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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Dean R. Garraffa

TITLE: Improved Breathing Regulator Apparatus Having Automatic Flow Control

PATENT NO.: 5,678,541

FILING DATE: March 15, 1996

ISSUE DATE: October 21, 1997

DOCKET: Atomic-1

SERIAL NO.: 08/616,223

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SUPPLEMENTAL PETITION FOR REINSTATEMENT

OF PATENT UNDER 37 CFR § 1.378

Dear Sir:

Atomic Aquatics, LLC ("Petitioner", "Atomic Aquatics" or just "Atomic"), the present assignee of U.S. Patent No. 5,678,541 (the "Subject Patent") now petitions for revival and the acceptance of all necessary maintenance fees and surcharges under 37 CFR 1.378. Petitioner asks for a suspension of the rules under 37 CFR 1.183 to the extent necessary to provide consideration of all of the requests and issues presented within this petition, and pays the corresponding fee set forth in 37 CFR 1.17(f). Thank you.

Petitioner now pays the required 7.5- and 11.5-year maintenance fees of \$1425 and \$2365 as a small entity and the \$700 fee under 37 CFR 1.20(i)(1). Combined with the \$400 fee under 37 CFR 1.176 for suspension of the rules, Petitioner now pays a total of \$4,890. If there is any deficiency, please contact Mr. Robinson immediately at the number at the bottom of this Petition.

12/23/2011 GARIAS 00000007 00016223 01 11:15 6898.00 OP

ATOMIC AQUATICS HAS MET ITS BURDEN TO SHOW THAT THE ABANDONMENT OF THE  
SUBJECT PATENT AND DELAY IN THE PAYMENT OF MAINTENANCE FEES WAS  
UNAVOIDABLE

In conformance with MPEP 2590(I), the Patentee has explained above (1) that reasonable care was taken to pay the maintenance fees for the Subject Patent, (2) the manner in which it became aware of the expiration of the Subject Patent, and (3) the steps taken to file this petition promptly. The Patentee attaches herewith the exhibits referred to above, supplying documentary evidence supporting the facts presented above. The Patentee now pays the required maintenance fee(s) and surcharge(s) to reinstate the Subject Patent, and the petition fee under 37 CFR 1.20(i)(1). The Patentee also pays the fee herewith under 37 CFR 1.17(f) for a suspension of the rules, should that be required.

REQUEST

Now having complied with all the requirements under 37 CFR 1.378(b), the Patentee requests reinstatement of the Subject Patent. Should there be any questions, please contact Mr. Robinson at the number below. Thank you.

Respectfully submitted this 14th day of December, 2011.

A handwritten signature in black ink, appearing to read 'E.D. Robinson', with a long horizontal flourish extending to the right.

Everett D. Robinson  
Reg. No. 50,911  
Echelon IP, LLC  
P.O. Box 1047  
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(801) 649-5858

Please note that the exhibits presented with this petition contain other exhibits: to distinguish, the Petitioner has presented its exhibits behind the covers marked "Petitioner's Exhibit". Mr. Robinson represents that all of the exhibits presented with this Petition are accurate representations of their respective documents as he has received them.

Petitioner now proceeds with its showing under 37 CFR 1.378(b).

### STATEMENT OF FACTS

The following is a chronological account of the Subject Patent and a number of related patents providing a showing of the conduct and intent of the owners and their legal representative, with reference to the supporting exhibits provided herewith.

- In 1995 Dean R. Garraffa and Douglas J. Toth formed a partnership under the name of Atomic Aquatics engaged in the manufacture and sale of diving equipment. Messrs. Garraffa and Toth have made several inventions over the years, and have secured patents in the United States including patent nos. 5,678,541, 5,803,073, 6,463,640, and 6,761,163 (hereinafter "Atomic-1", "Atomic-2", "Atomic-10" and "Atomic-14" referring to their corresponding docket numbers, or collectively as the "Lapsed Patents".) Through the prosecution until the present time, Leonard Tachner (hereinafter "Tachner") has been the attorney of record of the Lapsed Patents.
- On October 21, 1997, Atomic-1 issued to inventor Dean R. Garraffa. At about that time, Atomic reached an agreement with Tachner that he would invoice them for the payment of any maintenance fees necessary to keep Atomic-1 and any corresponding foreign patent matters and subsequent patents to the Atomic in force, and pay those fees to the U.S. Patent and Trademark Office (hereinafter the "Patent Office"). (See Exhibits P and Q, item 6.)
- In accordance with that understanding, Atomic Aquatics received an invoice from Tachner dated October 22, 2001 for the first maintenance fee due October 21, 2001 for Atomic-1, which invoice was paid to Tachner on Nov. 28, 2001. (See Exhibit A.) Also in accordance with that understanding, Atomic Aquatics received an invoice from Tachner dated August 1, 2000 for the payment of annuities

for foreign cases in the European Patent Office corresponding to Atomic-1 and Atomic-2, which invoice was paid to Tachner on August 15, 2000. (See Exhibit B.)

- The Patent Office mailed to Tachner on August 8, 2001 a notice that a fee deficiency submission under 37 CFR 1.28 was accepted, apparently because Tachner had paid the fourth-year maintenance fee in the small-entity amount without establishing small-entity status. The Patent Office sent to Tachner a Notice Of Patent Expiration (Exhibit C) because “payment of the maintenance fee ... has not been timely received”. Atomic was not made aware of this. (See Exhibits P and Q, item 11.)
- Tachner apparently paid the fourth-year maintenance fees in 2002 for Atomic-2, as it issued in 1998 and there is no notice of expiration entered in 2002 into the record.
- Atomic-14 issued on July 13, 2004.
- The record of Atomic-1 shows that Tachner received a Notice of Patent Expiration in 2005 for failure to pay the eighth-year maintenance fee (Exhibit D). Atomic was not made aware of this. (See Exhibits P and Q, item 11.)
- For Atomic-2, the record does not show that any notice was sent regarding non-payment of maintenance fees nor expiration thereof, but the bibliographic information available on PAIR shows that the status of this patent was changed to expired as of Oct. 12, 2006, which would correspond to non-payment of the eighth-year maintenance fee. As it is standard practice of the Patent Office to send a Notice of Patent Expiration to the correspondence address of record, it is beyond ordinary doubt that Tachner received notice of the 2006 Atomic-2 expiration.
- On Nov. 15, 2006, the Patent Office mailed to Tachner a Notice of Patent Expiration for Atomic-10 for failing to pay the fourth-year maintenance fee (Exhibit E). Atomic was not made aware of this. (See Exhibits P and Q, item 11.)
- By Dec. 19, 2006, Atomic had paid the issue fees to receive U.S. Pat. Nos. 7,181,778 and 7,188,869.



- On Aug. 11, 2008, the Patent Office mailed to Tachner a Notice of Patent Expiration for Atomic-14 for failing to pay the fourth-year maintenance fee (Exhibit F). Atomic was not made aware of this. (See Exhibits P and Q, item 11.)
- The 11.5-year maintenance fee came due in 2009 for Atomic-1, which was also not timely paid.
- In 2010 Tachner paid the issue fees for Atomic to receive U.S. Pat. Nos. 7,686,032; 7,704,015 and 7,712,793.
- Later in 2010 Atomic was approached by an investor, who requested the status of its intellectual property. Atomic then requested of Tachner a status report on its patents and patent applications. (See Exhibit G; and Tachner's declarations of Dec. 22, 2011 or Dec. 31, 2011, items 15-17, entered in Exhibits V-Y.) On Nov. 24, 2010 Atomic learned from Tachner that the Lapsed Patents had expired for failure to pay maintenance fees. Prior to Nov. 24, 2010, Atomic was not aware that the Lapsed Patents had not been maintained. (See Exhibits P and Q, item 11.)
- Having learned of their expirations, Atomic consulted with Tachner to revive the Lapsed Patents immediately. On Nov. 29, 2010, Tachner reported to Atomic that the cause of the expiration of these Lapsed Patents was the mental breakdown of his secretary, Ms. Foreman, and that that could be grounds for revival. (See Exhibit H.) Tachner kept Atomic minimally informed of his efforts to prepare and file petitions to revive. On Dec. 2, 2010, he informed Atomic of his preparation of petitions using the basis of the "temporary psychosis" of Ms. Foreman, before a diagnosis had been rendered by his "physician friend". (See Exhibit I.) Atomic continued to inquire as to the progress being made in the petitions. (See Exhibit J.)
- On Dec. 22, 2010 Tachner filed petitions to revive in Atomic-1 and Atomic-2, followed by petitions to revive in Atomic-10 and Atomic-14 on Dec. 31, 2010. Tachner did not forward drafts or copies for Atomic to review prior to filing; as of Jan. 11, 2011 Atomic had not received copies of these Dec. 2010 petitions. (Exhibit P item 16, Exhibit Q item 13.) Tachner was withholding copies of the petitions for Atomic-10 and Atomic-14. (See Exhibit K.)

- Atomic continued to inquire as to the status of the petitions, which Tachner minimally provided (see Exhibit L.)
- Between Feb. 10 and Feb. 22, 2011, the Patent Office mailed Decisions in all of the Lapsed Patents dismissing the petitions to revive (those patent histories appearing in Exhibits V-Y.) In summary, the Decisions in Atomic-2, Atomic-10 and Atomic-14 failed because Tachner had not shown that his assistant's mental illness was the cause of the failure to pay the missing maintenance fees. The Decision in Atomic-1 explores the failure in further detail, noting the other three petitions concerning the Lapsed Patents as well as three other petitions that were filed in other cases in January of 2011.
- None of the Feb. 2011 Decisions in the Lapsed Patents was sent to Atomic, nor did Tachner inform Atomic that the April 2011 requests for reconsideration had been denied. (Exhibit P item 20, Exhibit Q item 16.) Tachner allowed Atomic to believe that these petitions were still pending in the Patent Office, and in fact in May of 2011 Tachner told Mr. Garraffa that what he had received were only "requests for additional information" (Exhibit N), that in response he had "submitted a second physician's statement and statements from me and Janis at the PTO's request" and that "our petition is still ongoing". (See Exhibit M.) Regarding his assistant, Tachner further told Atomic that the Patent Office was "primarily interested in having more direct statements from her physician which would attribute her actions to her condition" and "the petitions are still being considered." (Exhibit N.) In reality, between April 11 and April 22, 2011 Tachner had filed a request for reconsideration of his earlier petitions in each of the Lapsed Patents. Tachner concealed the fact that his petitions to revive had been denied, and did not provide Atomic with any of the correspondence received or filed regarding any of these petitions.
- Atomic was kept unaware of the true condition of the Lapsed Patents and the correspondence therein until August of 2011. Atomic was told by an investor that the petitions to revive had been dismissed, and Atomic questioned how this could be verified through the on-line PAIR system. (See Exhibit O.)
- On October 6, 2011, the Patent Office sent a Request For Information in each of the Lapsed Patents in response to Tachner's April 2011 papers, in effect denying all outstanding petitions of revival. In these latest papers, the Patent Office notes that by his own admission, Tachner has not been truthful. The Patent Office further found that 'it is extremely odd that the people that were closest to Ms.

Foreman did not notice that, as stated by Dr. Albert, she exhibited “destabilizing behavior” or that “she lost her sense of reality” or “lost her sense of proportionality” even though no one noticed the claimed failures in her primary duties. The Patent Office further found the presentation of Tachner to be lacking in credibility without “corroborating evidence of Ms. Foreman's condition from a source that is independent of Dr. Albert.” From this, the Patent Office itself has now noticed the apparent deception of Tachner with regard to the failure to pay the maintenance fees in the Lapsed Patents.

- As to the October 6, 2011 Requests, Atomic has yet to receive any notice from Tachner. (See Exhibit P item 23, Exhibit Q item 20.) Indeed, at least one of the Oct. 6, 2011 notices mailed to Tachner was returned as undeliverable by the U.S. Post Office. (See Exhibit W.) Were it not for the recent due diligence efforts of Atomic's investors, Atomic would have no reason to believe that petitions to revive are not pending at the present time against the Lapsed Patents, nor would it have a reason to take independent action from the representation provided by Tachner.

## ARGUMENT

### THE POLICY OF THE U.S. PATENT AND TRADEMARK OFFICE WHERE PRACTITIONER DECEPTION IS INVOLVED

The policy of the U.S. Patent and Trademark Office regarding revival under 37 CFR § 1.378 has been made clear through the course of many decisions, including that of *In re Tan*, Pat. No. 5,290,273, decided about Mar. 7, 2008. (See Exhibit T.) Quoting from page 4 of *Tan*:

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions. Specifically, a petitioner's delay caused by the mistakes of negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess “notice of all facts, notice of which can be charged upon the attorney.”

“Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client,” but “if the client freely chooses

counsel, it should be bound to counsel's actions.”

“Presuming for the purposes of discussion that it was an act/omission of Counsel that contributed to any of the delay herein, the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client in the absence of evidence that the attorney/agent has acted to deceive the client.”

Speaking generally, the Patent Office holds patentees accountable for the representatives they choose. As stated in the text above, this is upon a theory that a patentee is provided with sufficient information to voluntarily choose his agent/representative before the Office, and that it is he that should bear the consequences if he makes a poor choice. Tan also expresses the policy that even where an attorney “affirmatively misled” a client out of gross negligence, that is still not a sufficient showing to revive a patent. But where an attorney “has acted to deceive the client”, and it was an act or omission of that attorney that was the cause of the delay, that is beyond the gross negligence standard.

The Patent Office excuses patentees that are not provided with the information necessary to select their representative due to deception on the part of the practitioner:

Presuming for the purposes of discussion that it was an act/omission of Counsel that contributed to any of the delay herein, the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client in the absence of evidence that the attorney/agent has acted to deceive the client. (See Exhibit T pgs. 3-4.)

In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990): “When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the rule stated in Link for charging the attorney's mistake to his client. (See Exhibit S, footnote 10 on pg. 3 and Exhibit T, footnote 13 on page 5.)

Even though a patentee may be able to show that its delay was caused by attorney deception, the patentee is still required to show that it acted reasonably and responsibly to keep a patent maintained, including a showing of what was done once the neglect or deception on the part of his chosen representative was discovered. The Patentee will make that showing below.

## TACHNER'S RECENTLY DISCOVERED PATTERN OF DECEPTION REGARDING THE PAYMENT OF MAINTENANCE FEES FOR CLIENTS

The Patentee will now demonstrate that Tachner has a history of deception with his clients and with the Patent Office, specifically involving the payment of maintenance fees for his clients. The Petitioner turns now to Petitioner's Exhibit U, which is a petition for revival and corresponding favorable decision in U.S. Pat. No. 6,205,885 ("885") for an entity known as Crankbrothers, Inc. or California Crank Brothers, Inc. (hereinafter "Crank Brothers"). The exhibits of the Haynes & Boone / Finnegan & Henderson petition will be referred to here as Exhibit U-%, where % represents one of his exhibits enumerated from A to Y.

For 885, Tachner first explained that the failure to pay a maintenance fee by March of 2005 was due "entirely to confusion between my staff and the client as to who would pay the fee." (Page 2 of Exhibit U-A dated Oct. 18, 2007.) This petition to revive of Exhibit U-A was accompanied by the Declaration of Janis Foreman, Office Manager for Tachner. She swore that copies of docket sheets attached were true copies with annotations that the client would pay their own maintenance fees.

That petition was followed by another dated July 30, 2008 from Tachner (Exhibit U-C), including his own declaration swearing (1) that his firm paid patent maintenance fees when requested by their clients, (2) that Ms. Foreman was believed to be confused in this patent with respect to the payment of maintenance fees, (3) that he was reducing her workload, and (4) that he had instructed her to always confirm that a client does not want them to pay a maintenance fee. A decision was issued granting that petition on Oct. 15, 2008 (Exhibit U-D), followed by a corrected decision vacating that grant on June 3, 2009 (Exhibit U-E). That latest decision noticed that Tachner had paid maintenance fees in several others of Crank Brothers' patents at around the same time as the missing maintenance fee, and there was uncertainty over which set of presented facts was correct. In his declaration, Tachner also claimed not to have received a Notice of Patent Expiration in the case; however the Haynes & Boone / Finnegan & Henderson petition was able to produce one with Tachner's address on it (Exhibit U-P).

A declaration of Inventor Winefordner was later filed (Exhibit U-R) in which he swore that Tachner had withheld the petitions and their supporting declarations in the attempt to revive the '885 patent. He

further swore that Tachner had withheld informing Crank Brothers of the expiration of Pat. No. 5,676,529 in 2001 and 2005, and their subsequent reinstatements. He further swore that Tachner had refrained from informing Crank Brothers of the expiration of Pat. No. 5,857,509 in 2007. He further swore that inquiries to Tachner resulted in claims that “the patent office website is down” and that annuities had been paid as shown in an attached maintenance fee statement. He further swore that fees refunded to Tachner were never returned to Crank Brothers.

The Haynes & Boone / Finnegan & Henderson petition notes several indications of falsehood in the Declaration of Janis Foreman, including that the same annotation “error” occurred on several files at different times. (Exhibit U, in the petition on pg. 8, quoting the First Decision: “If Ms. Foreman made an error, it appears she made the same error on multiple occasions. Any request for reconsideration should be accompanied by a full discussion of each occasion Ms. Foreman changed any of the petitioner's files to indicate petitioner would pay the fee.”)

The Haynes & Boone / Finnegan & Henderson petition notes several indications of falsehood in the Declaration of Leonard Tachner, including that Tachner had claimed not to have a file with any materials other than the patent for the '885 patent, and there was confusion over who was to pay the maintenance fees there. The Haynes & Boone / Finnegan & Henderson petition was able to produce a postcard (Exhibit U-H) changing the correspondence address to Tachner in the case, contradicting Tachner's sworn declaration. (Exhibit U, in the petition on pg. 9.)

The Haynes & Boone / Finnegan & Henderson petition also showed that the copies of the file covers submitted to the Patent Office by Tachner were falsified: the handwritten notation that the client was to pay the maintenance fees were written on copies of the file covers presented to the Patent Office, but were not actually on the covers themselves. (Exhibit U, in the petition on pgs. 10-11.) That petition also provided histories of others of Crank Brothers' patents and an email of Janis Foreman, which showed that Tachner was engaged in hiding the expiration of these other patents from his client. (Exhibit U, in the petition on pgs. 11-13.)

Therefore, Exhibit U provides a strong showing that Tachner was engaged in deceiving a client other than Atomic, and that that deception was across several patents to avoid his client's discovering the late

payment of maintenance fees. The evidence of Exhibit U shows that Tachner had a pattern of allowing patents to lapse for failure to pay maintenance fees, and then reinstating them, all without informing his client, Crank Brothers.

But this pattern was not limited only to Crank Brothers. The Patentee has been able to find a pattern of lapsing and reinstating of applications and patents of the Physical Optics Corporation. This includes U.S. Pat. Nos. 6,594,050; 6,595,644; 6,603,770; 6,802,188; and 7,113,489, all of which include an abandonment followed by a reviving of a case.

Thus, this problem Tachner had of allowing patents to lapse was not confined to one client, and where he failed to pay maintenance fees he also concealed this from the affected clients.

#### TACHNER CONCEALED HIS MISCONDUCT FROM ATOMIC AQUATICS, AND DECEIVED HIS CLIENT INTO BELIEVING THE PATENTS WERE BEING APPROPRIATELY MAINTAINED

The pattern of deception shown to have occurred in the '885 patent against Crank Brothers was continued against Atomic. As with Crank Brothers, Atomic was invoiced for the payment of a maintenance fee in or around 2001. (Exhibit A.) So the evidence is strong that Atomic had agreed with Tachner that he would manage and pay the maintenance fees for issued patents, including the Lapsed Patents. (See also Exhibits P and Q items 5 and 6.) Tachner's concealment began in 2001 with the failure to timely pay the maintenance fee in Atomic's Patent No. 5,678,541. Atomic was not made aware of the expiration and revival of this patent in 2001. (See Exhibits P and Q item 11.) Now referring to the Statement of Facts above and Petitioner's Exhibit V, upon the expiration of the Subject Patent in 2005, a Notice of Patent Expiration was mailed to Tachner. Atomic did not receive this Notice.

Atomic first learned of the lapsing of the Subject Patent in November of 2010 when approached by its investor. (Exhibit G; Exhibits P and Q item 11.) As with Crank Brothers, the expiration of this patent did not stand alone; it was one of a set of four that had been neglected. (Exhibits P and Q item 11.) An accidental error would have impacted one of a client's patents. Here, this impacted four Lapsed Patents.

In 2008 for Crank Brothers, Tachner explained the failure to pay the maintenance fee on a failure of performance with his Office Manager, Janis Foreman, she being “distracted”, “confused” or otherwise “not functioning in her usually dependable way”. (Exhibit U-C in the Declaration of Leonard Tachner, paragraphs 4, 8.) He then swore that he was “taking action immediately to reduce Ms. Foreman's duties.” (Exhibit U-C in the Declaration of Leonard Tachner, paragraphs 9.) In 2010, Tachner's explanation for the failure to pay the maintenance fees on the Lapsed Patents was “that my secretary of over 30 years had some kind of a meltdown.” (Exhibit H.) Three days later, Tachner's report was that his physician friend was willing to help and would see his secretary “Janis next week to interview her for his diagnosis which will be described in his declaration”. (Exhibit I.) He continued: “My plan is to file declarations in support of petitions to revive the patents based on unavoidable abandonment resulting from Janis' temporary psychosis.”

On Dec. 2, 2010, temporary psychosis was the diagnosis to appear in the declarations, to be created the following week by his physician friend. (Exhibit I.) In Exhibits V-Y, Dr. Albert's statement of Dec. 13, 2010 includes the following statements: “Ms. Foreman's irrational behavior is a result of her reaction to a temporary but continually increased work overload which became more than she could handle...”, “This type of destabilizing behavior resulted in a spiralling down in her ability to think and act rationally. She began to do and say unreasonable and unrealistic things. She lost any sense of reality ... Ms. Foreman was suffering from an acute psychotic breakdown ...” In 2008, Tachner swore to “reduce Ms. Foreman's duties.” In 2010, Dr. Albert's statement tells, with remarkable similarity: “I would suggest to her that she should help her employer adjust her office responsibilities to reduce her work load if possible.” Dr. Albert's statement includes the diagnosis: “Major Depression, severe, with psychotic episodes” in accordance with Tachner's plan.

As with Crank Brothers, Atomic did not receive the petitions filed nor drafts thereof. (Exhibit P item 16, Exhibit Q item 13.) None of the Feb. 2011 Decisions in the Lapsed Patents was sent to Atomic, nor did Tachner inform Atomic that the April 2011 requests for reconsideration had been denied. As spoken of above in the Statement of Facts, Tachner allowed Atomic to believe that these petitions were still pending in the Patent Office, and in fact in May of 2011 Tachner told Mr. Garraffa that what he had received were only “requests for additional information” (Exhibit N), that in response he had



“submitted a second physician's statement and statements from me and Janis at the PTO's request” and that “our petition is still ongoing”. (See Exhibit M.) Regarding his assistant, Tachner further told Atomic that the Patent Office was “primarily interested in having more direct statements from her physician which would attribute her actions to her condition” and “the petitions are still being considered.” (Exhibit N.) In reality, between April 11 and April 22, 2011 Tachner had filed a request for reconsideration of his earlier petitions in each of the Lapsed Patents. Tachner concealed the fact that his petitions to revive had been denied, and did not provide Atomic with any of the correspondence received or filed regarding any of these petitions.

Atomic was kept unaware of the true condition of the Lapsed Patents and the correspondence therein until August of 2011, when Atomic was told by an investor that the petitions to revive had been dismissed. (See Exhibit O.)

On October 6, 2011, the Patent Office sent a Request For Information in each of the Lapsed Patents in response to Tachner's April 2011 papers, in effect denying all outstanding petitions of revival. In these latest papers, the Patent Office notes that by his own admission, Tachner has not been truthful. The Patent Office further found that 'it is extremely odd that the people that were closest to Ms. Foreman did not notice that, as stated by Dr. Albert, she exhibited “destabilizing behavior” or that “she lost her sense of reality” or “lost her sense of proportionality” even though no one noticed the claimed failures in her primary duties. The Patent Office further found the presentation of Tachner to be lacking in credibility without “corroborating evidence of Ms. Foreman's condition from a source that is independent of Dr. Albert.” From this, the Patent Office itself has now noticed the apparent deception of Tachner with regard to the failure to pay the maintenance fees in the Lapsed Patents.

As to the October 6, 2011 Requests, Atomic has yet to receive any notice from Tachner. (See Exhibits P and Q.) Indeed, the Oct. 6, 2011 notice mailed to Tachner was returned as undeliverable by the U.S. Post Office. (See Exhibit W.) Were it not for the recent due diligence efforts of Atomic's investors, Atomic would have no reason to believe that petitions to revive the Lapsed Patents are not pending at the present time, nor would it have a reason to take independent action from the representation provided by Tachner.

Mr. Doug Toth of Atomic also reports that he was misled as to the status of an application being prepared under the "16desB" docket identifier. Atomic was invoiced for the filing of the application, and Atomic was given explanations that the Patent Office was just slow when Atomic inquired as to the application's status. Mr. Toth later learned that this application was never filed. (Exhibit Q item 23.)

The Patentee cannot prove why Tachner had this pattern, but Atomic believes it can state with substantial certainty that most clients would notice the non-payment of an issue fee, as a client would almost always notice the failure of a patent to issue. Tachner could, however, conceal the lapse of a patent, as most clients do not read the Official Gazette looking for their patents and all mailings of abandonment or expiration would have been sent to Tachner's address. Thus, even though Tachner failed to pay maintenance fees in 2005 (Atomic-1), 2006 (Atomic-2, Atomic-10) and 2008 (Atomic-14), his office still paid the issue fees for Atomic in 2006 for Pat. Nos. 7,181,778 and 7,188,869.

With the overwhelming evidence discussed above, the Patentee submits that the evidence is compelling beyond any reasonable question that Tachner's actions went well beyond gross negligence and were done with deliberate intent and deception, both to the Patent Office and to the Patentee. Regardless of whether it was Leonard Tachner himself or one of his staff members, the deception on the part of his office including the concealment of the lapsing of Atomic's patents prevented the Patentee from taking and maintaining prompt and proper action to revive the Subject Patent.

#### ATOMIC AQUATICS ACTED REASONABLY, RESPONSIBLY AND PROMPTLY TO CORRECT THE ERRORS CAUSED BY TACHNER'S MISCONDUCT

##### 1. Reasonable care was taken to ensure that the maintenance fees would be paid timely.

At the time of the issuance of the first of the Lapsed Patents, Atomic instructed Tachner to maintain them. (See Exhibits P & Q, items 6-9.) Atomic has expected to receive invoices for Tachner's efforts in maintaining the Lapsed Patents, which it did in 2001 for Atomic-1 for the fourth-year maintenance fee. Atomic paid that invoice (Exhibit A) and subsequent invoices as Tachner performed further work for Atomic. (See Exhibits P & Q, item 10.)

2. The petition was filed promptly after the patentee discovered the expiration of the patent.

The Patentee was unaware that Tachner was allowing the Lapsed Patents to expire, because the Notices of Patent Expiration were being sent to him (see Exhibits C, D, E and F). On Oct. 25, 2010, Doug Toth requested on behalf of Atomic an inventory of all of its patent matters from Tachner. (See Exhibit G.) This was initiated by a request from a potential investor, who wanted to know the status of all of Atomic's patents and patent applications. The Patentee did not know until Nov. of 2010 that Tachner was allowing the Lapsed Patents to expire. (See Exhibits P & Q, item 11.)

3. The petitioner took prompt steps to reinstate the patent

Upon learning of the expiration of the Lapsed Patents in Nov. 2010, Atomic immediately contacted its patent attorney, Tachner, and asked what could be done to reinstate them. (See Exhibits P & Q, item 12.) Tachner informed Atomic that his secretary had had a “meltdown”, and that was the cause of the failure to pay the maintenance fees for the Lapsed Patents. (See Exhibit H and Exhibits P & Q, item 13.) Tachner reported that he was progressing on petitions to revive the Lapsed Patents through December. (See Exhibits I, J and Exhibit P items 14 and 15.) Atomic has continued to follow up with Tachner, communicating with him in 2011 in at least January, February, May, and August (Exhibits K through O).

Prior to August of 2011, Atomic had no reason to believe that Tachner was not providing accurate information as to the status of the petitions to revive the Lapsed Patents. (Exhibit P item 21 and Exhibit Q item 17.) In May of 2011, Tachner informed Atomic that the petitions to revive were “ongoing” and “still being considered” and that the U.S. Patent and Trademark Office had requested additional information in them. (Exhibit P item 18.) Atomic did not learn of the Feb. 2011 denials within the Decisions on Petition, nor of Tachner's subsequent filings of April 2011 in each of the Lapsed Patents until August of 2011 (Exhibit P items 19 and 20; Exhibit Q items 15 and 16.) Tachner has continued to withhold communications from the U.S. Patent and Trademark Office, including the Oct. 6, 2011 Requests for Information in each of the Lapsed Patents (Exhibit P items 23 and 24; Exhibit Q items 19 and 20.)

Had Atomic known about Crank Brothers' difficulty with the '885 matter in 2010, it might have been able to develop the suspicion to conduct a further inquiry into Tachner's trustworthiness. But Atomic did not discover this until October of 2011. (Exhibit P items 21 and 22; Exhibit Q item 18.)

Furthermore, the difficult standard for reviving patents expired beyond two years was not explained to Atomic, at a level of comprehensibility by the ordinary public: Atomic did not have the background needed to be suspicious of Tachner's conduct.

In September of 2011, I was asked to provide an independent report on the status of the Lapsed Patents and other of Atomic's patents and patent applications. I reported back to Mr. Mark Frederickson, an officer acting on behalf of Atomic. Mr. Frederickson asked me to study how feasible it would be to revive the Lapsed Patents, which study I performed by October 18, 2011. My study uncovered Tachner's alleged misconduct related to U.S. Pat. No. 6,205,885 ("Crank Brothers") and repeated abandonment of applications and expiration of patents assigned to Physical Optics (U.S. Pat. Nos. 6,594,050; 6,595,644; 6,603,770; 6,802,188; and 7,113,489). Only recently has Atomic learned of Tachner's apparent misconduct in the Crank Brothers and Physical Optics matters (Exhibit P item 22; Exhibit Q item 18.) Upon learning of this, I requested that Atomic provide me copies of its correspondence with Tachner, which I reviewed by November 2, 2011. I made further inquiries of Dean R. Garraffa and Douglas J. Toth regarding their affairs with Tachner, which were responded to by Nov. 15, 2011, including copies of invoices containing some charges for the payment of maintenance fees and invoices. I have since been preparing these petition materials for submission. (For my efforts, see Exhibit R.)

#### 4. Atomic Aquatics acted reasonably to maintain and revive the Subject Patent.

Petitioner submits that it acted reasonably in its reliance upon Tachner to maintain the Subject Patent. Reasonable persons rely upon their attorneys to manage their affairs, and reasonable patentees rely upon their patent attorneys to pay maintenance fees required to maintain their patents. At all times that the Petitioner relied upon Tachner, he was an attorney registered to practice before the U.S. Patent and Trademark Office.

Persons are evaluated with respect to their honesty and integrity before becoming attorneys and before becoming registered with the U.S. Patent and Trademark Office, and reasonable persons conducting business before the Office do not need to protect themselves from deception by their attorneys registered to practice there.

Furthermore, the U.S. Patent and Trademark Office maintains professional rules of conduct applied to those registered to represent applicants and patentees before the Patent Office, and reasonable persons rely upon those rules.

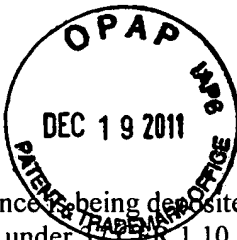
Reasonable persons rely upon patent attorneys to follow correct administrative procedures, and in general do not need to learn those procedures themselves. Thus, reasonable persons do not need to learn the correspondence procedure used by the U.S. Patent and Trademark Office to pay maintenance fees, nor procedures to verify that their attorneys are performing those procedures correctly.

The U.S. Patent and Trademark Office has a practice of corresponding only with either an applicant or his attorney. Thus the Patent Office effectively releases applicants who are represented from directly knowing the details of the status of their matters, while at the same time imposing upon their attorneys a duty of candor with them. Reasonable persons recognize that they must rely upon their registered attorneys to advise them on the state of their matters with the Office, and to act correctly in their behalf.

Until the recent availability of the PAIR system, applicants represented by an attorney had no alternative but to consult with their attorney to know of the status of an application or a patent. Even with the improved access available today, the Patentee submits that it would still be an unreasonable burden upon applicants and patentees to know the procedures and technicalities of the facilities of the Patent Office.

The Patentee's reliance upon Tachner was not unreasonable, and it should not be held responsible for Tachner's concealment, deception and/or fraud.

CERTIFICATE OF MAILING



☐ I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 39 CFR 1.10 with sufficient postage and is addressed to:

☒ I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
Mail Stop Petition  
P.O. Box 1450  
Alexandria, VA 22313-1450

on Dec. 15, 2011.

Typed or printed name of person signing this certificate:

☒ Everett D. Robinson

☐ \_\_\_\_\_

Signature 

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted the United States Patent and Trademark Office,

☐ Fax No. (571) 273-8300

☐ Fax No. (     ) \_\_\_\_\_ - \_\_\_\_\_

on \_\_\_\_\_.

Typed or printed name of person signing this certificate:

☐ Everett D. Robinson

☐ \_\_\_\_\_

Signature \_\_\_\_\_

# Petitioner's Exhibit A

Invoice for 4th-year maintenance fee  
for Pat. No. 5,678,541 (Atomic-1)  
from Tachner dated 10/22/2001,  
with payment

Exhibit A

**LEONARD TACHNER  
A PROFESSIONAL LAW CORPORATION  
REGISTERED PATENT ATTORNEY  
17961 SKY PARK CIRCLE  
SUITE 38-E  
IRVINE, CALIFORNIA 92614**

**October 22, 2001**

**PATENTS  
TRADEMARKS  
COPYRIGHTS**

**TEL: (949) 752-8525  
FAX: (949) 955-2415**

**STATEMENT OF ACCOUNT**

Mr. Douglas J. Toth  
Mr. Dean R. Garraffa  
ATOMIC AQUATICS, INC.  
17842 Georgetown Lane  
Huntington Beach, CA 92647

Fees for professional services rendered re:

**ATOMIC-1:**

Payment of first annuity in the U.S.  
Patent and Trademark Office for Patent  
No. 5,678,541 entitled "BREATHING  
REGULATOR APPARATUS HAVING  
AUTOMATIC FLOW CONTROL" by  
inventor Dean R. Garraffa including  
payment of government fees (\$440)  
(1/3 hr. Atty Time @/\$300/hr.):

**\$ 550.00**

**Current Balance Due \$ 550.00**





REFERENCE NO.	DESCRIPTION	INVOICE DATE	INVOICE AMOUNT	DISCOUNT TAKEN	AMOUNT PAID
CHECK DATE	CHECK NO.	PAYEE	DISCOUNTS TAKEN	CHECK AMOUNT	
11/28/01	00006629	Leonard Tachner		550.0	

50 DELUXE BUSINESS FORMS 1-800-328-0304 www.deluxeforms.com

Mr. Douglas J. Toth  
Mr. Dean R. Garraffa  
ATOMIC AQUATICS, INC.  
17842 Georgetown Lane  
Huntington Beach, CA 92647

Fees for professional services rendered re:

**ATOMIC-1:**

Payment of first annuity in the U.S.  
Patent and Trademark Office for Patent  
No. 5,678,541 entitled "BREATHING  
REGULATOR APPARATUS HAVING  
AUTOMATIC FLOW CONTROL" by  
inventor Dean R. Garraffa including  
payment of government fees (\$440)  
(1/3 hr. Atty Time @/\$300/hr.):

\$ 550.00

**Current Balance Due \$ 550.00**

# Petitioner's Exhibit B

Invoice for annuity payments for  
EPO applications corresponding to  
Atomic-1 and Atomic-2  
from Tachner dated 10/22/2001,  
with payment

Exhibit B

**LEONARD TACHNER  
A PROFESSIONAL LAW CORPORATION  
REGISTERED PATENT ATTORNEY  
17961 SKY PARK CIRCLE  
SUITE 38-E  
IRVINE, CALIFORNIA 92614-6364**

**August 1, 2000**

**PATENTS  
TRADEMARKS  
COPYRIGHTS**

**TEL: (949) 752-8525  
FAX: (949) 955-2415**

**STATEMENT OF ACCOUNT**

**ATOMIC AQUATICS, INC.  
17842 Georgetown Lane  
Huntington Beach, CA 92647**

**Fees for professional services rendered re:**

**ATOMIC-1/EPO:**

**Payment of yearly renewal for EPO  
Application No. 97915960 which  
corresponding to U.S. Patent No. 5,678,541  
entitled "BREATHING REGULATOR  
APPARATUS HAVING AUTOMATIC  
FLOW CONTROL" by inventor Dean R.  
Garraffa including associate's fees, government  
fees (\$720.65) and our fee (\$100.00):** **\$ 820.00**

**ATOMIC-2/EPO:**

**Payment of yearly renewal for EPO  
Application No. 97915986 which  
corresponds to U.S. Patent No. 5,803,073  
entitled "SECOND STAGE SCUBA DIVING  
REGULATOR HAVING PNEUMATIC-  
DEPENDENT ANTI-SET FEATURE" by  
inventor Douglas J. Toth including associate's  
fees, government fees (\$720.65) and our  
fee (\$100.00):** **\$ 820.00**

**Current Balance Due \$ 1,640.00**

REFERENCE NO.	DESCRIPTION	INVOICE DATE	INVOICE AMOUNT	DISCOUNT TAKEN	AMOUNT PAID
08-01-00		8-1-00	1,640.00		1,640.00
CHECK DATE	CHECK NO.	PAYEE	DISCOUNTS TAKEN	CHECK AMOUNT	
8-15-00	5205	Leonard Tachner			\$1,640.0

DELUXE BUSINESS FORMS 1+800-328-0304

ATOMIC AQUATICS, INC.  
17842 Georgetown Lane  
Huntington Beach, CA 92647

Fees for professional services rendered re:

**ATOMIC-1/EPO:**

Payment of yearly renewal for EPO  
Application No. 97915960 which  
corresponding to U.S. Patent No. 5,678,541  
entitled "BREATHING REGULATOR  
APPARATUS HAVING AUTOMATIC  
FLOW CONTROL" by inventor Dean R.  
Garraffa including associate's fees, government  
fees (\$720.65) and our fee (\$100.00): \$ 820.00

**ATOMIC-2/EPO:**

Payment of yearly renewal for EPO  
Application No. 97915986 which  
corresponds to U.S. Patent No. 5,803,073  
entitled "SECOND STAGE SCUBA DIVING  
REGULATOR HAVING PNEUMATIC-  
DEPENDENT ANTI-SET FEATURE" by  
inventor Douglas J. Toth including associate's  
fees, government fees (\$720.65) and our  
fee (\$100.00): \$ 820.00

**Current Balance Due \$ 1,640.00**

# Petitioner's Exhibit C

2001 Notice of Expiration  
of the Atomic-1 Patent

Exhibit C



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

P75M

LEONARD TACHNER  
SUITE 295  
3990 WESTERLY PLACE  
NEWPORT BEACH CA 92660

DATE PRINTED

11/27/01

## NOTICE OF PATENT EXPIRATION

According to the records of the Patent and Trademark Office, payment of the maintenance fee for the patents listed below has not been timely received prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b).

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(m) are paid, AND THE DELAY IN PAYMENT OF THE MAINTENANCE FEE IS SHOWN TO THE SATISFACTION OF THE COMMISSIONER TO HAVE BEEN UNAVOIDABLE. 35 U.S.C. 41(c)(1).

IF THE COMMISSIONER ACCEPTS PAYMENT OF THE MAINTENANCE FEE UPON PETITION, THE PATENT SHALL BE CONSIDERED AS NOT HAVING EXPIRED, BUT WOULD BE SUBJECT TO THE INTERVENING RIGHTS AND CONDITIONS SET FORTH IN 35 U.S.C. 41(c)(2).

NOTICE OF THE EXPIRATION WILL BE PUBLISHED IN THE OFFICIAL GAZETTE.

PATENT NUMBER	U.S. SERIAL NUMBER	PATENT DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
5678541	08616223	10/21/97	03/15/96	10/21/01	

# Petitioner's Exhibit D

2005 Notice of Expiration  
of the Atomic-1 Patent

Exhibit D



P75M

LEONARD TACHNER  
SUITE 295  
3990 WESTERLY PLACE  
NEWPORT BEACH CA 92660

DATE PRINTED

11/23/05

**NOTICE OF PATENT EXPIRATION**

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, you may call the USPTO Contact Center at 800-786-9199 or 703-308-4357.

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
578541	08616223	10/21/97	03/15/96	10/21/05	



# Petitioner's Exhibit E

2005 Notice of Expiration  
of the Atomic-10 Patent

Exhibit E



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

P75M  
LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

DATE PRINTED

11/15/06

**NOTICE OF PATENT EXPIRATION**

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, you may call the USPTO Contact Center at 800-786-9199 or 571-272-1000.

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
463640	09483145	10/15/02	01/13/00	10/16/06	

# Petitioner's Exhibit F

2008 Notice of Expiration  
of the Atomic-14 Patent

Exhibit F



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

P75M

LEONARD TACHNER  
A PROFESSIONAL LAW CORPORATION  
SUITE 38-E  
17961 SKY PARK CIRCLE  
IRVINE CA 92614-6364

DATE PRINTED

08/11/08

**NOTICE OF PATENT EXPIRATION**

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, customers should call the Office of Petitions Help Desk at 571-272-3282 or refer to the USPTO Web site at [www.uspto.gov/web/offices/pac/dapp/petitionspractice.html](http://www.uspto.gov/web/offices/pac/dapp/petitionspractice.html). The USPTO also permits reinstatement under 37 CFR 1.378(c) by electronic petition (e-petition) using EFS-Web; e-petitions may be automatically granted if all the eligibility requirements are met. For further information on filing an e-petition, please call the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100 or refer to the EBC's e-petition guide at [www.uspto.gov/ebc/portal/efs/petition\\_quickstart.pdf](http://www.uspto.gov/ebc/portal/efs/petition_quickstart.pdf).

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
6761163	10347608	07/13/04	01/21/03	07/13/08	ATOMIC-14

NOTE: This notice was automatically generated based on the amount of time that elapsed since the date a patent was granted. It is possible that the patent term may have ended or been shortened due to a terminal disclaimer that was filed in the application. Also, for any patent that issued from an application filed on or after June 8, 1995 containing a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed, unless the term was adjusted or extended under 35 U.S.C. 154 or 156.

# Petitioner's Exhibit G

Request for patent inventory  
from Tachner  
Oct. 25, 2010

Exhibit G

## **Doug Toth**

**From:** Doug Toth [doug@atomicaquatics.com]

**Sent:** Monday, October 25, 2010 10:45 AM

**To:** 'jforemantachlaw@aol.com'

**Subject:** patent inventory

Janice,

Do you have a detailed inventory of all out patents and their status; pending, issued, expiration, etc.?

Doug Toth  
Atomic Aquatics  
16742 Burke Lane  
Huntington Beach CA 92672  
ph 714-375-1433  
fax 714-375-1435

# Petitioner's Exhibit H

Email from Tachner to Dean Garraffa  
dated 11/29/2010  
regarding the failure to pay  
Maintenance fees

Exhibit H

**Subject:** Re: Petitions to revive

**From:** <ltachner@aol.com>

**Date:** 11/29/2010 6:48 PM

**To:** <deanatomic@aol.com>

Dean: As I explained to you earlier, preliminary indications are that my secretary of over 30 years had some kind of meltdown. I'm not yet sure of the full scope of what has occurred, but it looks like over the 2005-2007 time frame she stopped doing things that I had come to rely on her to do without fail. In some respects that significantly improves the chance of successfully reviving abandoned patents because an employee's sickness (mental or otherwise) is clearly unforeseeable. I believe that our chances for reviving your patents are significantly better than if she had just forgotten or simply made a mistake. Leonard



# Petitioner's Exhibit I

Email from Tachner to Dean Garraffa  
dated 12/2/2010  
regarding preparation of petition  
and diagnosis of assistant

Exhibit I

**Subject:** Re: From Dean Garraffa

**From:** <ltachner@aol.com>

**Date:** 12/2/2010 4:43 PM

**To:** <deanatomic@aol.com>

Dean: I'm working on declarations for the petitions today. I've spoken to my physician friend and he's willing to help. He'll see Janis next week to interview her for his diagnosis which will be described in his declaration.

The files are being copied, but it will take a few more days. I will be reviewing each file myself to confirm the status as described in the table she sent you. I understand the need for urgency, but I need to do things carefully to have the best chance for success. My plan is to file declarations in support of petitions to revive the patents based on unavoidable abandonment resulting from Janis' temporary psychosis. I believe that her behavior resulted from stress that exceeded her limit, but that she is being and will continue to be fully cooperative. Leonard

In a message dated 12/2/2010 2:48:05 P.M. Pacific Standard Time, Deanatomic@aol.com writes:

Hi Leonard,

Doug Toth and Jerry Mix have been informed as to how you intend to appeal the Now abandoned patents I told them as you explained to me in our conversations yesterday.

I just wanted to send you this Email to clarify a few items we talked about in your office on Monday.

You said it would take a few days to understand what we would need to do. I hope we can have that action plan in place before tomorrow as we know as fact that several people have now become aware that the patents are abandoned.

The status list Atomic *attached* is the only list we are working from and we want to make certain that the items are correctly listed and the information is correct I need to have someone double check each item and tell us if we need to act quickly to recover any other patents in trouble How do you plan to verify the accuracy of this list?

Patents we need immediate action on per the list you supplied.

Atomic 12 10 14 15 16 16DES 16DES-b 20

It would be very helpful to me if you could keep me informed so I can answer these questions if asked.

The other issue is copies of our files. If you can have them copied this week I am happy to pay for the service or costs

Please call today me if you wish to talk about any progress you have made or information we can use to keep the Patents alive.

Thank you,

***Dean Garraffa***



***16742 Burke Lane, Huntington Beach, CA 92647***  
***(714)-375-1433 Fax (714) 375-1435***

# Petitioner's Exhibit J

Email between Tachner to Dean Garraffa  
dated 12/7/2010  
regarding preparation of petition

Exhibit J

Subj: **Re: From Dean Garraffa**  
Date: 12/7/2010 11:00:36 AM Pacific Standard Time  
From: [Ltachner@aol.com](mailto:Ltachner@aol.com)  
To: [Deanatomic@aol.com](mailto:Deanatomic@aol.com)

Dean: The file copying will be done today. I met with my doctor friend over the weekend and he agreed to help. I wrote his declaration yesterday and he's reviewing it today. Janis' and my declarations are being typed today. Leonard

In a message dated 12/7/2010 10:29:39 A.M. Pacific Standard Time, [Deanatomic@aol.com](mailto:Deanatomic@aol.com) writes:

Hi Leonard,

Any progress to report?

All The Best,

*Dean Garraffa*

# Petitioner's Exhibit K

Email from Tachner to Dean Garraffa  
dated 1/11/2011  
regarding missing copies of  
petitions to revive

Exhibit K

**Subject:** Re: From Dean Garraffa

**From:** <ltachner@aol.com>

**Date:** 1/11/2011 5:33 PM

**To:** <deanatomic@aol.com>

**CC:** <doug@atomicaquatics.com>

Dean: Janis says that the petitions for Atomic-1 and -2 were mailed to you Saturday, but I've asked her to e-mail them now also. The petitions for 1, 2, 10 and 14 are essentially identical except for the docket numbers and patent numbers referred to. Let me know if you need anything further in this regard. Leonard

In a message dated 1/11/2011 3:51:44 P.M. Pacific Standard Time, Deanatomic@aol.com writes:

Hi Leonard,

Doug and I called you last Friday for a copy of filed petitions to revive our abandoned patents, yesterday I received by certified mail containing the filing for the **Atomic -30 Des new dive mask having multicolored frame**

It appears this was sent last Friday, but nothing else was inside the envelope should we expect a separate mailing for the Petitions?

*Dean Garraffa*

# Petitioner's Exhibit L

Email from Tachner to Doug Toth  
dated 2/2/2011  
regarding status of petitions to revive

Exhibit L



**Subject:** FW: Update

**From:** "Doug Toth" <dougt@atomicaquatics.com>

**Date:** 2/10/2011 12:20 PM

**To:** "Dean Garraffa" <deanatomic@aol.com>

---

**From:** Ltachner@aol.com [mailto:Ltachner@aol.com]

**Sent:** Wednesday, February 02, 2011 11:34 AM

**To:** dougt@atomicaquatics.com

**Subject:** Re: Update

Doug: We've heard back only in regard to Atomic -19 and Atomic -23 so far. Both have been granted. Leonard

In a message dated 2/2/2011 9:13:45 A.M. Pacific Standard Time, dougt@atomicaquatics.com writes:

Leonard,

Any response at all on any of the petitions filed yet?

Doug Toth

Atomic Aquatics

# Petitioner's Exhibit M

Email from Dean Garraffa to Doug Toth  
dated 5/5/2011  
forwarding IM conversation with Tachner

Exhibit M

**Subject:** From Dean Garraffa

**From:** "C:Documents and SettingsDean gDesktopleonard Tachner" <patents.pfc@aol.com>

**Date:** 5/5/2011 5:02 AM

**To:** Deanatomic

Hi Dan,

Here is a short instant message conversation I had with Leo

Deanatomic [9:37 AM]: Hi Leonard

Ltachner [9:39 AM]: What's happening?

Deanatomic [9:39 AM]: what's new asking again about the patents

Ltachner [9:41 AM]: We've submitted a second physician's statement and further statements from me and Janis at the PTO's request

Deanatomic [9:41 AM]: is that good for us?

Ltachner [9:42 AM]: It's hard to tell. But our petition is still ongoing.

Deanatomic [9:43 AM]: Would you send me a short email that I could share this information?

Ltachner [9:43 AM]: Sure

Deanatomic [9:44 AM]: Great when could you send this?

Ltachner [9:45 AM]: I'm out of the office today, but I can get to it tomorrow morning

Deanatomic [9:45 AM]: OK can I use any of the text in this IM ?

Ltachner [9:46 AM]: Oh sure.

Deanatomic [9:46 AM]: Great I am sending him something to say we will send more tomorrow

Ltachner [9:47 AM]: Very good

Dean Garraffa



16742 Burke Lane, Huntington Beach, CA 92647  
(714)-375-1433 Fax (714) 375-1435

# Petitioner's Exhibit N

Email from Tachner to Dean Garraffa  
dated 5/6/2011  
regarding status of petitions to revive

Exhibit N

**Subject:** Status

**From:** <ltachner@aol.com>

**Date:** 5/6/2011 1:44 PM

**To:** <deanatomic@aol.com>

Dean: Further to yesterday's brief communication, between mid-April and this last Monday we responded to requests for additional information from the USPTO in regard to the pending petitions. They were primarily interested in having more direct statements that Janis' illness was the cause of the problems. They specifically asked for another statement from her physician which would attribute her actions to her condition. We also submitted additional declarations from us to further describe the circumstances. I don't know whether this is newly submitted material will satisfy the USPTO, but we know that the petitions are still being considered. Leonard

# Petitioner's Exhibit O

Email from Dean Garraffa  
dated 8/31/2011  
containing IM conversation  
with Tachner

Exhibit O

**Subject:** From Dean Garraffa

**From:** "C:Documents and SettingsDean gDesktopleonard Tachner" <patents.pfc@aol.com>

**Date:** 8/31/2011 9:23 AM

**To:** <nschneider@seedmackall.com>

**CC:** <doug@atomicaquatics.com>

Hi Nick,

Please send this to Steve if you wish I just got this from Tachner it's the latest information.

**Deanatomic [1:38 PM]:** Hi Leonard,

**Ltachner [1:38 PM]:** Hi

**Deanatomic [1:39 PM]:** I have some questions about atomic 1

**Ltachner [1:39 PM]:** Go

**Deanatomic [1:40 PM]:** Buyer said the patent office has now fully rejected all of your requests is this true?

**Ltachner [1:43 PM]:** We have a call into the petitions branch examiner to inquire directly from horse's mouth. PTO web site has no such indication.

**Deanatomic [1:45 PM]:** Their side said the patent office rejected meaning all of the petitions you submitted.

**Deanatomic [1:47 PM]:** We need to see the hard copy but they will not send it to me I went to the USPTO site and there are many documents

**Deanatomic [1:47 PM]:** documents sorry!

**Ltachner [1:48 PM]:** I'll email you what we can see.

**Deanatomic [1:49 PM]:** <http://portal.uspto.gov/external/portal/pair> here is where I went

**Deanatomic [1:52 PM]:** I have a document that says petition is dismissed Have you seen this it's dated feb22

**Deanatomic [1:53 PM]:** ???

**Ltachner [1:56 PM]:** Feb 22 was date of initial refusal to which we responded in April with additional information. That April resubmission is what we're waiting for a decision on.

**Ltachner [1:58 PM]:** Just emailed you log showing April date.

Will do

In a message dated 8/31/2011 2:13:11 P.M. Pacific Daylight Time, Deanatomic@aol.com writes:

Hi Leonard,

Their side is requesting a second opinion we need to hire and submit his findings by today or tomorrow.

Please send your guy in to the Patent office as my urgent request to save our Atomic 1 and Atomic 2.

As the top priority.

*Dean Garraffa*



**16742 Burke Lane, Huntington Beach, CA 92647**  
**(714)-375-1433 Fax (714) 375-1435**

---

Attachment not found: C:\Documents and Settings\Dean g\My Documents\log-patent-actions.pdf



# Petitioner's Exhibit P

Affidavit of Dean R. Garraffa

Exhibit P

**DECLARATION OF DEAN R. GARRAFFA**  
**SUPPORTING REINSTATEMENT OF U.S. PATENT**  
**NOS. 5,678,541; 5,803,073; 6,463,640 and 6,761,163**

I, Dean R. Garraffa, declare that I have direct knowledge of all facts set forth in this Declaration and:

1. I am the sole inventor of the subject matter claimed in U.S. Patent No. 5,678,541 (the "Subject Patent").
2. I am one of two founders of Atomic Aquatics (hereinafter "Atomic"), an S-corporation founded in the state of California in 1996, the other founder being Douglas J. Toth.
3. In 2011 Atomic was reorganized as a limited liability company in the state of Delaware, which organization continues to this day. I am the President of Atomic, and Douglas J. Toth acts in the position of Vice President.
4. During the period of 1995 until the present year, Atomic has engaged the services of Patent Attorney Leonard Tachner ("Tachner") for substantially all of its patent prosecution and maintenance needs, including the maintenance of U.S. Patents 5,678,541; 5,803,073; 6,463,640; 6,761,163; 7,188,869; 7,181,778; 7,686,032; 7,704,015 and 7,712,793 (the "Atomic Patents").
5. At all times, Atomic has considered the scheduling and payment of patent maintenance fees to be administrative, but vital acts best performed by a reliable entity regularly engaged in that practice.
6. At the time of the issuance of the first of the Atomic Patents in 1997, Atomic had discussed the payment of maintenance fees. At about that time, Atomic gave instructions to Tachner to manage the maintenance fees of patents issuing while in Tachner's care, advising and invoicing Atomic as needed, which Tachner agreed to do.
7. At no time has Atomic instructed Tachner not to pay a maintenance fee, and Atomic expected that Tachner would inform Atomic of any actions or moneys needed to maintain all of the Atomic Patents in force.
8. Atomic received an invoice from Tachner dated August 1, 2000 including charges of "government fees" of \$1440 for the "Payment of yearly renewal" in the European Patent Office for two patent applications. Atomic paid those fees to Tachner using check no. 5205 dated 8/15/00.
9. Atomic received an invoice from Tachner dated Oct. 22, 2001 including charges of "government fees" of \$440 for the "Payment of first annuity in the U.S. Patent and Trademark Office for Patent No. 5,678,541". Atomic paid those fees to Tachner using check no. 6629 dated 11/28/01.
10. Atomic continued to receive invoices from Tachner as work was performed in patent matters from 2002 through 2010, which Atomic timely paid.

11. In November of 2010 and for the purpose of providing for an evaluation of the intellectual property of Atomic for potential investors, Atomic requested of Tachner a detailed status of the Atomic Patents. On Nov. 24, 2010, Atomic received from Tachner a status report of matters in his care, detailing the status of the Atomic Patents. In that report Atomic received its first notice that the maintenance fees for Patent Nos. 5,678,541; 5,803,073; 6,463,640 and 6,761,163 (hereinafter the "Lapsed Patents") had not been paid and these patents had lapsed.

12. Upon learning of the lapsed status of the Lapsed Patents on Nov. 24, 2010, Atomic immediately contacted Tachner and inquired what could be done to reinstate the Lapsed Patents.

13. On Nov. 29, 2010, I received an email from Tachner informing me that his secretary had had a "meltdown" of some kind that caused the failure of the payment of the maintenance fees for the Lapsed Patents.

14. By Dec. 2, 2010, Tachner informed me that he was working on papers to be filed to revive the Lapsed Patents. I remained in regular contact with Tachner about the preparation of those papers.

15. On Dec. 7, 2010, Tachner informed me that he was making progress in the preparation of the papers to revive the Lapsed Patents.

16. Atomic was informed no later than Jan. 11, 2011 that petitions had been filed to accept late payment of the maintenance fees in each of the Lapsed Patents on Dec. 22, 2010 and Dec. 31, 2010. Atomic was not provided with copies of these petitions nor any supporting documentation.

17. Atomic was informed by Tachner on Feb. 2, 2011 that the petitions to revive filed in each of the Lapsed Patents had not yet been decided upon.

18. On about May 5, 2011, Atomic was informed by Tachner that the petitions to revive in each of the Lapsed Patents were "ongoing", the "petitions were still being considered", and further that the U.S. Patent and Trademark Office had requested additional information.

19. From a source other than Tachner, I learned that he had filed subsequent requests/petitions dated and transmitted between April 11 and April 22, 2011 in each of the Lapsed Patents.

20. Atomic did not learn of the Decisions On Petition mailed in Feb. of 2011 in each of the Lapsed Patents denying the acceptance of the late maintenance fees and reinstatement until August of 2011 when informed by its investor.

21. Prior to August of 2011 and not until learning of the Feb. 2011 Decisions, I had no reason to believe that Leonard Tachner was providing misinformation regarding the status of the Lapsed Patents, nor had I any reason to believe that Tachner was not providing competent service.

22. Neither I nor Atomic knew of the allegations of deception and misconduct made against Tachner by the Crank Brothers, Physical Optics Corporation or any other prior to October of 2011.

23. Tachner has yet to inform Atomic of the Request for Information mailings of Oct. 6, 2011 in each of the Lapsed Patents suggesting misconduct on the part of Tachner and/or his employees.

24. I did not learn of the Request for Information mailings dated Oct. 6, 2011 in each of the Lapsed patents prior to October 18, 2011. I learned about these mailings through agents of our investor.

25. As of Nov. 15, 2011, I was not aware that there was no petition to revive pending against any of the Lapsed Patents.

26. Prior to Nov. 24, 2010, Atomic had never received any notification of the lapsing of any of the Atomic Patents, including the lapsing of the '541 Patent in 2001.

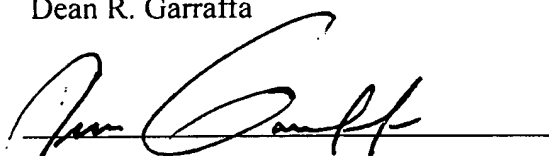
27. At any time, had Atomic had notice of the expiration of any of the Lapsed Patents, from Tachner or otherwise, it would have taken immediate action to revive them.

28. I have reviewed the two invoices dated Oct. 22, 2001 and Aug. 1, 2000 with the accompanying copies of the checks used to pay them appearing in the Exhibits, and the email messages from or from me dated 11/29/2010, 12/2/2010, 12/7/2010, 1/11/2001, 2/10/2011, 5/5/2011, 5/6/2011, and 8/31/2011 also appearing in the Exhibits, and report that they are accurate representations of their respective communications.

29. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the Atomic Patents, of which the Subject Patent is one.

Name: Dean R. Garraffa

Signature:



Date:

12-6-2011

# Petitioner's Exhibit Q

Affidavit of Douglas J. Toth

Exhibit Q

**DECLARATION OF DOUGLAS J. TOTH**  
**SUPPORTING REINSTATEMENT OF U.S. PATENT**  
**NOS. 5,678,541; 5,803,073; 6,463,640 and 6,761,163**

I, Douglas J. Toth, declare that I have direct knowledge of all facts set forth in this Declaration and:

1. I am the sole inventor of the subject matter claimed in U.S. Patent Nos. 5,803,073, 6,463,640 and 6,761,163 (the "Subject Patents").
2. I am one of two founders of Atomic Aquatics (hereinafter "Atomic"), an S-corporation founded in the state of California in 1996, the other founder being Dean R. Garraffa.
3. In 2011 Atomic was reorganized as a limited liability company in the state of Delaware, which organization continues to this day. I am the Vice President of Atomic, and Dean R. Garraffa acts in the position of President.
4. During the period of 1995 until the present year, Atomic has engaged the services of Patent Attorney Leonard Tachner ("Tachner") for substantially all of its patent prosecution and maintenance needs, including the maintenance of U.S. Patents 5,678,541; 5,803,073; 6,463,640; 6,761,163; 7,188,869; 7,181,778; 7,686,032; 7,704,015 and 7,712,793 (the "Atomic Patents").
5. At all times, Atomic has considered the scheduling and payment of patent maintenance fees to be administrative, but vital acts best performed by a reliable entity regularly engaged in that practice.
6. At the time of the issuance of the first of the Atomic Patents in 1997, Atomic had discussed the payment of maintenance fees. At about that time, Atomic gave instructions to Tachner to manage the maintenance fees of patents issuing while in Tachner's care, advising and invoicing Atomic as needed, which Tachner agreed to do.
7. At no time has Atomic instructed Tachner not to pay a maintenance fee, and Atomic expected that Tachner would inform Atomic of any actions or moneys needed to maintain all of the Atomic Patents in force.
8. Atomic received an invoice from Tachner dated August 1, 2000 including charges of "government fees" of \$1440 for the "Payment of yearly renewal" in the European Patent Office for two patent applications. Atomic paid those fees to Tachner using check no. 5205 dated 8/15/00.
9. Atomic received an invoice from Tachner dated Oct. 22, 2001 including charges of "government fees" of \$440 for the "Payment of first annuity in the U.S. Patent and Trademark Office for Patent No. 5,678,541". Atomic paid those fees to Tachner using check no. 6629 dated 11/28/01.
10. Atomic continued to receive invoices from Tachner as work was performed in patent matters from 2002 through 2010, which Atomic timely paid.

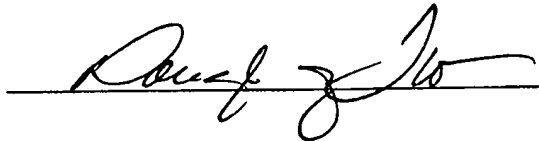
11. In November of 2010 and for the purpose of providing for an evaluation of the intellectual property of Atomic for potential investors, Atomic requested of Tachner a detailed status of the Atomic Patents. On Nov. 24, 2010, Atomic received from Tachner a status report of matters in his care, detailing the status of the Atomic Patents. In that report Atomic received its first notice that the maintenance fees for Patent Nos. 5,678,541; 5,803,073; 6,463,640 and 6,761,163 (hereinafter the "Lapsed Patents") had not been paid and these patents had lapsed.
12. Upon learning of the lapsed status of the Lapsed Patents on Nov. 24, 2010, Atomic immediately contacted Tachner and inquired what could be done to reinstate the Lapsed Patents.
13. Atomic was informed no later than Jan. 11, 2011 that petitions had been filed to accept late payment of the maintenance fees in each of the Lapsed Patents on Dec. 22, 2010 and Dec. 31, 2010. Atomic was not provided with copies of these petitions nor any supporting documentation.
14. Atomic was informed by Tachner on Feb. 2, 2011 that the petitions to revive filed in each of the Lapsed Patents had not yet been decided upon.
15. From a source other than Tachner, I learned that he had filed subsequent requests/petitions dated and transmitted between April 11 and April 22, 2011 in each of the Lapsed Patents.
16. Atomic did not learn of the Decisions On Petition mailed in Feb. of 2011 in each of the Lapsed Patents denying the acceptance of the late maintenance fees and reinstatement until August of 2011 when informed by its investor.
17. Prior to August of 2011 and not until learning of the Feb. 2011 Decisions, I had no reason to believe that Leonard Tachner was providing misinformation regarding the status of the Lapsed Patents, nor had I any reason to believe that Tachner was not providing competent service.
18. Neither I nor Atomic knew of the allegations of deception and misconduct made against Tachner by the Crank Brothers, Physical Optics Corporation or any other prior to October of 2011.
19. Tachner has yet to inform Atomic of the Request for Information mailings of Oct. 6, 2011 in each of the Lapsed Patents suggesting misconduct on the part of Tachner and/or his employees.
20. I did not learn of the Request for Information mailings dated Oct. 6, 2011 in each of the Lapsed patents prior to October 18, 2011. I learned about these mailings through agents of our investor.
21. As of Nov. 15, 2011, I was not aware that there was no petition to revive pending against any of the Lapsed Patents.
22. Prior to Nov. 24, 2010, Atomic had never received any notification of the lapsing of any of the Atomic Patents, including the lapsing of the '541 Patent in 2001.
22. At any time, had Atomic had notice of the expiration of any of the Lapsed Patents, from Tachner or otherwise, it would have taken immediate action to revive them.

23. For one matter under the docket identifier of "Atomic 16desB", I had made inquiries as to the status of this application. Atomic was invoiced for the filing of this application, which Atomic paid, and upon inquiry Tachner's assistant would report that the Patent Office is just slow. I later learned that this application was never filed.

24. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the Atomic Patents, of which the Subject Patent is one.

**Name:** Douglas J. Toth

**Signature:**

A handwritten signature in cursive script, appearing to read "Doug J Toth", written over a horizontal line.

**Date:**

12-6-11



# Petitioner's Exhibit R

Affidavit of Everett D. Robinson

Exhibit R

**THE DECLARATION OF EVERETT D. ROBINSON**  
**SUPPORTING REINSTATEMENT OF U.S. PATENT**  
**NOS. 5,678,541; 5,803,073; 6,463,640 and 6,761,163**

I, Everett D. Robinson, declare that I have direct knowledge of all facts set forth in this Declaration and:

1. I am an attorney licensed to practice in the State of Utah and registered to practice with the U.S. Patent and Trademark Office under registration no. 50,911.

2. On September 19, 2011 I was first introduced to U.S. Patent Nos. 5,678,541; 5,803,073; 6,463,640; and 6,761,163 (hereinafter the "Lapsed Patents") through a request to investigate the status of those Patents and others on a schedule provided to me for Atomic Aquatics. I responded to that request by September 27, 2011 with a report that these Patents had expired due to nonpayment of maintenance fees.

3. On September 27, 2011 I participated in a telephone conference with Mr. Mark Frederickson and Mr. Jon Christensen, both attorneys acting on behalf of Atomic Aquatics, to discuss these Lapsed Patents. Our discussion included the possibility of revival of the Lapsed Patents, and the difficulty of such revivals under the "unavoidable" standard of 37 CFR 1.378(b).

4. On September 28, 2011 I was asked to perform a study into the feasibility of reviving the Lapsed Patents. I conducted that research in federal caselaw and through other large compilations of correspondence histories with the Office of Petitions available on the Internet and reported to Messrs. Frederickson and Christensen by October 18, 2011.

5. Between October 18 and 26, 2011 I received from Messrs. Frederickson and Christensen compilations prepared at my request of correspondence between Leonard Tachner and Atomic Aquatics.

6. On November 2, 2011 I had reviewed the compilations provided in October and reported back with further requests for information.

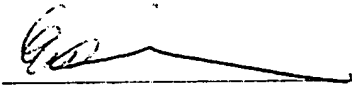
7. On November 8, 2011 I conversed with Mark Frederickson over the telephone about further information to be supplied in support of petitions to revive, and sent to him some questions for Atomic Aquatics principals to answer in preparation for the petitions of revival for the Lapsed Patents and declarations thereof.

8. On November 14, 2011 I received answers to my questions of November 8 prepared by Dean R. Garraffa and Douglas J. Toth. I returned to Messrs. Garraffa and Toth some further questions, which were responded to on Nov. 15, 2011 with copies of invoices from Leonard Tachner containing charges for the payment of maintenance fees and annuities.

9. Since November 23, 2011 I have been regularly drafting the petition papers to revive the Lapsed Patents.

10. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the Atomic Patents, of which the Subject Patent is one.

**Name:** Everett D. Robinson

**Signature:**  \_\_\_\_\_

**Date:** Dec. 12, 2011

# Petitioner's Exhibit S

Decision in In re Georgialis,  
Pat. No. 4,740,967  
May 12, 2005

Exhibit S



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
WWW.USPTO.GOV

Paper No. 22

NICHOLAS C. GEORGALIS  
6981 IVANDALE  
INDEPENDENCE OH 44131

**COPY MAILED**

MAY 12 2005

**OFFICE OF PETITIONS**

In re Application of :  
NICHOLAS C. GEORGALIS :  
Application No. 07/043,863 :  
Patent No. 4,740,967 :  
Filed: January 7, 1987 :  
Issue Date: April 26, 1988 :  
Title: DISPERSED SWITCHING :  
TELECOMMUNICATION SYSTEM :

DECISION ON RENEWED PETITION  
UNDER 37 C.F.R. §1.378(E)

This is a decision on the renewed petition filed November 16, 2004, under 37 C.F.R. §1.378(e), requesting reconsideration of a prior decision pursuant to 37 C.F.R. §1.378(b)<sup>1</sup>, which refused to accept the delayed payment of two maintenance fees for the above-referenced patent. On December 14, 2004, Petitioner submitted supplemental material.

The request to accept the delayed payment of the maintenance fee is **DENIED**<sup>2</sup>.

The patent issued April 26, 1988. The grace period for paying the 7½ year maintenance fee<sup>3</sup> provided in 37 CFR 1.362(e) expired at midnight on April 26, 1996, with no payment received. Accordingly, the patent expired at midnight on April 26, 1996.

<sup>1</sup> Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. §1.378(b) must include:

- (1) The required maintenance fee set forth in 37 C.F.R. §1.20 (e) through (g);
- (2) The surcharge set forth in 37 C.F.R. §1.20(i)(1), and;
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

<sup>2</sup> This decision may be regarded as a final agency action within the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

<sup>3</sup> The PTO's Patent Location and Monitoring System software does not show that the 3½ year maintenance fee was received. However, Petitioner has submitted evidence on renewed petition by way of a Maintenance Fee Statement, mailed by the Office on November 14, 1991, which establishes that this maintenance fee was paid.

With the original petition submitted on October 1, 2004 under 37 C.F.R. §1.378(b), Petitioner submitted payment in the amount of \$455, \$1045, and \$1610 for the delayed payment of the required 3½ year, 7½ year, and 11½ year maintenance fees, respectively, as well as the surcharge associated with the filing of this petition.

The application issued on April 26, 1988. Petitioner asserted that due to financial hardship, he was unable to submit the required maintenance fees until the present time.

To establish unavoidable delay, Petitioner submitted a statement of facts where Petitioner asserted financial hardship. A decision was mailed on November 15, 2004 which dismissed the petition for failing to establish that the delay was unavoidable in that Petitioner failed to submit a complete and thorough showing of his financial condition during the entire period between April 26, 1996 and the date on which the petition was submitted.

With the instant petition pursuant to 37 C.F.R. §1.378(e), Petitioner has again failed to meet the requirement under 37 C.F.R. §1.378(b)(3) of an adequate showing that the delay was unavoidable. A discussion follows.

### **The standard**

35 U.S.C. §41(c)(1) states:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>4</sup> is shown to the satisfaction of the Director to have been unavoidable.

§1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business<sup>5</sup>.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>6</sup> Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>7</sup>

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<sup>4</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. §1.378(b).

<sup>5</sup> *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), *aff'd*, 143 U.S.P.Q. 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913).

<sup>6</sup> *Smith v. Mossinghoff*, 671 F.2d at 538, 213 U.S.P.Q. at 982.

An adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 C.F.R. §1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action<sup>8</sup>.

Presuming for the purposes of discussion that it was an act/omission of Counsel that contributed to any of the delay herein, the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client<sup>9</sup> in the absence of evidence that the attorney/agent has acted to deceive the client.<sup>10</sup>

### **The portions of the MPEP relevant to the facts as presented**

#### **2504 Patents Subject to Maintenance Fees**

##### **37 CFR 1.362. Time for payment of maintenance fees.**

- (a) Maintenance fees as set forth in §§ 1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.
- (b) Maintenance fees are not required for any plant patents or for any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.
- (c) The application filing dates for purposes of payment of maintenance fees are as follows:
  - (1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.
  - (2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.
  - (3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing

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<sup>7</sup> Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

<sup>8</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

<sup>9</sup> The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962). The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

<sup>10</sup> When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

- application.
- (4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original non-reissue application on which the patent reissued is based.
  - (5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.
- (d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:
- (1) 3 years through 3 years and 6 months after grant for the first maintenance fee,
  - (2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and
  - (3) 11 years through 11 years and 6 months after grant for the third maintenance fee.
- (e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:
- (1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.
  - (2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and
  - (3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.
- (f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.
- (g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.
- (h) The periods specified in § 1.362 (d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.

Maintenance fees are required to be paid on all patents based on applications filed on or after December 12, 1980, except for plant patents and design patents. Furthermore, maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees. Application filing dates for purposes of determining whether a patent is subject to payment of maintenance fees are as follows:

- (A) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.
- (B) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119(a)-(d), the actual United States filing date of the application.
- (C) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.
- (D) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original nonreissue application on which the patent reissued is based.
- (E) For an international application that has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

#### 2506 Times for Submitting Maintenance Fee Payments

37 CFR 1.362(d) sets forth the time periods when the maintenance fees for a utility patent can be paid without surcharge. Those periods, referred to generally as the "window period," are the 6-month periods preceding each due date. The "due dates" are defined in 35 U.S.C. 41(b). The window periods are (1) 3 years to 3 1/2 years after the



date of issue for the first maintenance fee payment, (2) 7 years to 7 1/2 years after the date of issue for the second maintenance fee payment, and (3) 11 years to 11 1/2 years after the date of issue for the third and final maintenance fee payment. A maintenance fee paid on the last day of a window period can be paid without surcharge. The last day of a window period is the same day of the month the patent was granted 3 years and 6 months, 7 years and 6 months, or 11 years and 6 months after grant of the patent. 37 CFR 1.362(e) sets forth the time periods when the maintenance fees for a utility patent can be paid with surcharge. Those periods, referred to generally as the "grace period," are the 6-month periods immediately following each due date. The grace periods are (1) 3 1/2 years and through the day of the 4th anniversary of the grant of the patent, (2) 7 1/2 years and through the day of the 8th anniversary of the grant of the patent and, (3) 11 1/2 years and through the day of the 12th anniversary of the grant of the patent. A maintenance fee may be paid with the surcharge on the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant to prevent the patent from expiring. Maintenance fees for a reissue patent are due based upon the schedule established for the original utility patent. The filing of a request for ex parte or inter partes reexamination and/or the publication of a reexamination certificate does not alter the schedule of maintenance fee payments of the original patent. If the day for paying a maintenance fee falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee may be paid on the next succeeding day that is not a Saturday, Sunday, or Federal holiday. For example, if the window period for paying a maintenance fee without a surcharge ended on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee can be paid without surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia. Likewise, if the grace period for paying a maintenance fee with a surcharge ended on a Saturday, Sunday, or a Federal holiday within the District of Columbia, the maintenance fee can be paid with surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia. In the latter situation, the failure to pay the maintenance fee and surcharge on the next succeeding day that is not a Saturday, Sunday, or a Federal holiday within the District of Columbia will result in the patent expiring on a date (4, 8, or 12 years after the date of grant) earlier than the last date on which the maintenance fee and surcharge could be paid. This situation results from the provisions of 35 U.S.C. 21, but those provisions do not extend the expiration date of the patent if the maintenance fee and any required surcharge are not paid when required. For example, if the grace period for paying a maintenance fee with a surcharge ended on a Saturday, the maintenance fee and surcharge could be paid on the next succeeding business day, e.g., Monday, but the patent will have expired at midnight on Saturday if the maintenance fee and surcharge were not paid on the following Monday. Therefore, if the maintenance fee and any applicable surcharge are not paid, the patent will expire as of the end of the grace period as listed above. A patent that expires for failure of payment will expire on the anniversary date the patent was granted in the 4th, 8th, or 12th year after the grant.

### **Application of the standard to the current facts and circumstances**

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fee and surcharge based on unavoidable delay.

In the original petition under 37 C.F.R. §1.378(b), submitted October 1, 2004, Petitioner set forth that he was not able to pay the maintenance fees at the time which they were due. In the decision mailed November 15, 2004, Petitioner was instructed to submit a complete and thorough showing of his financial condition during the entire period of delay.

With the renewed petition, Petitioner has supplied a rather voluminous packet of information containing, among other things, a statement of facts, charts showing cash flows from 1991 - 1995, a Net Worth Table spanning from 1987 - 2003, a receipt which confirms submission of the 3½ year maintenance fee, tax returns for 1991 - 1995, end of year bank statements for this same time period, a listing of home mortgage payments from 1991 - 2004, end of year credit card

summaries for 1991 – 1995 and 2002, utility payments for 2004, a summary of Petitioner's severance pay and pension buyout, and a personal statement of benefits from Petitioner's former employer.

As set forth in the previous decision, Petitioner should be made aware that the standard associated with the filing of a petition under the unavoidable standard is extremely difficult to meet.

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fees and surcharge, for the reasons which follow<sup>11</sup>.

Petitioner has not made an adequate showing that the failure to pay the maintenance fee was unavoidable, given the exercise of due care. The period for paying the 7½ year maintenance fee without the surcharge extended from April 26, 1995 to October 26, 1995, and for paying with the surcharge from October 27, 1995 to April 26, 1996. Thus, the delay in paying the 7½ year maintenance fee extended from April 27, 1996 to the filing of the petition on October 1, 2004.

The entire period of delay is the relevant period:

Petitioner states that he does not agree that the entire period of the delay should be considered, but rather the only time that is relevant is the time when the maintenance fee was due. Petitioner states that if the Office were to consider only the period following the date the maintenance fee was due would be to provide "no rational basis for explaining why the maintenance fee was not paid at the time that it was due thereby making the delay in payment unavoidable in the first instance<sup>12</sup>." Petitioner is reminded that the statute, 35 U.S.C. 41(c)(1) cited above, requires that the delay in submitting the maintenance fee was unavoidable. By definition, the delay inherently includes the period following the date the maintenance fee was due. Petitioner's argument is inconsistent with the statute. See also MPEP 711.03(c) and 37 C.F.R. §1.378(b)(3), which requires

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. (Emphasis added).

Since the petition which Petitioner has filed requires a showing that the delay was unavoidable, Petitioner is required to establish that he could not submit the maintenance fees from the time

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<sup>11</sup> See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>12</sup> Supplement to renewed petition, page 2.

that they were due until the time that they were eventually submitted to the Office. Put another way, Petitioner is required to establish that the entire period of delay was unavoidable.

Petitioner argues, inter alia, "that it is unreasonable to expect that [a "financial hardship"] standard can be met for the entire period [from 1995 to 2004];" that "the standard will always lead to a denial of the petition, hence thwart the intent of the law," and that the "effect of high standards relating to unavoidable delay of maintenance fees required by the Patent Office is to deny permanently the property rights of an inventor granted under the Patent Law and the United States." Petitioner asserts that the standard applied by the Office is arbitrary and capricious.<sup>13</sup> Unfortunately for Petitioner, the heavy burden necessary to establish that a delay was unavoidable is precisely what Congress required when 35 U.S.C. §41(c) was enacted. See 49 FR34716: "The legislative history of Pub. L. 97-247, House Report. 47-542 (Committee of the Judiciary) which indicates that "[a]fter the expiration of a reasonable period of time, the patentee would bear a heavy burden of proof that the delay was unavoidable." It was because of the difficulty in satisfying the standard that prompted Congress, in 1992, to amend 35 U.S.C. §41(c) to include the lesser standard of "unintentional" delay, subject to the 24 month time period. See House Report 102-993 ("The 'unavoidable' standard has proved to be too stringent in many cases. Many patentees have been deprived of their patent rights in failure to [pay the maintenance fees for reasons that may have been unintentional yet not avoidable."])

Petitioner has failed to address the entire period of the delay, and it is not clear why Petitioner waited until recently to submit his maintenance fees. The 7½ year and 11½ year maintenance fees, at the time which they were due, were \$995 and \$1455, respectively. As will be shown below, Petitioner was clearly financially capable of making these payments.

The issue of affordability/financial hardship:

Petitioner has alleged that he was unable to submit the maintenance fees for the above-identified patent. Petitioner has a wife and four children, and was employed by the local phone company as an engineer and manager until he was laid off in September of 1994. At the time of his layoff, Petitioner received \$50,000 after taxes.

In 1995, Petitioner's daughter transferred to Cleveland State University after spending a year at Ohio State University, and Petitioner assisted her in her expenses<sup>14</sup>.

In 1997, Petitioner paid for his oldest son to attend Case Western Reserve University, the cost of which Petitioner estimated at \$20,000 per year. It is assumed that his son attended the school for four years<sup>15</sup>. This same year, Petitioner purchased a new car for \$23,000<sup>16</sup>. Petitioner also makes mention of expenses for a "long planned vacation to Greece<sup>17</sup>." Petitioner's "End of Year Credit Card Summary for 2002" shows, inter alia, credit card charges to restaurants totaling over

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<sup>13</sup> Id.

<sup>14</sup> Renewed petition, page 4.

<sup>15</sup> Id.

<sup>16</sup> Id. at page 8.

<sup>17</sup> Id.

\$5000, retail charges of over \$11,000, lodging and airfare charges over \$3000, miscellaneous charges over \$6,000, etc.

Petitioner explains:

these expenses along with my diminished prospects about my future retirement as well as the expectation of at least 13 more years of college payments<sup>18</sup> played a pivotal role in my decision regarding the payment of maintenance fees in 1995.

Renewed petition, page 5.

Clearly, Petitioner had the means to submit the maintenance fee, but allocated these funds to other sources. Petitioner has reported his net worth for the years 1996 and 1997 as \$311,634 and \$333,973, respectively. A net worth amount of \$201,915 appears to be indicated for year 2002, though the data in this column appears incomplete. It is noted that Petitioner has not reported his present net worth, or the net worth for years 1998-2001 or 2003.

In the supplement to the petition, received on December 14, 2004, Petitioner states that he is not asserting financial hardship, which Petitioner understands as implying that he must show that he was in bankruptcy in the entire period, but rather that when he was laid off, his perception of his future net worth diminished<sup>19</sup>. As such, Petitioner asserts that the standard should not be financial hardship, but rather affordability, and as such, "the projected loss of net worth can be used to make a reasonable judgment regarding the ability to pay the maintenance fee at the time that it was due and thereafter as well<sup>20</sup>." In other words, Petitioner realized that he would not have as much money in the future as he once thought that he might, and as such, present spending had to be curtailed so as to prepare for the diminishment in his perceived future net worth. Petitioner adds that his case is unique in that his business interests and his family interests are bound together. Every person with a family has business interests which cannot be separated from his family interests.

Petitioner has asserted that he simply could not afford to pay the \$995 maintenance fee in 1996 and the \$1455 maintenance fee in 2000. However, Petitioner has made it clear that he was able to afford to send his son to a rather expensive university, he was able to afford the purchase of a brand new car, he was able to afford a trip to Europe, he was able to eat out at restaurants and stay at hotels, etc. This, coupled with the fact that his net worth was hundreds of thousands of dollars, suggests that Petitioner had the \$995 in 1996 and the \$1455 in 2000, had he chose to spend it. It is clear that Petitioner could have submitted the payments, but chose not to, since he had other priorities which were placed above the maintenance of this patent.

On page 4 of the supplement to the renewed petition under 37 C.F.R. §1.378(e), Petitioner correctly sets forth that the standard adopted by the courts is that of a reasonably prudent person acting in relation to their most important business. Petitioner then immediately writes that the

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<sup>18</sup> There were still two younger children who would eventually be attending college.

<sup>19</sup> Supplement, page 2.

<sup>20</sup> Id.

payment of the maintenance fee was not his most important business<sup>21</sup>. As such, Petitioner has set forth that he cannot meet the standard required under this rule, in that he has set forth that paying his current debts, paying his mortgage, food, clothing, fuel, utilities, taxes, insurance, home and car maintenance, entertainment, saving for college tuition, saving for his retirement, contributing to his church, and contributing to charities are each more important to him than his patent. As such, Petitioner has not treated this patent as his most important business, because he has other obligations which are more important to him. As stated above, the failure of a patentee to treat his patent as his most important business precludes the granting of a petition under 37 C.F.R. §1.378(e).

Furthermore, Petitioner has set forth that if this petition is denied, that would have the effect of the PTO reordering his personal priorities through beauracatic fiat<sup>22</sup>. Such is not the case. The reasonably prudent person standard recited above comes not from beauracatic fiat, but rather from judicial decree interpreting the statutory requirements that the delay be "unavoidable"<sup>23</sup>.

Finally, as stated above, Petitioner had the means to pay the maintenance fee, but chose to allocate his financial resources to other matters. Petitioner has set forth that he believed that failure to submit the maintenance fee in a timely fashion would result in the patent becoming dormant, but not expired<sup>24</sup>. As such, Petitioner was clearly misinformed, and this belief indicates a lack of understanding of the consequences which befall patentees when maintenance fees are not timely paid. The lack of knowledge pertaining to failure to submit maintenance fees will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office, and as such, a lack of understanding cannot be used to support a finding that the delay was "unavoidable"<sup>25</sup>.

## CONCLUSION

The prior decision which refused to accept, under 37 C.F.R §1.378(b), the delayed payment of a maintenance fee for the above-identified patent, has been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. §1.378(b).

Since this patent will not be reinstated, Petitioner is entitled to a refund of the surcharge and the three maintenance fees he submitted with the original petition. The \$130 fee associated with the filing of a renewed petition under 37 C.F.R. §1.378(e) will not be refunded. A treasury check will be issued in due course.

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<sup>21</sup> Id. at 5.

<sup>22</sup> Id.

<sup>23</sup> In re Mattullath, *supra*.

<sup>24</sup> Supplemental petition, page 5.

<sup>25</sup> See In re Sivertz, *supra*.

Telephone inquiries should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

A handwritten signature in dark ink, appearing to read "Charles Pearson". The signature is fluid and cursive, with the first name "Charles" and the last name "Pearson" clearly distinguishable.

Charles Pearson

Director

Office of Petitions

United States Patent and Trademark Office

# Petitioner's Exhibit T

Decision in In re Tan,  
Pat. No. 5,290,273  
March 7, 2008

Exhibit T



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
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Paper No. 12

DAVID PRASHKER, P.C., COUNSELOR AT LAW  
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**MAR 07 2008**

**OFFICE OF PETITIONS**

In re Application of	:	
Oon T. Tan	:	
Application No. 08/066,875	:	
Patent No. 5,290,273	:	DECISION ON RENEWED PETITION
Filed: May 25, 1993	:	PURSUANT TO 37 C.F.R.
Issue Date: March 1, 1994	:	§ 1.378(E)
Attorney Docket Number:	:	
TAN001CIP	:	
Title: LASER TREATMENT METHOD	:	
FOR REMOVING PIGMENT CONTAINING	:	
LESIONS FROM THE SKIN OF A	:	
LIVING HUMAN	:	

This is a decision on the renewed petition filed on October 1, 2007, pursuant to 37 C.F.R. § 1.378(e)<sup>1</sup> requesting reconsideration of a prior decision pursuant to 37 C.F.R.

<sup>1</sup> Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) The required maintenance fee set forth in 37 C.F.R. §1.20 (e) through (g);
- (2) The surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became



§ 1.378(b), which refused to accept the delayed payment of maintenance fees for the above-referenced patent. The request to accept the delayed payment of the maintenance fee is **DENIED**<sup>2</sup>.

The patent issued on March 1, 1994. The grace period for paying the 7½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on March 1, 2002, with no payment received. Accordingly, the patent expired on March 1, 2002 at midnight.

Mr. Tan is the inventor. The Assignee is a corporate entity by the name of Cynosure, Inc. (Cynosure). The Petitioner is a member of the law firm Hamilton, Brook, Smith & Reynolds (HBSR).

An original petition pursuant to 37 C.F.R. § 1.378(b) was filed on November 6, 2006 to reinstate the above-identified patent. This petition was dismissed via the mailing of a decision on August 1, 2007, for failure to establish that the entire period of delay was unavoidable.

Petitioner has submitted, *inter alia*, the surcharge associated with a petition to accept late payment of a maintenance fee as unavoidable, the 7½ and 11½-year maintenance fees, a statement of facts, and the surcharge that is associated with the filing of this renewed petition.

Petitioner has met the first and second requirements set forth in 37 C.F.R. § 1.378(b). A discussion of the third requirement follows.

#### The standard

35 U.S.C. § 41(c)(1) states:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>3</sup> is shown to the satisfaction of the Director to have been unavoidable.

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aware of the expiration of the patent, and the steps taken to file the petition promptly.

<sup>2</sup> This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704 for the purposes of seeking judicial review. See MPEP § 1002.02.

§1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business<sup>4</sup>.

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable<sup>5</sup>."

An adequate showing that the delay in payment of the maintenance fee at issue was unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 C.F.R. § 1.378(b).

The burden of showing the cause of the delay is on the person seeking to revive the application<sup>6</sup>.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the

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<sup>3</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. §1.378(b).

<sup>4</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

<sup>5</sup> Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

<sup>6</sup> Id.

MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action<sup>7</sup>.

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions<sup>8</sup>. Specifically, a petitioner's delay caused by the mistakes of negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133<sup>9</sup>.

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney"<sup>10</sup>.

Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions"<sup>11</sup>.

Presuming for the purposes of discussion that it was an act/omission of Counsel that contributed to any of the delay herein, the act(s) or omissions of the attorney/agent are imputed wholly to the applicant/client<sup>12</sup> in the absence of

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7 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

8 Link v. Wabash, 370 U.S. 626, 633-634 (1962).

9 Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

10 Link at 633-634.

11 Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983). See also, Wei v. State of Hawaii, 763 F.2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983).

12 The actions or inactions of the attorney/agent must be imputed to the petitioners, who hired the attorney/agent to represent them. Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962). The failure of a party's attorney to take a required action or to notify the party of its rights does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

evidence that the attorney/agent has acted to deceive the client.<sup>13</sup>

Moreover, Link sets forth:

"[I]f an attorney's conduct fails substantially below what is reasonable under the circumstances, the client's remedy is against the attorney in a suit for malpractice. But keeping [a] suit alive merely because plaintiff should not be penalized for the omissions of his own attorney would be visiting the sins of plaintiff's lawyer upon the defendant<sup>14</sup>."

**Portions of the Code of Federal Regulations and the MPEP  
relevant to the abandonment of this application**

**37 C.F.R. § 1.362 Time for payment of maintenance fees.**

(a) Maintenance fees as set forth in §§ 1.20(e) through (g) are required to be paid in all patents based on applications filed on or after December 12, 1980, except as noted in paragraph (b) of this section, to maintain a patent in force beyond 4, 8 and 12 years after the date of grant.

(b) Maintenance fees are not required for any plant patents or for any design patents. Maintenance fees are not required for a reissue patent if the patent being reissued did not require maintenance fees.

(c) The application filing dates for purposes of payment of maintenance fees are as follows:

(1) For an application not claiming benefit of an earlier application, the actual United States filing date of the application.

(2) For an application claiming benefit of an earlier foreign application under 35 U.S.C. 119, the United States filing date of the application.

(3) For a continuing (continuation, division, continuation-in-part) application claiming the benefit of a prior patent application under 35 U.S.C. 120, the actual United States filing date of the continuing application.

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<sup>13</sup> When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney's error, the situation is not governed by the stated rule in Link for charging the attorney's mistake to his client. In re Lonardo, 17 USPQ2d 1455 (Comm'r. Pat. 1990).

<sup>14</sup> Link at 634. See also Mekdeci v. Merrell Nat'l. Laboratories, 711 F.2d 1510, 1522-23 (11th Cir. 1983) ("There is no constitutional or statutory right to effective assistance of counsel on a civil case." . . . [A] 'party' . . . does not have any right to a new trial in a civil suit because of inadequate counsel, but has as its remedy a suit against the attorney for malpractice.") (quoting Watson v. Moss, 619 F.2d 775, 776 (8th Cir. 1980)) and Kushner v. Winterthur Swiss Ins. Co., 620 F.2d 404, 408 (3rd Cir. 1980) ("An aggrieved party in a civil case, involving only private litigants unlike a defendant in a criminal case, does not have a constitutional right to the effective assistance of counsel. The remedy in a civil case, in which chosen counsel is negligent, is an action for malpractice.").

(4) For a reissue application, including a continuing reissue application claiming the benefit of a reissue application under 35 U.S.C. 120, the United States filing date of the original non-reissue application on which the patent reissued is based.

(5) For an international application which has entered the United States as a Designated Office under 35 U.S.C. 371, the international filing date granted under Article 11(1) of the Patent Cooperation Treaty which is considered to be the United States filing date under 35 U.S.C. 363.

(d) Maintenance fees may be paid in patents without surcharge during the periods extending respectively from:

(1) 3 years through 3 years and 6 months after grant for the first maintenance fee,

(2) 7 years through 7 years and 6 months after grant for the second maintenance fee, and

(3) 11 years through 11 years and 6 months after grant for the third maintenance fee.

(e) Maintenance fees may be paid with the surcharge set forth in § 1.20(h) during the respective grace periods after:

(1) 3 years and 6 months and through the day of the 4th anniversary of the grant for the first maintenance fee.

(2) 7 years and 6 months and through the day of the 8th anniversary of the grant for the second maintenance fee, and

(3) 11 years and 6 months and through the day of the 12th anniversary of the grant for the third maintenance fee.

(f) If the last day for paying a maintenance fee without surcharge set forth in paragraph (d) of this section, or the last day for paying a maintenance fee with surcharge set forth in paragraph (e) of this section, falls on a Saturday, Sunday, or a federal holiday within the District of Columbia, the maintenance fee and any necessary surcharge may be paid under paragraph (d) or paragraph (e) respectively on the next succeeding day which is not a Saturday, Sunday, or Federal holiday.

(g) Unless the maintenance fee and any applicable surcharge is paid within the time periods set forth in paragraphs (d), (e) or (f) of this section, the patent will expire as of the end of the grace period set forth in paragraph (e) of this section. A patent which expires for the failure to pay the maintenance fee will expire at the end of the same date (anniversary date) the patent was granted in the 4th, 8th, or 12th year after grant.

(h) The periods specified in §§1.362 (d) and (e) with respect to a reissue application, including a continuing reissue application thereof, are counted from the date of grant of the original non-reissue application on which the reissued patent is based.

[49 FR 34724, Aug. 31, 1984, added effective Nov. 1, 1984; paras. (a) and (e), 56 FR 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (c)(4) and (e) revised and para. (h) added, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994]

#### Application of the standard to the current facts and circumstances

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for

acceptance of a late payment of the maintenance fee and surcharge, as set by 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3).

The arguments and exhibits submitted on renewed petition have been reviewed and considered, and they have not been deemed to be persuasive.

The period for paying the 7½-year maintenance fee without the surcharge extended from March 1, 2001 to September 1, 2001, and for paying with the surcharge from September 2, 2001 to March 1, 2002. Thus, the delay in paying the 7½-year maintenance fee extended from March 1, 2002 at midnight to the filing of the original petition on November 6, 2006.

The underlying facts are summarized as such:

- The inventor assigned all patent rights to Cynosure.
- On March 1, 1994, the present patent issued.
- At the time of issuance, Horace Furumoto was the President of Cynosure, Emanuel Crespo served as Cynosure's in-house attorney, and Cynosure relied on outside counsel (David Prashker) to track its maintenance fee payments.
- The 3½-year maintenance fee was timely submitted on November 20, 1997, along with the required surcharge, by an unknown entity.
- In 2003, Cynosure underwent a corporate restructuring, Mr. Furumoto retired, and Mr. Crespo left the company.
- Prior to the restructuring, George Cho was responsible for Cynosure's clinical studies, regulatory affairs, and quality assurances. After the corporate restructuring, he became responsible for regulatory affairs and management of Cynosure's intellectual property.
- Upon assuming responsibility for Cynosure's patents, Mr. Cho was given a list of what was intended to constitute Cynosure's entire patent portfolio. The present patent did not appear on the list, which had been had previously maintained by Mr. Crespo.
- It is not clear when Cynosure ceased using David Prashker as outside counsel, and retained the services of HBSR.

The decision on the original petition set forth that Petitioner had failed to establish that the entire period of delay was unavoidable for the following reasons:

1. It was not clear who submitted the first maintenance fee.
2. It had not been established that Mr. Prashker had any steps in place for ensuring the timely payment of the maintenance fee.
3. Petitioner had submitted a statement of facts from George Cho, however Mr. Cho does not have firsthand knowledge of "the facts involved at the time of expiration of the patent for failure to pay the second maintenance fee."
4. The decision further indicated that a statement of facts would be required from Messrs. Furumoto and Crespo, indicating why this patent was not included in the list that was presented to Mr. Cho and represented as Cynosure's complete patent portfolio. The decision also indicated that a statement of facts would be required from Mr. Prashker.

Regarding the first and second points above, it has not been determined who submitted the first maintenance fee, nor has it been established that any steps were in place for ensuring that the maintenance fee would be submitted in a timely manner.

Petitioner has set forth that "[t]he evidence suggests that Mr. Prashker did pay the first maintenance fee..."<sup>15</sup> Petitioner has further asserted "[t]he evidence furthest suggests that Mr. Prashker...had a system in place for monitoring deadlines and paying maintenance fees..."<sup>16</sup> Each assertion amounts to mere supposition and conjecture. In essence, Petitioner has based his first assumption on the fact that Mr. Prashker was acting as outside counsel at the time. The second assumption is based on the first - if Mr. Prashker submitted the first maintenance fee, then he must have had a system for tracking the maintenance fees that was reliable.

Petitioner further set forth "[w]hatever system was in place that resulted in the first maintenance fee being paid, the evidence suggests that this system failed with respect to the fee due in 2001-2002..."<sup>17</sup>

Petitioner has not described what steps, if any, Mr. Prashker had in place for ensuring the timely submission of the maintenance fee.

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<sup>15</sup> Renewed petition, page 3.

<sup>16</sup> Id. at 4.

<sup>17</sup> Id.

Petitioner has added that HBSR handled "the majority of Cynosure's patents" during "the time period relevant to this case (i.e. 2001-2002)<sup>18</sup>." The inclusion of the word "majority," coupled with the assertion regarding the failure of the system that Petitioner has asserted that Mr. Prashker had in place strongly suggests that HBSR was not in charge of tracking the maintenance fees for this patent at the time of expiration. As such, the system that HBSR had in place is not relevant to the expiration of this patent.

*Assuming arguendo* that HBSR was in charge of tracking the maintenance fees for this patent at the time of expiration, it is not clear why this maintenance fee was not timely submitted. Petitioner has described the tracking system that HBSR has in place, and has indicated that a patent is entered into the docketing system "upon receipt of the Issue Notification from the USPTO<sup>19</sup>." This patent issued in 1994. As such, it does not appear that this patent would have been entered into HBSR's docketing system, and no mention has been made of any provision for when HBSR assumes responsibility of issued patents.

Regarding the third point above, Petitioner has asserted that Mr. Cho is "directly knowledgeable of Cynosure's current and historical practices with respect to maintenance fee payments<sup>20</sup>," and has cited to the fourteenth paragraph of Mr. Cho's declaration of facts. This paragraph has been reviewed, and it appears that his knowledge is limited to an approximate number of patents that Cynosure owns, the fact that Cynosure relies on outside counsel, and that this system has worked "well to date." Mr. Cho does not appear to have any firsthand knowledge pertaining to the docketing system that Mr. Prashkar might or might not have had in place, or the identity of the party who submitted the first maintenance fee. These are the relevant issues, and it is clear that Mr. Cho does not have any firsthand knowledge relating to them.

The requirement that Petitioner must address the issue of why this patent was not included in the list that was presented to Mr. Cho, and represented as Cynosure's complete patent portfolio, does not appear to have been addressed.

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<sup>18</sup> Id. at 2.

<sup>19</sup> Id.

<sup>20</sup> Id.



Regarding the fourth point above, a statement of facts has not been provided from any of these three individuals. Petitioner has asserted that Mr. Furumoto is deceased. It appears that Petitioner has made the conscious decision not to provide a statement from Messrs. Crespo and Prashker, based on their indication to Petitioner that they had no recollection of any information related to this patent<sup>21</sup>. Nevertheless, statements from these individuals were required<sup>22</sup>, and they have not been provided. Without statements from the parties responsible for the payment of the maintenance at the time the patent lapsed, a determination as to whether the failure to pay the maintenance fee was unavoidable cannot be made. In the absence of such statements, we are left with speculation and conjecture as to what happened.

#### Conclusion

The prior decision that refused to accept, pursuant to 37 C.F.R. § 1.378(b), the delayed payment of a maintenance fee for the above-identified patent, has been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b).

Since this patent will not be reinstated, Petitioner is entitled to a refund of the surcharge and the 7½ and 11½-year maintenance fees, but not the \$400 fee associated with the filing of this renewed petition pursuant to 37 C.F.R. § 1.378(e). These fees will be refunded to Petitioner's Deposit Account in due course.

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<sup>21</sup> See renewed petition, page 4.

<sup>22</sup> On the fourth page of the renewed petition, Petitioner sets forth "...the Office suggested (emphasis added) that a renewed petition include statements" from these individuals. The fourth page of the decision on the original petition clearly set forth that the submission of these statements was not a mere suggestion, but rather that these statements were "required."

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225<sup>23</sup>.



Charles Pearson  
Director  
Office of Petitions

cc: Kevin Shaughnessy  
Hamilton Brook Smith and Reynolds PC  
530 Virginia Road  
P.O. Box 9133  
Concord, MA 01742

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<sup>23</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

# Petitioner's Exhibit U

“Crank Brothers”  
Decision and Petition in  
Pat. No. 6,205,885  
July 2010 to Feb. 2011

Exhibit U



HAYNES AND BOONE, LLP  
IP Section  
2323 Victory Avenue  
Suite 700  
Dallas, TX 75219

**MAILED**  
**FEB 08 2011**  
**OFFICE OF PETITIONS**

In re Patent of Hermansen :  
Patent No. 6,205,885 :  
Issue Date: March 27, 2001 :  
Application No. 09/391,709 :  
Filing Date: September 8, 1999 :  
Attorney Docket No. 70614.30 :

Decision on Petition

This is a decision in response to the communication filed July 21, 2010, which is being treated as a petition under 37 C.F.R. § 1.183 and a petition under 37 C.F.R. § 1.378(b).

The petition under 37 C.F.R. § 1.183 is **granted**.

The petition under 37 C.F.R. § 1.378(b) is **granted**.

The Office has charged the required petition fee (\$400), the required surcharge (\$700), the 3.5 year maintenance fee (\$490), and the 7.5 year maintenance fee (\$1,240) to Deposit Account No. 08-1394.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley  
Senior Petitions Attorney  
Office of Petitions

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	Attorney Docket No. 70614.30
Frank HERMANSEN, et al.	§	
	§	
Appln. No.: 09/391,709	§	U.S. Patent No.: 6,205,885
	§	
Filed: Sept. 8, 1999	§	Issued: March 27, 2001
	§	
For: CLIPLESS BICYCLE PEDAL		

**SUPPLEMENTAL PETITION FOR RECONSIDERATION**  
**AND ACCEPTANCE OF DELAYED PAYMENT**  
**OF MAINTENANCE FEES UNDER 37 C.F.R. §§ 1.182, 1.183, and 1.378**

**Mail Stop Petitions**

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

02/07/2011	CKHLUX	00000023	001394	6205885
01	FC:2551	490.00	DA	
02	FC:2552	1240.00	DA	
03	FC:1557	700.00	DA	
04	FC:1462	400.00	DA	

Dear Sir:

Crankbrothers, Inc., formerly known as California Crank Brothers, Inc. ("Crank Brothers"), the assignee of U.S. Patent No. 6,205,885 to Hermansen ("Hermansen '885") submits this Supplemental Petition to the Commissioner to revive Hermansen '885 and to accept delayed payment of the first maintenance fee, and renewed timely payment of the refunded second maintenance fee, for Hermansen '885. This Supplemental Petition is filed in response to the Decision on Petition mailed June 3, 2009.

Crank Brothers and the undersigned attorneys greatly appreciate the availability of Acting Assistant Commissioner for Patent Examination Policy Robert W. Bahr to meet and discuss Hermansen '885 on May 19, 2010. Crank Brothers respectfully requests consideration of this delayed Supplemental Petition submission under 37 C.F.R. §§ 1.182, 1.183, and/or 1.378 to waive the requirement to reply within two months of the Decision on Petition mailed June 3, 2009 in view of the apparently falsified record created by Crank Brothers' former patent counsel Leonard Tachner ("Tachner") or his employees. The inaccurate facts and apparently falsified documents in the record, coupled with incorrect U.S. Patent and Trademark Office ("USPTO")

records hindered the investigation as to the true facts relating to Hermansen '885. This extraordinary request is made in view of the recent discovery of Tachner or his employees' apparently fraudulent concealment of the actual facts while attempting to have the delayed maintenance fees accepted, as well as the importance of Hermansen '885 to Crank Brothers.

### **BACKGROUND**

Hermansen '885 issued on March 27, 2001. Hermansen '885 names as inventors, the principals of Crank Brothers, namely, Carl Winefordner and Frank Hermansen. The first maintenance fee for Hermansen '885 could have been paid between March 27, 2004 and Monday March 28, 2005. The first maintenance fee was not timely paid and Hermansen '885 expired at midnight on March 29, 2005.

A Petition for Acceptance of Delayed Payment of Maintenance Fee Under Rule 1.378(b) (the "Petition") was filed by Tachner on October 18, 2007. A Decision (the "First Decision") dismissing the Petition was mailed to Tachner on April 9, 2008. A Request for Reconsideration of Petition for Acceptance of Delayed Payment of Maintenance Fee Under Rule 1.378(b) (the "Request") was filed by Tachner on July 31, 2008. A Decision (the "Second Decision") granting the Petition was mailed to Tachner on October 15, 2008. As a result of the Second Decision, Hermansen '885 was reinstated. The second maintenance fee and the required surcharge were then timely submitted by Tachner on November 6, 2008. A "corrected" Decision (the "Third Decision"), which vacated the Second Decision and denied the Petition, was mailed to Tachner on June 3, 2009 and roughly concurrently the USPTO apparently refunded to Tachner's deposit account all fees associated with the first and second maintenance fee payments. Copies of the Petition, the First Decision, the Request, the Second Decision and the Third Decision are attached as Exhibits A-E, respectively.

This Supplemental Petition for Reconsideration and the attached Declaration and Exhibits constitute a verified showing that the delay in the payment of the first maintenance fee for Hermansen '885 was unavoidable, despite the exercise of reasonable care by Crank Brothers to ensure that the first maintenance fee would be timely paid. Specifically, this Petition and the attached Declarations demonstrate that the delay in the payment of the first maintenance fee resulted from one or more of a docketing error and a clerical error committed apparently by

Tachner's staff and the apparent fabrication of evidence by Tachner or his staff to actively conceal such errors while at the same time attempting to reinstate the patent.

### **EVIDENCE IN SUPPORT OF PETITION**

Attached to this Supplemental Petition is the Declaration of Tom Chen (Exhibit F), Crank Brothers' current patent counsel. The Chen Declaration together with Exhibits A-E and Exhibits G-Y, demonstrate that:

- (1) One or more of a docketing error and a clerical error was the cause of the delay in payment of the first maintenance fee for Hermansen '885,
- (2) Tachner or his staff intentionally deceived Winefordner, Hermansen, Crank Brothers and the USPTO as to the errors that led to the delay in payment of the first maintenance fee for Hermansen '885, and
- (3) Winefordner, Hermansen and Crank Brothers have at all times exercised due care and been diligent in pursuing the reinstatement and payment of maintenance fees for Hermansen '885.

### **ARGUMENT IN SUPPORT OF PETITION GRANT**

35 U.S.C. § 41(c)(1) and 37 CFR § 1.378(b) provide that the Director may accept the payment of any maintenance fee due on a patent after the expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable.

As noted in the Third Decision, 37 CFR § 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

"A showing that . . . reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee . . . became aware of . . . the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which the patentee became aware of the expiration of the patent." (Third Decision, page 2).

The Third Decision also states that:

"In order for a party to prove unavoidable delay, the Office requires the party demonstrate the party exercised the 'care or diligence tha[t] is generally used and observed by prudent and careful men in relation to their most important business.'" (Third Decision, page 2).

As noted in MPEP § 711.03(c)(2) decisions on reviving abandoned applications on the basis of "unavoidable" delay follow the reasonably prudent person standard to determine if a delay was unavoidable. This section of the MPEP goes on to note that in the context of the reasonably prudent person standard:

"The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. (Emphasis added)

Also as noted in MPEP § 711.03(c)(2):

"A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of 'unavoidable' delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care."

**1. CRANK BROTHERS RELIED UPON TACHNER TO PAY THE MAINTENANCE FEES FOR HERMANSSEN '885**

As stated in the Declarations of Carl Winefordner and Frank Hermansen submitted with the Request, Crank Brothers engaged Tachner to provide various services with respect to the preparation, prosecution and maintenance of Crank Brothers' U.S. and corresponding foreign patents. While the degree of reliance by Crank Brothers on Tachner for services related to the preparation and prosecution of patent matters varied, one thing was consistent -- Tachner was



always responsible for the docketing and payment of maintenance fees and annuities with respect to all of Crank Brothers' U.S. and foreign patent matters.

With respect to Hermansen '885, Winefordner and Hermansen wrote the underlying application while Tachner edited the application and wrote the claims. Winefordner and Hermansen filed the application and it was allowed on the first action. Winefordner and Hermansen paid the issue fee and thereafter met with Tachner and his staff and requested that Tachner assume responsibility for Hermansen '885 including the docketing and payment of maintenance fees. Obviously, once the issue fee was paid, the only action left to be taken with respect to Hermansen '885 was the payment of the first, second and third maintenance fees. If Crank Brothers had not intended for Tachner to handle the timely payment of maintenance fees for Hermansen '885, there would have been no reason for Winefordner and Hermansen to meet and request that Tachner assume further responsibility for the patent. Indeed, according to the Winefordner Declaration, Winefordner stated that:

"Our plan was to turn over this patent to Mr. Tachner as soon as we received the first Office Action, but as it turned out, this patent was approved without any Office Actions. So Frank and I paid for the patent issue fee directly, and then met with Mr. Tachner's secretary, Janis Foreman, and requested that the Law Office of Leonard Tachner take over further responsibility for this patent including future maintenance fees." (Winefordner Declaration, paragraph 4, pages 2-3).

Winefordner also stated that:

"I am 100% sure that I gave Mr. Tachner's secretary, Janis Foreman, instructions to pay the maintenance fees on our '885 patent and I am without any doubt sure that I never told her that I or we would pay it ourselves. I specifically told Ms. Foreman this in person while Frank and I visited the law office." (Winefordner Declaration, paragraph 5, page 3).

Finally, Winefordner stated that:

"Frank [Hermansen] and I specifically communicated to the Law Offices of Leonard Tachner to take over patent responsibilities and pay the maintenance fees of the '885 patent." (Winefordner Declaration, paragraph 11, page 5).

According to the Hermansen Declaration, Hermansen substantiates the statements made by Winefordner as follows:

"I recall that we paid for the patent issue fee directly and then met with Mr. Tachner's secretary, Janis Foreman, to request that the Law Office of Leonard

Tachner take over all responsibility for this patent including payment of future maintenance fees." (Hermansen Declaration, paragraph 3, page 2).

"We made our instructions and intentions very clear to Mr. Tachner's secretary." (Hermansen Declaration, paragraph 4, page 2).

"I am completely positive that we requested the Law Office of Leonard Tachner to pay the maintenance fees on this patent as I was present during this conversation." (Hermansen Declaration, paragraph 5, page 2).

In view of the Winefordner and Hermansen Declarations, it is clear that Crank Brothers was never confused about whose responsibility it was to pay the maintenance fees for Hermansen '885 -- Tachner was responsible at all times. As will be shown below, Tachner was not confused either -- he knew he was responsible for those maintenance fees.

It is important to note that Hermansen '885 is the brightest gem in Crank Brothers' American success story and it has and does protect a significant portion of Crank Brothers' domestic bicycle pedal revenue from substantial foreign competition headquartered in, for example, Japan and France.<sup>1</sup> Attached as Exhibit G is a copy of an email from Winefordner to Tachner dated March 27, 2008 which states that:

"There are many millions of dollars of revenue potentially riding on [the reinstatement of Hermansen '885], because I'm sure that we will be copied heavily if the bike industry figures out that we don't have an active patent. Last year we sold over \$7,000,000 worth of pedals under this patent, and this year it will be more. It is the majority of our business still."

Thus, based solely on the Declarations of Winefordner and Hermansen submitted with the Request, the record is clear that Crank Brothers never informed Tachner or his staff that Crank Brothers would pay the maintenance fees for Hermansen '885 or any of Crank Brothers' other U.S. and foreign patents handled by Tachner. The USPTO, however, was apparently misled by the Declaration of Janis Foreman submitted with the Petition and the Declaration of Leonard Tachner submitted with the Request which are discussed below, as to the facts surrounding the

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<sup>1</sup> It should be noted that Crank Brothers became part of a foreign-owned entity after January, 2008 after the events leading to the Petition and the filing of the Petition itself. Crank Brothers still has the same principals and substantially the same manufacturing facilities in the U.S. as before this change, and still qualifies for small entity status.

delayed maintenance fee payment in Hermansen '885 when issuing the First Decision and the Third Decision.

**2. TACHNER ALLEGED THAT CRANK BROTHERS ASSUMED RESPONSIBILITY FOR PAYMENT OF MAINTENANCE FEES FOR HERMANSEN '885**

According to the Petition, which was authored by Tachner, the delay in payment of the first maintenance fee for Hermansen '885 was allegedly due to confusion between Tachner's staff and Crank Brothers as to who would pay the maintenance fee. In an attempt to document the alleged confusion, the Petition included the Declaration of Janis Foreman, Tachner's Office Manager and secretary, which stated that:

"[B]efore the first annuity became due (September 27, 2004) I entered a statement on the face of the file that the client would pay the annuities . . . As shown in the attached Exhibit C which is a photocopy of the face of our Docket No. SLIP-21, it is noted the client will pay the maintenance fee. All of the issued patent file faces for this client show that the client will pay their own annuities as of mid-2004 (see sample photocopies attached as Exhibits D1-D6). I recall doing so based on a discussion with the client indicating that they would pay their own annuities." (Foreman Declaration, paragraph 4, page 2).

As will be demonstrated below, the above-noted statement in the Foreman Declaration was apparently false and was presumably made in an apparent attempt to fraudulently conceal the cause of the error that led to the late payment of the first maintenance fee for Hermansen '885.

The above-noted apparently false statement in the Foreman Declaration was extremely important to the effort to reinstate Hermansen '885. Indeed, the First Decision stated that:

"Based on the facts in the record, it appears the most likely explanation for petitioner's failure to pay the fee is:

- (1) Petitioner informed the law firm petitioner would pay maintenance fees in the future,
- (2) Petitioner failed to take steps to ensure the fees would be timely paid, and
- (3) Petitioner failed to pay the fees." (First Decision, page 3).

The First Decision also stated that:

"If petitioner never informed the law firm that petition[er] would pay the fees, then Ms. Foreman's conduct does not appear to have been reasonable. Ms. Foreman did not simply make a typographical or minor clerical error. Instead near mid-2004, she intentionally changed most, if not all of petitioner's files, to indicate petitioner would be paying the fee.

The Office notes Ms. Foreman has stated, 'All of the issued patent files for this client show that the client will pay their own annuities as of mid-2004.' However, the front of the files for Patent No. 6,851,189, and Patent No. 7,225,703, render the comment ambiguous. The front of each file appears to indicate the 'client to pay' entries were made after mid-2004. For Patent No. 6,851,189, the entry indicating 'client to pay annuities' follows the entry indicating the issue fee was paid December 30, 2004. For Patent No. 7,225,703, the entry indicating 'client pays annuities' follows the entry indicating the issue fee was paid April 16, 2007. If Ms. Foreman made an error, it appears she made the same error on multiple occasions. Any request for reconsideration should be accompanied by a full discussion of each occasion Ms. Foreman changed any of petitioner's files to indicate petitioner would pay the fee." (emphasis in original) (First Decision, pages 4-5).

The Third Decision also refers to the apparently false statement in the Foreman Declaration:

"In this case, the facts are clear that petitioner initially retained Tachner and relied on Tachner to inform petitioner of when maintenance fees became due for petitioner's patents. However, at some point prior to September 22, 2004, when the first maintenance fee became due, an entry was made in the docket records that 'the client will pay their own annuities.' The record is not clear that an error in docketing the payment of the maintenance fees occurred. The facts as set forth in the Foreman declaration do not show that any error in docketing was made by the party responsible for maintaining the docket records. What the facts of record show is that there was confusion between the client and the attorney over who would pay the maintenance fee." (Third Decision, page 6).

"It is well established that failure in communications between a client and his or her attorney does not constitute unavoidable delay. Here it would appear that a misunderstanding has occurred over who would be responsible for tracking and paying the maintenance fee. The failure in communication is not considered to be unavoidable error." (Third Decision, page 7).

Thus, it is clear that the apparently false statement in the Foreman Declaration alleging that there was confusion between Tachner's office and Crank Brothers over who would track and pay the maintenance fees for Hermansen '885 were the key "facts" relied upon in the First and Third Decisions in which the Petition to reinstate Hermansen '885 was denied.

In addition to the apparently false statement in the Foreman Declaration, the Request included the Declaration of Leonard Tachner, which also included potentially false statements concerning Hermansen '885. Specifically, the Tachner Declaration states that:

"Because I did not file or prosecute the '885 patent, we have no file history for it. Apparently, Messrs. Winefordner and Hermansen still have the prosecution documents for the '885 patent. We have made a substitute file in which there is only a copy of the issued patent and a copy of our October 2007 petition. Any and all documents that might have been received by our office from the USPTO in regard to the '885 patent should be contained in that file, but there are none."  
(Tachner Declaration, paragraph 6, page 3).

Contrary to the Tachner Declaration and as stated in the Chen Declaration, Tachner's file for Hermansen '885 contains a stamped postcard receipt dated May 17, 2004 which confirms that Tachner changed the correspondence address to ensure receipt of USPTO correspondence for Hermansen '885. A copy of this stamped postcard receipt is attached as Exhibit H. It is important to note that Tachner filed the change of correspondence address documentation during the time the window was open for payment of the first maintenance fee for Hermansen '885, *i.e.*, between March 27, 2004 and March 28, 2005. Tachner presumably changed the correspondence address for Hermansen '885 so he could receive reminders regarding the maintenance fees, which he was responsible for paying, directly from the USPTO.

Therefore, the Tachner Declaration was factually incorrect in stating: (i) there was nothing in Tachner's file for Hermansen '885 besides the patent, and (ii) there was confusion as to who was responsible for the maintenance fee payment. In reality, no confusion existed at the time. Thus, it is clear that Tachner was responsible for the payment of maintenance fees for Hermansen '885 at the time the first and second maintenance fees were due.

**3. TACHNER APPARENTLY FRAUDULENTLY CONCEALED THE ERROR THAT LED TO THE LATE PAYMENT OF THE FIRST MAINTENANCE FEE FOR HERMANSEN '885**

On or about April 14, 2009, at the request of Crank Brothers, Tachner transferred all of his files concerning Crank Brothers' patent and trademark matters to Haynes and Boone, LLP. Consequently, Haynes and Boone now has custody of Tachner's actual files including the original file covers that were prepared by Tachner or his staff in connection with the filing,

prosecution and maintenance of Crank Brothers' U.S. patent filings. Attached as Exhibits I-N are true and correct photographs of the file covers that Tachner or his staff prepared in connection with the following U.S. Patents owned by Crank Brothers:

U.S. Patent No. 5,676,529  
U.S. Patent No. 6,027,319  
U.S. Patent No. 5,857,509  
U.S. Patent No. 6,059,245  
U.S. Patent No. 6,851,189  
U.S. Patent No. 7,225,703.

Upon receipt of the transferred patent files from Tachner, Crank Brothers' current patent counsel placed a tracking label in the upper left corner and an attorney docket number in the upper right corner of the file covers. As a result, the notations placed on the file covers by Tachner or his staff remain untouched. In this regard, see paragraph 7 of the Chen Declaration.

With respect to the notations placed on the file covers by Tachner or his staff, Exhibits I-N correspond exactly to Exhibits D1-D6, respectively, to the Foreman Declaration, except for one significant detail. Specifically, the handwritten notations of "client will pay", "client pays", "client to pay annuities", or "client pays annuities" that appear in the right-hand column next to the due dates for the annuities for such patents as well as the semi-circular bracket shown in Exhibits D1-D6 to the Foreman Declaration are absent from the photographs in Exhibits I-N. The photographs in Exhibits I-N also demonstrate that there are no alterations, erasures, white-outs or cover ups on the file covers. This is also confirmed by paragraph 7 of the Chen Declaration. Consequently, the only explanation for the discrepancy between Exhibits I-N and Exhibits D1-D6 to the Foreman Declaration is that Tachner or his staff made photocopies of the respective file covers, entered the handwritten notations on the photocopies, made photocopies of the hand-altered photocopies and submitted them under oath as being true copies of the file covers. It is clear from Exhibits I-N that the handwritten notations shown in Exhibits D1-D6 to the Foreman Declaration were never actually written on the file covers.

Attached as Exhibit O is a photograph of the cover of Tachner's file for Hermansen '885. Exhibit O corresponds exactly to Exhibit C to the Foreman Declaration, except for the tracking label and attorney docket number placed on the file cover by Crank Brothers' current patent counsel. Contrary to Exhibits I-N, Exhibit O does show that the handwritten notation "client to pay annuities" was actually written on the file cover and was subsequently crossed out (perhaps

immediately after being written) when Tachner attempted to pay the first maintenance fee with the Petition on October 18, 2007. It follows then that if the handwritten notations shown in Exhibits D1-D6 to the Foreman Declaration had actually been written on the file covers, when the maintenance fees were later paid by Tachner, the handwritten notations would be crossed out like they were on Exhibit O. This inconsistency also supports the conclusion that rather than being authentic copies of the file covers of Tachner's files concerning Crank Brothers' U.S. patents, Exhibits D1-D6 to the Foreman Declaration appear to have been intentionally falsified - presumably to support Tachner's contention that there was confusion as to whether Tachner or Crank Brothers was responsible for the tracking and payment of the first maintenance fee for Hermansen '885. Consequently, it appears that Tachner intentionally fraudulently concealed from Crank Brothers and the USPTO the docketing or clerical error committed by Tachner's staff that led to the delay in the payment of the first maintenance fee for Hermansen '885. Since the file covers of Exhibits D1-D6 to the Foreman Declaration bearing handwritten notations have been shown to have been apparently falsified, the veracity of the allegedly, corroborative, handwritten docket sheets attached to the Foreman Declaration as Exhibits A and B1-B3 are also suspect and will not be commented upon herein.

Tachner and his staff apparently had clear motivation to conceal the docketing or clerical error from Crank Brothers and the USPTO. Tachner and his staff were well aware of the significance of Hermansen '885 to Crank Brothers' competitive position in the bicycle pedal industry. Indeed, Tachner stated in the Request that:

"[I]f this request for reconsideration of the petition is found lacking, I am personally at risk for a staggering liability which would likely terminate a 36-year career . . . and negatively affect the rest of my life." (Request, pages 2-3).

Further, during the course of the maintenance history concerning Hermansen '885 there were four documents that showed a negative effect on the status of Hermansen '885. These documents are:

1. The Maintenance Fee Statement that would have been routinely mailed on or about September 27, 2004 (three and one-half years after the issue date of Hermansen '885) to Tachner as the "Fee Addressee";
2. The Notice of Patent Expiration dated April 27, 2005, a copy of which is attached as Exhibit P;

3. The First Decision; and
4. The Third Decision.

Each of these documents was properly addressed to Tachner, but Tachner claims to have never received any of them (See paragraph 5 of the Tachner Declaration and paragraph 5 of the Chen Declaration). On the other hand, the only positive document following the issuance of Hermansen '885, namely the Second Decision, was received by Tachner. In light of Tachner's apparent intentional falsification of documents and potentially active concealment of the error in the payment of the first maintenance fee for Hermansen '885, it stretches credulity to believe that Tachner and his staff did not receive even a single one of the four above-noted documents that bore negatively on the status of Hermansen '885. Instead, what seems likely is that Tachner or his staff did receive such documents but destroyed them to further the concealment of errors concerning Hermansen '885.

As further evidence of the apparent concealment of the error concerning Hermansen '885 by Tachner or his staff, it should be noted that Winefordner and Hermansen were completely unaware of the contents of the Petition, the Foreman Declaration, the Request and the Tachner Declaration. Instead, Winefordner and Hermansen had only been permitted to review their own Declarations, and therefore could not have possibly understood the facts and positions that Tachner stated (and those he omitted) in pursuing the reinstatement of Hermansen '885 by the filing of the Petition and the Request. In this regard, see Winefordner's email dated July 14, 2008 to Tachner attached as Exhibit Q which states that "[w]e don't know what you included in the petition." Also, see the Declaration of Carl Winefordner ("Winefordner II Declaration") attached hereto as Exhibit R.

Still further, attached as Exhibits S and T are the transaction histories for Crank Brothers' U.S. Patent Nos. 5,676,529 and 5,857,509, respectively. As noted in Exhibit S, U.S. Patent No. 5,676,529 expired twice, namely on November 20, 2001 and on November 16, 2005. Also, a Petition to Accept Late Payment of Maintenance Fee was filed on October 3, 2007 and a Decision on the Petition was mailed on October 3, 2007. As noted in Exhibit T, U.S. Patent No. 5,857,509 expired on February 14, 2007, a Petition to Accept Late Payment of Maintenance Fee was filed on October 3, 2007 and a Decision on the Petition was mailed on October 3, 2007. As noted in the Winefordner II Declaration, Tachner never told Crank Brothers that U.S. Patent No.



5,857,509 had expired nor that U.S. Patent No. 5,676,529 had expired twice. Rather, Tachner hid these adverse events and correspondence from the USPTO from Crank Brothers, although in those cases he was able to revive the expired patents without Crank Brothers' involvement or knowledge (Winefordner II Declaration, at paragraphs 4-6).

As noted in paragraph 8 of the Chen Declaration, every single one of the Notices of Patent Expiration, Petitions to Accept Late Payment of Maintenance Fee and Decisions on Petition for U.S. Patent Nos. 5,676,529 and 5,857,509 was missing from the files Tachner transferred to Crank Brothers' current patent counsel. In addition, the Petition and the Request are missing from Tachner's file for Hermansen '885. Finally, as noted in paragraph 8 of the Chen Declaration, in a telephone conversation between Chen and Tachner on July 7, 2010, Tachner confirmed that he had transferred to Crank Brothers' current patent counsel all of his files and documents concerning Crank Brothers' patent matters. Every single one of these documents, especially those prepared by Tachner or his staff, should be in the files. The absence of these documents from Tachner's files certainly suggests they were intentionally removed in furtherance of the concealment from Crank Brothers and the USPTO of the errors concerning Hermansen '885 and other patents owned by Crank Brothers. When an attorney intentionally conceals various substantive mistakes from his client, fairness requires that the client not be adversely prejudiced by requiring diligent action until after the client understands the extent of the deceit. *In re Lonardo*, 17 U.S.P.Q.2d 1455 (Com'r Pat. 1990).

Finally, attached as Exhibit U is a copy of an email from Janis Foreman of Tachner's office to Winefordner dated October 3, 2007. Exhibit U demonstrates that Tachner and/or his staff discovered several concurrent maintenance fee problems regarding Crank Brothers' U.S. patents for which Tachner was responsible, and attempted to correct these problems without explaining to Crank Brothers that the affected patents had expired. Exhibit U, of course, came well after mid-2004 when the Foreman Declaration alleges Crank Brothers was responsible for all of Crank Brothers' annuity payments. Importantly, Exhibit U does not state that Crank Brothers missed the maintenance fee deadline as it would if they were responsible, but rather, Tachner takes responsibility for the missed maintenance fees and indicates corrective action has been taken (without Crank Brothers' input) to "correct the situation." Why? Because Tachner was responsible for all maintenance fee payments. Attached at Exhibit V is a list of Crank

Brothers' U.S. and foreign patent matters being handled by Tachner. The list is dated October 3, 2007 and was attached to the email shown in Exhibit U. As will be noted, the list shown in Exhibit V includes the due dates for all three maintenance fee payments for Hermansen '885.

Exhibit V also reveals another apparently false statement in the Foreman Declaration. Specifically, the Foreman Declaration states that:

"Around March 2001, when the Firm received the above-captioned issued patent, I supervised Miller to assure that entries were made in the docket system for September 27, 2004 (3.5 yr annuity), September 27, 2008 (7.5 yr annuity) and September 27, 2012 (11.5 yr annuity) deadlines for payment of the maintenance fees, and to send a letter to the client explaining the requirement for paying the maintenance fees." (Foreman Declaration, paragraph 3, page 2).

While Hermansen '885 was issued on March 27, 2001, it seems likely that Tachner did not receive instructions from Crank Brothers to do anything with respect to Hermansen '885 until sometime between March 16, 2004 and March 26, 2005. Specifically, the list in Exhibit V demonstrates that Tachner's system for naming files for Crank Brothers was to designate the client with the term "SLIP" and to then open new matters in a chronological sequence. Had Tachner actually received Hermansen '885 around March 2001 and opened a matter for it so that the maintenance fees could be docketed, Tachner's matter name for it would have been SLIP-6. This is because Tachner's matter number SLIP-5 was for U.S. Patent Application No. 09/679,078 filed May 14, 1998 and Tachner's matter number SLIP-6 was for U.S. Patent No. 6,851,189 which issued from U.S. Patent Application No. 10/375,243 filed February 27, 2003.

Instead, as shown in Exhibit V, Tachner's matter number for Hermansen '885 was "SLIP-21". Tachner's matter number SLIP-20 was for U.S. Patent No. 7,225,703 which issued from U.S. Patent Application No. 10/802,105 filed March 16, 2004 and Tachner's matter number SLIP-22 was for U.S. Patent Application No. 11/138,134 filed March 26, 2005. Consequently, what seems likely is that Tachner or his staff received Hermansen '885 from Crank Brothers shortly before the filing of the Change of Correspondence Address evidenced by the stamped postcard receipt dated May 17, 2004 and attached as Exhibit H. As noted above, Tachner filed the Change of Correspondence Address during the time the window was open for payment of the first maintenance fee for Hermansen '885, i.e. between March 27, 2004 and March 28, 2005. The only logical conclusion is that Crank Brothers gave Hermansen '885 to Tachner and

requested that he file the Change of Correspondence Address so that Tachner could receive maintenance fee reminders directly from the USPTO and pay such maintenance fees when due.

The apparently false statement in the Foreman Declaration about the timeframe in which Tachner or his staff set up a file and docketed the maintenance fees for Hermansen '885 is another example of how Tachner submitted apparently false statements in an effort to conceal the error that led to the late payment of the first maintenance fee for Hermansen '885.

**4. IF TACHNER HAD NOT APPARENTLY FRAUDULENTLY CONCEALED THE ERROR THAT LED TO THE LATE PAYMENT OF THE FIRST MAINTENANCE FEE FOR HERMANSEN '885, IT WOULD HAVE LIKELY BEEN REINSTATED**

As noted above, MPEP § 711.03(c)(2) states that:

"A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of 'unavoidable' delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care."

As detailed above, the docketing or clerical error was clearly the cause of the delay in the payment of the first maintenance fee for Hermansen '885.

The Tachner Declaration submitted with the Request states that:

"Over a period of almost thirty years I personally trained Ms. Foreman to carry out numerous duties in my practice. Included among these duties is that of being responsible for the timely payment of maintenance fees for our clients' issued U.S. patents. I have also instructed her in communicating with clients in a timely manner to learn whether they wish to have us pay maintenance fees for them so that we can anticipate being reimbursed for that payment and being paid a reasonable service fee. Over that period of time I have come to rely on Ms. Foreman to properly carry out these duties, she has paid hundreds of maintenance

fees to the U.S. Patent and Trademark Office.” (Tachner Declaration, paragraph 2, pages 1-2).

The Tachner Declaration submitted with the Request also states that:

“Ms. Foreman has been a hard-working, dedicated and loyal employee of my firm for decades. I’ve not previously had reason to doubt her word or question her actions. Ms. Foreman has through many years of her service to the firm and in her relation with clients over that period, convinced me that she could be relied upon to communicate unambiguously with clients and to follow instructions from me and from clients in regard to what to pay or not pay to the Patent Office in behalf of clients.” Tachner Declaration, paragraph 7, page 4).

Thus, it is apparent from the Tachner Declaration that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, and the employee (Ms. Foreman) was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. Consequently, had Tachner admitted in the Petition or the Request that his staff had made at least one of a docketing and clerical error that led to the delay in the payment of the first maintenance fee for Hermansen ‘885, it would have been likely that Hermansen ‘885 would have been reinstated.

In his attempts to reinstate Hermansen ‘885, Tachner was then faced with the prospect of admitting the error but was likely concerned that if the reinstatement effort was unsuccessful, the admission of the error could be used against him in any resulting malpractice claims brought by Crank Brothers. Instead of doing the right thing, Tachner or his staff appears to have chosen to cover up the error by submitting apparently falsified documents and testimony.

##### **5. TACHNER CONCEALED FROM CRANK BROTHERS THE REFUND OF MAINTENANCE FEE PAYMENTS FOR HERMANSEN ‘885**

In connection with the unsolicited Third Decision, on or about June 4, 2009, the USPTO refunded to Tachner’s deposit account the fee payments in connection with the first and second maintenance fees for Hermansen ‘885. Tachner had previously invoiced Crank Brothers and had received payment from Crank Brothers for the first and second maintenance fees for Hermansen ‘885 (Winefordner II Declaration, paragraph 8).

To date, Tachner has not informed Crank Brothers that the fees have been refunded to his deposit account and he has failed to reimburse Crank Brothers for such fees (Winefordner II Declaration, paragraph 8). Regardless of whether or not Tachner actually received the Third Decision, he certainly should have been aware that the first and second maintenance fees had been refunded to his USPTO deposit account. He also should have refunded these fees to Crank Brothers.

Thus, in addition to apparently concealing the error and submitting apparently falsified documents and testimony in connection with his attempts to reinstate Hermansen '885, Tachner also failed to notify Crank Brothers that the USPTO refunded the first and second maintenance fees to Tachner's deposit account payments and he also failed to refund such fees to Crank Brothers.

#### **6. CRANK BROTHERS SHOULD NOT BE BOUND BY TACHNER'S CONDUCT**

As demonstrated above, Tachner or his staff appear to have tampered with the file covers that were exhibits to the Foreman Declaration submitted with the Petition in a successful attempt to create the illusion that there was confusion between Crank Brothers and Tachner or his staff about who was responsible for payment of the maintenance fees for Hermansen '885. In reality, there was no confusion-----Tachner was responsible, but apparently his staff had simply made a clerical error likely in docketing about who was responsible. Crank Brothers should not be punished in view of its diligent efforts regarding Hermansen '885 and the unknown and unforeseeable actions of Tachner and his staff, given that Tachner, and possibly his employees, acted outside the scope of his authority, acted without knowledge of Crank Brothers as to portions of the filings regarding the reinstatement of Hermansen '885, misled Crank Brothers as to the specifics of the Petition and the Request, failed to make other filings authorized by Petitioners (*i.e.*, the maintenance fees), failed to keep Crank Brothers updated on the status of Hermansen '885, apparently failed to notify Crank Brothers about the refunded first and second maintenance fees and to refund these fees, and apparently acted outside the scope of his professional responsibilities. While the general rule is that an attorney's conduct is chargeable to his client, the general rule has an important exception as noted by the Commissioner of Patents and Trademarks in *In re Lonardo*, 17 U.S.P.Q. 2d 1455 (Com'r Pat., 1990):

“When an attorney intentionally conceals a mistake he has made, thus depriving the client of a viable opportunity to cure the consequences of the attorney’s error, the situation is not governed by the . . . rule . . . for charging the attorney’s mistake to his client.” (17 U.S.P.Q.2d at 1458).

In a manner similar to the facts of the *In re Leonardo* decision, here Tachner and/or his staff appear to have knowingly and intentionally misled Crank Brothers and the USPTO as to the error that led to the late payment of the first maintenance fee for Hermansen ‘885 as well as the contents of his submissions over the course of the revival efforts.

Now that the record has been clarified as to the actual facts concerning the understanding of Tachner and his staff regarding the payment of maintenance fees for Hermansen ‘885, it should be clear that the unavoidable error that led to the late payment of the first maintenance fee for Hermansen ‘885 was not caused or committed by Crank Brothers. Rather, Crank Brothers relied on Tachner’s apparently reasonable procedures, but a docketing or clerical error occurred which error was compounded by Tachner’s or his staff’s efforts to apparently conceal the nature of the error. Crank Brothers was unable to discover this problem until Hermansen ‘885 and another patent entrusted to Tachner were both roughly concurrently discovered to have lapsed due to failure to pay maintenance fees. These lapses by Tachner and his staff occurred despite Crank Brothers’ instructions to Tachner and his staff to pay all such maintenance fees and to confirm with Crank Brothers about such payments in advance – in case Crank Brothers elected to abandon any of its patent rights. It was only at that juncture that Crank Brothers had any idea that Tachner’s procedures were either not entirely reliable or were not followed, and that an error or two had occurred. But even then, Crank Brothers still did not understand that Tachner’s attempts to revive Hermansen ‘885 were also unreliable at best - and in reality based on apparently falsified documents and testimony apparently designed to conceal reality from Crank Brothers and the USPTO. Because Crank Brothers was not able to review the Petition, the Request, the Foreman Declaration, and the Tachner Declaration, given that Tachner never provided drafts or copies of these documents, Crank Brothers had no reason to suspect these submissions were inaccurate and could not have discovered the incorrect facts submitted by Tachner. (See, e.g., Exhibit Q).

Thus, it was not until a few weeks ago that Crank Brothers and current counsel of record discovered the apparently falsified documents and testimony previously submitted by Tachner in

connection with the Petition and the Request as well as the accompanying Declarations of Foreman and Tachner. This discovery permitted Crank Brothers with an opportunity to understand what Tachner and his staff had actually done and what (erroneous) facts had actually been presented to the Patent Office in connection with the Petition and the Request. In view of Tachner's, and his staff's, apparently falsified submissions in connection with the maintenance fee payments and attempted revival of Hermansen '885, it would contravene the basic notions of equity for Crank Brothers to be forced to stand in Tachner's shoes.

Indeed, in concert with the decision of the Commissioner of Patents and Trademarks in *In re Lonardo*, the USPTO should ignore the time period of delay caused by prior counsel's deception, and should instead look only to Crank Brothers' intent and prompt action once aware of the true nature of the problem. *In re Lonardo*, 17 U.S.P.Q. 2d 1455 (Com'r Pat., 1990). Further, Crank Brothers' request for consideration is based on the recently discovered inaccurate facts submitted in the Petition and the Request, coupled with the corrected facts now diligently discovered and submitted in connection with reviving Hermansen '885 for late payment of the first and second maintenance fees with surcharges and petition fees now past due, despite the exercise of reasonable care to ensure that the fees would be timely paid. Despite the procedures in place by Tachner, as submitted in the Petition and Request including the docketing of USPTO deadlines and monitoring of same, the docketing notation and possibly other errors by Tachner's staff nullified the existing checks and balances he established to ensure timely payment of the maintenance fees—upon which Crank Brothers reasonably relied as shown herein. At no point in time did Crank Brothers ever intend for their most important patent, Hermansen '885, to lapse for any reason (See Exhibit Q, stating to Tachner on July 14, 2008 that “we never intended this patent to go inactive.”).

**7. PETITIONERS HAVE BEEN DILIGENT: THE ADDITIONAL DELAY FROM MISLEADING PRIOR COUNSEL ACTS AND INCORRECT USPTO RECORDS FROM THEIR DISCOVERY TO THE PRESENT WAS UNAVOIDABLE**

To clarify and support that the delay from issuance of the unsolicited Third Decision was also unavoidable, Crank Brothers provides additional new facts below regarding the delay from that time to the submission of this Supplemental Petition. Initially, Tachner claims to have never

received the unsolicited Third Decision denying the Request, nor would anyone have been expecting such a document. Despite the Correspondence Address correctly identifying Tachner's current office address, Tachner told Crank Brothers that he never received any further USPTO communications regarding Hermansen '885 to date despite the correspondence address being his then current office address. (Chen Declaration, paragraphs 5-6, pages 1-2).

Instead, Crank Brothers' Italian patent counsel APTA sent an email to Winefordner on December 15, 2009 to which was attached a list of Crank Brothers' patents which list indicated that Hermansen '885 was "granted/abandoned." See attached Exhibit X, which includes a copy of this email and the attached list. Crank Brothers replied to APTA by email on December 18, 2009 and stated that Hermansen '885 is not abandoned because the previous attorney [Tachner] made a mistake and did not pay the maintenance fee on time which caused it to be briefly shown as abandoned, but that the attorney had petitioned to the USPTO and was able to pay the fee and make the patent active again. See attached Exhibit X which includes a copy of Crank Brothers' email sent on December 18, 2009. Thus, even up to this point, Crank Brothers had no reason to suspect that a clock was ticking or that Hermansen '885 was again in jeopardy.

On January 21, 2010, APTA sent an email to Tom Chen and asked if any confirmation existed from the USPTO about the late payment of the maintenance fees for Hermansen '885. (See Exhibit Y which includes a copy of this email, and the Chen Declaration, paragraph 3, page 1). The same day, Mr. Chen sent an email to his assistant Ms. Annie McNally and asked her to check on APTA's request for information about the late payment of the maintenance fees for Hermansen '885 (See Exhibit Y). On that same day, Ms. McNally learned that the Request appeared to have ultimately been denied in June, 2009, that a decision to that effect had been mailed to Tachner, and that based on USPTO records Hermansen '885 had expired on March 27, 2009" (see Exhibit Y, the Chen Declaration, paragraph 4, page 1 and Exhibit 1 to the Chen Declaration). As shown in Exhibit W, the erroneous expiration date for Hermansen '885 is to this day still shown in the records of the USPTO. Thus, as of January 21, 2010, Mr. Chen and Crank Brothers understood that Hermansen '885 had somehow expired or gone abandoned again on March 27, 2009 based on USPTO records (Chen Declaration, paragraph 4, page 1). It would therefore have been possible to file a Petition to Revive under the unintentional standard since the lapse had been within the last two years (*i.e.*, from March 27, 2009 one would have until



March 27, 2011). The file history for Hermansen '885 was not then and is not now available electronically on the USPTO PAIR system.

The official file history for Hermansen '885 was ordered on January 22, 2010. As shown in Exhibit Y, Ms. McNally contacted the USPTO on January 25, 2010 to confirm when Hermansen '885 actually expired given the confusing online history for Hermansen '885. According to Exhibit Y, she was told by Michael Eason at the Petitions Office that he could not determine the facts since there was not much available electronically, and that he would pull the file and call Ms. McNally back. Several weeks passed and as shown in Exhibit Y, on February 16, 2010, Ms. McNally told Mr. Chen she was checking up on the request for information, but that the USPTO had been closed for four days due to a snow emergency. As also shown in Exhibit Y, a message was left with the Petitions Branch by Ms. McNally on February 17, 2010 after she was informed that Steven Brantley had responsibility for Hermansen '885.

On February 17, 2010, Mr. Chen spoke with Tachner who stated that he assumed Hermansen '885 had been reinstated because the Petition for Acceptance of Delayed Payment of Maintenance Fees was granted, which was the last he had heard about this matter. (Chen Declaration, paragraph 5, pages 1-2). Tachner also stated that he was unaware of any fees being credited to his USPTO Deposit Account or the subsequent unsolicited Third Decision denying the requested relief. (Chen Declaration, paragraph 5-6, pages 1-2).

On February 26, 2010, the file history for Hermansen '885 was received from the USPTO and transmitted to Randall Brown, Chair of Haynes and Boone, LLP's IP and Technology Transactions Section, for his review. On March 2, 2010, Mr. Brown acknowledged receipt, and between March 7 and April 1, 2010 Mr. Brown reviewed the file history and conducted research and held various discussions to determine courses of action for reviving Hermansen '885. On April 1, 2010, Mr. Brown contacted Mr. van Horn to discuss the situation.

On April 27-28, 2010, Mr. van Horn contacted the USPTO to discuss an appropriate avenue to proceed to rectify the injustice of the expiration of Hermansen '885 and the undersigned attorneys were asked to assist with this effort. Mr. van Horn subsequently arranged the meeting noted above, which was held at Mr. Bahr's earliest convenience on May 19, 2010. Additional evidence has been obtained periodically since May 19 from Crank Brothers, whose records have been partially compromised with the passage of time. In short, Crank Brothers and

their new counsel have diligently pursued the actual facts regarding Hermansen '885, and have diligently prepared this submission, during the time from about December 19, 2009 (well before the actual state of Hermansen '885 was known to Crank Brothers) to the present, despite being hindered by incorrect USPTO records as to the actual date of expiration, lack of an electronic USPTO file history for Hermansen '885, lack of complete contemporaneous correspondence between Crank Brothers and Tachner, and Crank Brothers' present inability to rely on accurate information from Tachner and his staff.

Based on the corrected record and the new facts showing diligence by Crank Brothers, it is believed that Tachner and his staff's apparent fraudulent and deceptive actions should be eliminated from consideration of the unavoidable delay in seeking reinstatement of Hermansen '885. Therefore, it is respectfully submitted that the relief previously granted in the Second Decision was appropriate and should be reinstated or that relief be granted based on the Petition when taking the corrected facts and elimination of the incorrect facts into account.

### **SUMMARY**

It is respectfully submitted that the delay in the payment of the first maintenance fee for Hermansen '885 has now been demonstrated to have been unavoidable. Specifically, the delay resulted from errors committed by Tachner's staff that were later apparently actively and intentionally concealed from Crank Brothers as well as the USPTO. Also, it has conclusively been shown that:

- (1) the error was the cause of the delay at issue;
- (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

The second maintenance fee, despite being timely paid and accepted, was later apparently refunded to Tachner in connection with the issuance of the unsolicited Third Decision.

In conclusion, all of the foregoing demonstrates that it was the docketing or clerical errors committed by Tachner's staff that resulted in the delay in payment of the first maintenance fee for Hermansen '885. Also, the error was apparently intentionally concealed by Tachner and his staff, which concealment prevented Crank Brothers from having an opportunity to cure the consequences of the error. Finally, had the error not been concealed, it would have been likely that Hermansen '885 would have been reinstated since the error appears to have been committed despite the exercise of due care by Tachner and his staff, such that the error was unexpected and unforeseen and, therefore, was unavoidable.

As shown herein, there was no confusion between Crank Brothers and Tachner. Rather, it was a docketing error or misunderstanding solely on the part of Tachner's staff, likely in the improper docketing and/or file jacket notation "client will pay." Thus, the main reason previously relied upon by the USPTO to deny relief to Crank Brothers was incorrect. The error was indeed unavoidable and completely due to a docketing error, which was undiscoverable until Crank Brothers requested the undersigned to investigate the facts, and was not due to any miscommunication on the part of Crank Brothers.

As demonstrated herein, all of the delay from the time Crank Brothers became aware of the Third Decision until the filing of this Supplemental Petition was unavoidable. Crank Brothers accordingly requests that the Commissioner grant this Supplemental Petition and accept submission of payment for both the first and second maintenance fees for Hermansen '885 so that the patent can be reinstated.

If any additional information would assist a decision on this Petition, please contact the undersigned attorneys for Crank Brothers. The Commissioner is hereby authorized to charge all

fees associated with this Supplemental Petition, including but not limited to the Petition fee, first and second maintenance fees and applicable surcharges to Deposit Account No. 08-1394, Order No. 70614.30.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP

\_\_\_\_\_  
Date

\_\_\_\_\_  
Charles E. Van Horn (Reg. No. 40,266)

HAYNES AND BOONE, LLP

\_\_\_\_\_  
Date

\_\_\_\_\_  
Jeffrey A. Wolfson (Reg. No. 42,234)

**HAYNES & BOONE LLP**

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**Exhibits A-Y**

D-1869591

I hereby certify that this correspondence is being filed with  
the United States Patent and Trademark Office via EFS-Web  
on the following date.

Date \_\_\_\_\_

\_\_\_\_\_

fees associated with this Supplemental Petition, including but not limited to the Petition fee, first and second maintenance fees and applicable surcharges to Deposit Account No. 08-1394, Order No. 70614.30.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP

21 July 2010  
Date

Charles E. Van Horn  
Charles E. Van Horn (Reg. No. 40,266)

HAYNES AND BOONE, LLP

July 21, 2010  
Date

Jeffrey A. Wolfson  
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**Exhibits A-Y**

D-1869591

<p>I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.</p> <p>Date <u>July 21, 2010</u></p> <p><u>Justin B. Sanford</u></p>
--

## EXHIBIT LIST

- Exhibit A: Petition for Acceptance of Delayed Payment of Maintenance Fee Under Rule 1.378(b), dated October 18, 2007
- Exhibit B: Decision dismissing the Petition, dated April 9, 2008
- Exhibit C: Request for Reconsideration of Petition for Acceptance of Delayed Payment of Maintenance Fee Under Rule 1.378(b), dated July 31, 2008
- Exhibit D: Second Decision granting the Petition, dated October 15, 2008
- Exhibit E: Third Decision which vacated the Second Decision and denied Petition, dated November 6, 2008
- Exhibit F: Declaration of Tom Chen, dated July 19, 2010, with Exhibits 1-2
- Exhibit G: E-mail from Winefordner to Tachner, dated March 27, 2008
- Exhibit H: Copy of stamped postcard receipt, dated May 17, 2004
- Exhibit I: Photograph of Tachner file cover for U.S. Patent No. 5,676,529
- Exhibit J: Photograph of Tachner file cover for U.S. Patent No. 6,027,319
- Exhibit K: Photograph of Tachner file cover for U.S. Patent No. 5,857,509
- Exhibit L: Photograph of Tachner file cover for U.S. Patent No. 6,059,245
- Exhibit M: Photograph of Tachner file cover for U.S. Patent No. 6,851,189
- Exhibit N: Photograph of Tachner file cover for U.S. Patent No. 7,225,703
- Exhibit O: Photograph of Tachner file cover for U.S. Patent No. 6,205,885
- Exhibit P: Notice of Patent Expiration, dated April 27, 2005
- Exhibit Q: E-mail from Winefordner to Tachner, dated July 14, 2008
- Exhibit R: Declaration of Carl Winefordner, dated July 19, 2010, with Exhibits 1-3 (Winefordner II Declaration)
- Exhibit S: Transaction history for U.S. Patent No. 5,676,529
- Exhibit T: Transaction history for U.S. Patent No. 5,857,509

## EXHIBIT LIST

- Exhibit U: E-mail from Foreman (Tachner's office) to Winefordner, dated October 3, 2007
- Exhibit V: List of Crank Brothers' U.S. and foreign patent matters handled by Tachner, dated October 3, 2007
- Exhibit W: Bibliographic data for U.S. Patent No. 6,205,885
- Exhibit X: E-mail from Crank Brothers' Italian counsel to Winefordner, dated December 15, 2009
- Exhibit Y: E-mail from Chen to McNally, dated January 21, 2010

# EXHIBIT A





**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Frank Hermansen et al	Assignee:	California Crank Brothers, Inc.
Patent No.:	6,205,885	Serial No.:	09/391,709
Issued:	March 27, 2001	Filed:	September 8, 1999
Title:	Clipless Bicycle Pedal		

**MAIL STOP: PETITIONS**

Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED

OCT 26 2001

Dear Sir:

**PETITION FOR ACCEPTANCE OF DELAYED  
PAYMENT OF MAINTENANCE FEES UNDER  
RULE 1.378(b)**

06/04/2001 161501 6265885  
02 FC:1557 15.00 CR -665.00 CP

The Petitioner herein, Leonard Tachner, respectfully requests granting of this petition, namely, a finding that expiration of the above-captioned patent based upon a delay of 24 months and 3 weeks in payment of the maintenance fee, was unavoidable.

06/04/2001 161501 6265885  
Case Number: 6265885  
161 4634 1664.00 CR

Enclosed herein are the required maintenance fee, the required surcharge and a showing as called for in Rule 1.378(h). The showing under paragraph (3) of 1.378(b) is provided herein in the form of a Declaration of my Office Manager, Janis Foreman.

In Ms. Foreman's Declaration, she explains under oath that the delay in payment resulted from an unfortunate confusion between our office staff and the patentee as to who would pay the maintenance fees for this client. Ms. Foreman believed that she had received instruction from the client that they would pay their own maintenance fees and

10/15/2000 CRLOK 6008001 660930 6265885

01 FC:2551 465.00 DP  
02 FC:1557 15.00 CR 665.00 CP

06/04/2001 161501 6265885  
02 FC:2552 1248.00 CR  
02 FC:2555 59.00 CR

PETITION FOR ACCEPTANCE OF DELAYED  
PAYMENT OF MAINTENANCE FEE UNDER  
RULE 1.378(b)  
6,205,885

FILED  
OCT 2 8 2007

notation to that effect on all appropriate docket sheets and on all corresponding file wrapper covers. Ms. Foreman has been my principal staff employee for over 29 years and Office Manager for about 25 years.

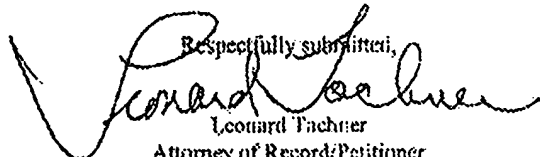
On or about October 3, 2007 we learned that the client/patentee had not paid the maintenance fee. We learned that the patentee had apparently forgotten the instruction communicated to Ms. Foreman and instead had assumed that our staff had paid the fee in a timely manner. We immediately set about to determine the cause of the delay in payment and have since determined that the cause was the aforementioned confusion between the instruction from the client and the client's apparent assumption that there was no such communication. We believe that the client's communication came in 2004 shortly after we paid the first maintenance fee on two earlier patents in February of that year and billed the client accordingly. We believe that the client had forgotten that they had given such an instruction to our staff.

The undersigned petitioner has a very active patent prosecution practice which has resulted in the issuance of upwards of least 500 U.S. patents over the past 29 years. We depend to a great extent on docket entries and file wrapper entries in meeting deadlines including if and when to pay maintenance fees. The delay in payment of the maintenance fee in regard to the above-captioned patent was due entirely to confusion between my staff and the client as to who would pay the fee. As soon as we learned of the problem, we started to determine what had occurred and to prepare this petition and attachments. We are submitting this petition 3 weeks beyond the two year limit under Rule 1.378(c) for unintentional delay.

**PETITION FOR ACCEPTANCE OF DELAYED  
PAYMENT OF MAINTENANCE FEE UNDER  
RULE 1.37H(b)**  
6,205,885

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OCT 24 2007

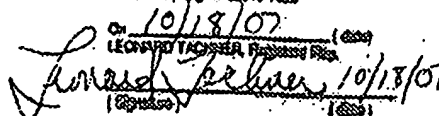
It is my earnest belief that the confusion and resulting payment delay was unavoidable. Nevertheless, I have instructed Ms. Foreman to rely only on written instruction from a client not to pay a maintenance fee for any reason in the future.

Respectfully submitted,  
  
Leonard Tachner  
Attorney of Record/Petitioner  
Registration No. 26,344

Dated: 10/18/07

(949) 752-8525 telephone  
(949) 955-2415 telefax

**CERTIFICATE OF MAILING**  
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to:  
MAIL STOP 10/18/07  
COMMISSIONER FOR PATENTS  
U.S. PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

On 10/18/07 (date)  
  
LEONARD TACHNER, Registered Filo.  
(Signature) 10/18/07 (date)



10-19-07

DAK/807m

P1038582 (10-00)

Approved for use through 6/30/2009, CMS 0651-0318  
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF  
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))**

Docket Number (Optional)  
SLIP-21

Mail to: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Fax: (571) 273-8300

RECEIVED

OCT 26 2007

NOTE: If information or assistance is needed in completing this form, please contact Patents Information  
at (571) 272-3262.

Patent No. 6,205,883 Application Number 09/391,709  
Issue Date March 27, 2001 Filing Date September 8, 1999

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent  
number (or reissue patent number, if a reissue) and (2) the application number of the  
actual U.S. application (or reissue application) leading to issuance of that patent to  
ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable

The above-identified patent:

☐ is a reissue of original Patent No. \_\_\_\_\_ original issue date \_\_\_\_\_  
original application number \_\_\_\_\_  
original filing date \_\_\_\_\_

Adjustment date: 18/10/2008 GARI05  
18/22/2007 EYALEM 00000040 6255085  
01 FC1594 -1158.00 CP

☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international  
application \_\_\_\_\_ filed on \_\_\_\_\_

**CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is  
(1) being deposited with the United States Postal Service on the date shown below with sufficient  
postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA 22313-1450 OR  
(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark  
Office at (571) 273-8300.

10/19/07  
Date

Leonard Tachner  
Signature

18/22/2007 EYALEM 00000040 6255085

LEONARD TACHNER

01 FC1594 1158.00 CP

Typed or printed name of person signing Certificate

01 FC1594 1158.00 CP

(Page 1 of 1)

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the patent which is to be (and by the  
USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 172 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 hours to  
complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any  
comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer,  
U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED  
FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-5109 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

1. SMALL ENTITY

☒ Petitioner claims, or has previously claimed, small entity status. See 37 CFR 1.27.

2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g).

3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$ _____	3 1/2 yr fee	(1551)	<input checked="" type="checkbox"/> \$ 450	3 1/2 yr fee	(2551)
<input type="checkbox"/> \$ _____	7 1/2 yr fee	(1552)	<input type="checkbox"/> \$ _____	7 1/2 yr fee	(2552)
<input type="checkbox"/> \$ _____	11 1/2 yr fee	(1553)	<input type="checkbox"/> \$ _____	11 1/2 yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$450

4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ 700

5. MANNER OF PAYMENT

☒ Enclosed is a check for the sum of \$ 1,150

☐ Please charge Deposit Account No. \_\_\_\_\_ the sum of \$ \_\_\_\_\_. A duplicate copy of this authorization is attached.

☐ Payment by credit card. Form PTO-2038 is attached.

6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 06-0930. A duplicate copy of this authorization is attached.

7. OVERPAYMENT

As to any overpayment made please

☒ Credit to Deposit Account No. 05-0930

OR

☐ Send refund check.

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioner/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

  
Signature(s) of Petitioner(s)

10/18/07  
Date

LEONARD TACHNER

26,344

Typed or printed name(s)

Registration Number, if applicable

17961 SKY PARK CIRCLE, SUITE 38-E

949-752-8525

Address

Telephone Number

IRVINE, CALIFORNIA 92614

Address

ENCLOSURES:

☒ Maintenance Fee payment

☒ Statement why maintenance fee was not paid timely

☒ Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)

☐ Other:

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

  
Signature

10/13/07  
Date

LEONARD TACHNER  
Typed or printed name

26,344  
Registration Number, if applicable

#### STATEMENT

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

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OCT 26 2007

(Please attach additional sheets if additional space is needed)



**UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Frank Hermansen et al	Assignee:	California Crank Brothers, Inc.
Patent No.:	6,205,885	Serial No.:	09/391,709
Issued:	March 27, 2001	Filed:	September 8, 1999
Title:	Clipless Bicycle Pedal		

**MAIL STOP: PETITIONS**

Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

OCT 26 2001

Dear Sir:

**DECLARATION OF JANIS FOREMAN**

I, Janis Foreman, declare as follows:

1. I am the Office Manager for Leonard Tachner, A Professional Law Corporation (the "Firm"). I began employment with the Firm over 29 years ago. My employment with the Firm has been continuous in the capacity of Office Manager for at least 25 years.

2. Along with Jodie Miller ("Miller"), secretary and docket clerk for the Firm, I manage the docket system for the Firm and frequently review docketing entries and due dates with Leonard Tachner ("Tachner"). The docket system tracks payment due dates for maintenance fees and for all other deadlines with the USPTO. The procedure for responding to a docket entry regarding a maintenance fee payment includes: 1) sending a letter to the client to explain the fee and deadline; and (2) paying the maintenance fee usually after receiving authorization, written or oral, from the client.



#### DECLARATION OF JANIS FOREMAN

3. Around March 2001, when the Firm received the above-captioned issued patent, I supervised Miller to assure that entries were made in the docket system for September 27, 2004 (3.5 yr annuity), September 27, 2008 (7.5 yr annuity) and September 27, 2012 (11.5 yr annuity) deadlines for payment of the maintenance fees, and to send a letter to the client explaining the requirement for paying the maintenance fees.

4. However, before the first annuity became due (September 27, 2004) I entered a statement on the face of the file that the client would pay the annuities (see photocopy of docket sheet attached as Exhibit A). Also attached are photocopies of docket sheets showing some of this client's other patent annuities wherein it is noted on the docket sheet that the client will pay their own annuities (attached hereto as Exhibits B1-B3). As shown in attached Exhibit C which is a photocopy of the face of our Docket No. SLIP-21, it is noted the client will pay the maintenance fee. All of the issued patent file faces for this client show that the client will pay their own annuities as of mid-2004 (see sample photocopies attached as Exhibits D1-D6). I recall doing so based on a discussion with the client indicating that they would pay their own annuities. It is not unusual for a client to express the desire to pay their own maintenance fees in order to avoid having to pay the firm the additional service fee we charge for doing so. For example, attached hereto is Exhibit E which is a photocopy of the face cover of Docket No. MATHENY-1 wherein the face of the file shows an entry indicating that the client has instructed us that they will pay their own maintenance fees. The same is true for Exhibit F for our Docket No. VLAD-1 (photocopy attached).

5. On October 3, 2007, the client inquired about annuity payments and specifically, if the annuity for this patent had been paid. I informed them that I had not paid the maintenance fee since I was under the impression that they had wanted to pay the maintenance fee themselves.

6. The client stated that they did not remember giving me the instruction that "they would pay their own maintenance fees". The client stated how important this patent is to their company and requested that we immediately begin a process to reinstate their patent.

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OCT 26 2007

**DECLARATION OF JANIS FOREMAN**

7. Because there appears to have been confusion between the client and myself regarding who would pay the maintenance fees and because neither the client nor I could find any written document providing instructions to pay or not to pay the maintenance fee, I believe the non-payment of this maintenance fee was unavoidable.

8. Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declarations made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the present patent.

Janis Foreman  
Declarant's Signature

10/18/07  
Date

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to:

MAIL STOP Patent  
COMMISSIONER FOR PATENTS  
U.S. PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

On 10/18/07 (date)  
I, Edward Tachner, Registered Rep.

Edward Tachner (Signature) 10/18/07 (date)

NAME Sepúlveda no. 107 Page 4 of 4

70 69

Exhibit 1[illegible]

# Exhibit B,

Page 1-4 3

April 20 05

DOCKET NO.	TYPE OF ACTION	FILE DATE	ACTION TAKEN IN RESPONSE	RESPONSE DATE
PUC 100-30/Canada	O.A. Due	4-5-05	See J.F. - 7-5-05	
Engine-6	Resp. to 2 <sup>nd</sup> (final) O.A.	4-6-05	Ame	1-20-05
Fisher-B	2 <sup>nd</sup> Annuit. ty	4-7-05	See 10-7-05	10/1/05
SOCK-2	Resp. to 3 <sup>rd</sup> (final) O.A.	4-7-05	See 7-7-05	10/1/05
Hypo-2/PCT	CH II: Due	4-8-05	Chp. II due 3-8-06	3/8/06
Salido-1/Het/annuity	Req. to 1 <sup>st</sup> O.A.	4-11-05	See J.F. (7-11-05)	
Airgain-1	Full Application/per Taiwan	4-12-05	Handled by another client/Attorney	
Airgain-2	Full Application/per Taiwan	4-13-05	Added full app, PCT & Taiwan on 4-13-05	4-3-05
Tay-1	Section 8 & 15 Affs.	4-13-05	See J.F. / No Resp from client	
QTech-2	Resp. to 1 <sup>st</sup> O.A.	4-13-05	Ame	3-18-05
Slip-2	2 <sup>nd</sup> Annuit. ty	4-14-05	Client will pay	
Salido-1/Het/final	Annuit. ty Due	4-14-05	See 10-14-05	10/14/05

# Exhibit B<sub>2</sub>

MONTH: July 20 06 Page 2

DOCKET NO.	TYPE OF ACTION	DUE DATE	ACTION TAKEN IN RESPONSE	RESPONSE DATE
Sheico-19	Resp to 1 <sup>st</sup> O.A.	7-7-06	Amc	6-14-06
Morlyn-1/cip-3	Resp to 2 <sup>nd</sup> O.A.	7-7-06	No response	
100,340/raim	Annuity	7-10-06	Assoc. paid	
ASM-141	3 <sup>rd</sup> Maint. fee	7-10-06	No longer our client	
ASM-140C	3 <sup>rd</sup> Maint fee	7-10-06	No longer our client	
GU00-2/3/pt/Kara	Annuity	7-11-06	No longer our client	
GU00-2/3/pt/Kara	Exam Due	7-11-06	No longer our client	
Slip-3	2 <sup>nd</sup> Annuity	7-12-06	Client will pay	
XR-1	Resp. to O.A.	7-12-06	Sent	3-14-06
6082005-1/pt/Kara	Exam Due	7-13-06	Assoc. Requested	
6082005-1/pt/Kara	Annuity	7-13-06	Assoc. paid	
Scuba-6/c	3 <sup>rd</sup> Annuity	7-17-06	No longer our client	

# Exhibit B3

MONTH August 2007 Page 3

DOCKET NO.	TYPE OF ACTION	DUE DATE	ACTION TAKEN IN RESPONSE	RESPONSE DATE
100.255/canada	Annuity	8-20-07	Assoc. Paid	
100.256/epo	Annuity	8-20-07	Assoc. Paid	
100.257/canada	Annuity	8-20-07	Assoc. Paid	
100.253/china	Annuity	8-20-07	Assoc. Paid	
100.261/epa	Annuity	8-20-07	Assoc. Paid	
100.251/epo	Annuity	8-20-07	Assoc. Paid	
100.247/epo	Annuity	8-20-07	Assoc. Paid	
100.258/china	Annuity	8-20-07	Assoc. Paid	
100.249/china	Annuity	8-20-07	Assoc. Paid	
100.248/canada	Annuity	8-20-07	Assoc. Paid	
100.265/canada	Annuity	8-20-07	Assoc. Paid	
Slip-2/cip	2 <sup>nd</sup> Annuity	8-22-07	Client will pay	

Exhibit C ISSUED

INVENTOR Frank Hermansen and Carl Winegardner  
SERIAL NO. 09/391,709 FILED 9-8-99  
TITLE Clipless Bicycle Pedal

ASSIGNEE

ASSIGNMENT REQUIRED \_\_\_\_\_ FEE \_\_\_\_\_ FINE \_\_\_\_\_

OFFICE ACTIONS	AMENDMENTS
9-27-04 First Annuity	Client to pay annuities
9-27-08 Second Annuity	
9-27-12 Third Annuity	

RECEIVED

OCT 26 2007

OFFICE OF THE COMPTROLLER

ALLOWED \_\_\_\_\_ FINAL FEE PAID \_\_\_\_\_  
PATENT NO. US 6,205,885 B1 DATE March 27, 2001

© Kratzman  
10100 10th Avenue, Suite 100, San Diego, CA 92121 (619) 594-1100  
Fax: (619) 594-1101

ISSUED

CLIENT'S TITLE SLIP-21  
DIVISION OR  
CONTINUATION IN PART OF  
INVENTOR Hermansen, Frank et al.  
SERIAL NO. 09/391,709

EXHIBIT D

LAW OFFICES OF LEONARD TACHNER  
REGISTERED PATENT ATTORNEY  
3990 WESTERLY PLACE  
SUITE 295  
NEWPORT BEACH, CALIFORNIA 92660  
(714) 752-8525

ISSUED

INVENTOR: FRANK HAMMENSEN AND CARL WINTERS  
SERIAL NO. 08/680,749 FILED 7-5-96  
TITLE: Compact Manual Air Pump Having Selectable  
High Volume and High Pressure Modes

ASSIGNEE

ASSIGNMENT RECEIVED \_\_\_\_\_ REEL \_\_\_\_\_ FRAME \_\_\_\_\_

OFFICE ACTIONS	AMENDMENTS
12-13-96 Rejected O.A.	12-12-96 ame.
5-5-97 Issue fees + Dange	5-5-97 drawings
4-14-2001 First Annuity	10-15-2001 pt w/annul
4-11-2005 Second Annuity	client will pay
11-21-2007 Third Annuity	

2nd Annuity  
Pd w/ Petition  
10-3-07

OFFICE OF  
OCT 26 1997  
U.S. DEPT. OF COMMERCE

ALLOWED \_\_\_\_\_ FINAL FEE PAID \_\_\_\_\_  
PATENT NO. 5,676,529 DATE October 14, 1997

ISSUED

CLIENT & TITLE  
INVENTOR  
CONVENTION IN PART OF  
Slip 2  
Hammsen, Carl Winters  
INVENTOR  
08/680,749  
SERIAL NO.



EXHIBIT 02

LAW OFFICES OF LEONARD TACHNER  
REGISTERED PATENT ATTORNEY  
3630 WESTERLY PLACE  
SUITE 295  
NEWPORT BEACH, CALIFORNIA 92660  
(714) 792-4325

ISSUED

INVENTOR <u>CHIEF, WINDFARMER and Frank Hermannsen</u>	
SERIAL NO. <u>08/945,068</u>	FILED <u>4-21-97</u>
TITLE <u>COMPACT MANUAL AIR PUMP HAVING</u> <u>SELECTABLE HIGH VOLUME AND HIGH PRESSURE MODES</u>	
ASSIGNEE	
ASSIGNMENT RECORDED _____ FEE _____ FRANK _____	
OFFICE ACTIONS	AMENDMENTS
3-31-99 Resp to First O.A.	4-18-99 Amend. Inv. etc.
	4-16-99 Supp. Amend.
2-1-99 Resp to 2nd O.A.	2-3-99 Amend
12-27-99 Issue First Formal Opp.	12-23-99 pl. a. drugs. rad. ch. clp
8-22-03 First Annuit.	2-23-04 2nd Opp.
8-22-07 Second Annuit.	Client. ph. ps
9-22-2011 Third Annuit.	

2nd Annuit.  
pd w/surch.  
10-3-07

FILED  
OCT 28 2007  
U.S. PATENT & TRADEMARK OFFICE  
NEWPORT BEACH, CALIF.

ALSO FILED \_\_\_\_\_ FINAL FEE PAID \_\_\_\_\_  
PATENT FEE 6,027.319 DATE February 22 2008

ISSUED

CLIENT or TITLE	INVENTOR	OTHER FOREIGN SERIAL NO.
08/945,068	WINDFARMER, Frank Hermannsen, Carl et al.	08/945,068

Exhibit D.3

LAW OFFICES OF LEONARD TACHNER  
REGISTERED PATENT ATTORNEY  
3090 WESTERLY PLACE  
SUITE 255  
NEWPORT BEACH, CALIFORNIA 92660  
(714) 752-8925

ISSUED

INVENTOR CARL WINE, EUGENE and Frank Hermanson  
SERIAL NO. 08/718,766 FILED 9-25-96  
TITLE IMPROVED BICYCLE TIRE LEVER

ASSIGNEE

ASSIGNMENT RECORDED \_\_\_\_\_ FILED \_\_\_\_\_ FRAME \_\_\_\_\_

OFFICE ACTIONS	AMENDMENTS
2-24-97 Resp. to First O.A.	11-5-97 AUC
3-24-98 Resp. to Second (Comm.) O.A.	2-22-98 JLU EWC
10-14-98 Issue Fees + Gen'l. Drgs.	10-14-98 pd a. d. d. d. d.
7-12-2002 First Annuity	7-12-02 pd
7-12-2006 Second Annuity	Client pays
7-12-2010 Third Annuity	

2nd Annuity  
pd w/ petition  
10-3-07

ALLOWED

PATENT NO. 5,

DATE

January 12, 1999

ISSUED

CLIENT & TITLE  
DIVISION OF  
COMPARISON IN PATENT

INVENTOR

OTHER FOREIGN

SERIAL NO.

08/718,766

Exhibit D4

Issued

INVENTOR Frank Heamansen and Carl Wine Fordner  
SERIAL NO. 01/00,361 FILED 6-19-98  
TITLE LOCKING WATER BOTTLE CASE  
FOR BICYCLES

ASSIGNEE

ASSIGNMENT RECORDED

REEL

FRAMES

OFFICE ACTIONS	AMENDMENTS
10-20-99 Resp. to First O.A.	9-3-99 amm.
12-13-99 Issue First Formal Docs	12-13-99 pl. dupes + Chgs. added
11-9-03 First Annuity	2-23-04 pl. up/ours
11-9-07 Second Annuity	client pays
11-9-11 Third Annuity	

ALLOWED

FINAL FEE PAID

PATENT NO.

6,059,245

DATE

May 9, 2000

Issued

CLIENT'S TITLE  
SUBSEQUENT  
CONTINUATION IN PART OF

01/079078 5-14-98

CANALIAN

OTHER REFERENCE

SERIAL NO.

SERIAL NO.

SLIP-5/c/p

Heamansen, Frank et al.

01/00,361

I瑞典

INVENTOR Frank Hammond and Carol Wynn Enchies  
SERIAL NO. 10/375,243 FILED 2-27-03  
TITLE Method of Fabricating a Clipless Bicycle Pedal  
ASSIGNEE \_\_\_\_\_  
ASSIGNMENT RECORDED \_\_\_\_\_ REEL \_\_\_\_\_ FRAME \_\_\_\_\_

OFFICE ACTIONS	AMENDMENTS
2-27-04 PCT and Taiwan	2-26-04 done
7-24-04 Restriction Election	7-26-04 done
12-30-04 Issue Fee & Due	12-30-04 paid
8-8-08 1 <sup>st</sup> Annuity	client to pay annuities
8-8-12 2 <sup>nd</sup> Annuity	
8-8-16 3 <sup>rd</sup> Annuity	

ALLOWED \_\_\_\_\_ FEE PAID \_\_\_\_\_  
PATENT NO. US 6,851,189 B2 DATE February 8, 2005

Issued

155ver

02/21/75

## MAXENTON

**REF: 440.**

Issued

~~7-26-73~~

ASSIGNMENT RECORDED \_\_\_\_\_ REEL \_\_\_\_\_ FRAME \_\_\_\_\_

OFFICE ACTIONS	AMENDMENTS
4-9-2001 Subsequent appeal due filed	4-6-2001
4-30-01 Resp to First O.A.	7-30-01 Barrett & CPA
01 Resp to 2nd O.A.	12-4-01 ame
7-23-02 Resp to 3rd Final O.A.	7-23-02 ame
11-13-02 Issue fees only	11-13-02 pd
9-18-06 1st Amr	6-21-06 client pd
9-12-07 2nd Amr	
9-18-14 3rd Amr	

ALLOWED \_\_\_\_\_ TRIAL FEE PAID \_\_\_\_\_  
PATENT NO. 6,535,181 DATE 3-18-2003

CONFIDENTIAL

INVENTOR:

CARL G. WILSON

SEVERAL NO.

DISCUSSION

ISSUED

12A2-1  
Provisional  
603/88-336 5-9-00

**Sevast'yanov, Vladimir**  
INVENTOR

**CHARNIN**

09/10/66  
SERIAL NO.  
OTHER DESIGNATION

ISSUED

# EXHIBIT B





UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22311-1450  
www.uspto.gov

LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

COPY MAILED

APR 09 2008

OFFICE OF PETITIONS

In re Patent of Hermansen et al. :  
Patent No. 6,205,885 :  
Issue Date: March 27, 2001 :  
Application No. 09/391,709 :  
Filing Date: September 8, 1999 :  
Attorney Docket No. SLIP-21 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.378(b), filed October 18, 2007, to reinstate the above-identified patent.

The petition is **DISMISSED**.

Facts:

The instant patent issued March 27, 2001.

The last day the maintenance fee could have been timely paid, with a surcharge, was Monday, March 28, 2005. The maintenance fee was not timely paid and the patent expired at midnight on March 28, 2005.

The law firm who handled prosecution of the patent, as well as several of petitioner's other patents, had paid maintenance fees for two of petitioner's patents during February of 2004. When the law firm pays a maintenance fee on behalf of a client, the law firm charges the client a service fee. The declaration of Janis Foreman indicates it is not unusual for a client to request to pay their own fees in order to avoid payment of the service fee.

Ms. Foreman believes she received instructions from the client on a date around mid-2004 stating the client would pay maintenance fees in the future. Ms. Foreman states, "All of the issued patent files for this client show that the client will pay their own annuities as of mid-2004."

The 3.5 year maintenance fee for the instant patent could have been paid, without a surcharge, as early as March 27, 2004, and as late as Monday, September 27, 2004. The law firm's docket sheet for the instant patent stated the due date for the first maintenance fee was September 27, 2004. The corresponding "Action Taken in Response" column stated, "Client said they will pay."

Patent No. 6,851,189 issued February 8, 2005. A copy of the front of the file includes an entry stating the issue paid was paid December 30, 2004. A following entry indicates "client to pay annuities."

Patent No. 7,225,703 issued June 5, 2007. A copy of the front of the file includes an entry stating the issue fee was paid April 16, 2007. A following entry indicates "client pays annuities."

Petitioner does not remember informing Ms. Foreman that Petitioner would handle payment of maintenance fees in the future.

On or about October 3, 2007, the law firm learned from petitioner that petitioner had not paid the maintenance fee.

The instant petition was filed October 18, 2007.

#### The Law:

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Director that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable.

In order for a party to prove unavoidable delay, the Office requires the party demonstrate the party exercised the "care or diligence that is generally used and observed by prudent and careful men in relation to their most important business."<sup>1</sup> However, "the question of whether [delay] was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>2</sup>

The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

The Office and Congress have recognized the unavoidable standard can be very difficult to meet. During 1992, Congress considered the difficulty involved in reinstating a patent under the unavoidable. Congressional representatives described the unavoidable standard as inflexible, extremely hard to meet, too stringent and harsh.<sup>3</sup> Congress did NOT take steps to make the

<sup>1</sup> *In re Matveich*, 38 App. D.C. 491, 314-15 (D.C. Cir. 1912). See also *Rex v. Latham*, 35 F.3d 506, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1993) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

<sup>2</sup> *Smith v. Moxness*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

<sup>3</sup> "[The unavoidable] standard has been found to be extremely hard to meet. Some patent owners have lost their patent rights due to this inflexible standard." 118 CONG. REC. S16613, 16614 (September 30, 1992) (Rep. DeConcini) (emphasis added). "The unavoidable standard has proved to be too stringent in many cases." 118 CONG. REC. H1135 (October 3, 1992) (Rep. Hughes) (emphasis added). "The unavoidable standard is too stringent. Some patent owners have lost their patent rights due to

unavoidable standard more flexible, easier to meet, less stringent, or less harsh. Instead, Congress determined that it would allow patent owners the ability to reinstate a patent under an "unintentional" standard as long as the petition was filed within 24 months of the expiration of the patent. Congress chose to continue requiring proof of unavoidable delay for petitions filed after the 24 month time period.

#### Application of the Law to the Facts:

Based on the facts in the record, it appears the most likely explanation for petitioner's failure to pay the fee is:

- (1) Petitioner informed the law firm petitioner would pay maintenance fees in the future,
- (2) Petitioner failed to take steps to ensure the fees would be timely paid, and
- (3) Petitioner failed to pay the fees.

An entity treating the patent the same as a reasonable and prudent person would treat his or her most important business would not absolve the law firm of responsibility for monitoring maintenance fees without taking reasonable and reliable steps to ensure maintenance fees for the patents in the future. The petition fails to list any steps taken by petitioner to ensure the fee would be paid timely.

Petitioner must prove the entire delay was unavoidable. When the law firm paid the maintenance fees for two patents during February 2004, did the law firm send petitioner a bill? If yes, and if petitioner was relying on the law firm, why did petitioner fail to inquire into the reason it was not receiving future bills for maintenance fees during the following period of over three years.

The petition states the law firm learned petitioner had not paid the fee during October 2007. However, the petition fails to discuss the date petitioner learned the maintenance fee had not been paid. When did petitioner first learn that the maintenance fee for the instant patent, or any of its other patents, had not been timely paid?

Any request for reconsideration should be accompanied by a statement by an employee or officer of petitioner with first hand knowledge of the relevant facts concerning petitioner's actions and inactions with respect to petitioner's patents and the maintenance fees for each patent.

Even if petitioner could prove it never informed the law firm it would pay the fees, and prove it was reasonable in relying on the law firm to pay maintenance fees, such a showing would not necessarily demonstrate unavoidable delay. Reasonable reliance on a third party representative does not, per se, constitute "unavoidable" delay. When a party relies on an agent to take certain steps, the petition must address not only the party's actions but also address the agent's actions or inactions.<sup>4</sup> A showing is insufficient if it merely establishes that petitioner did everything

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circumstances that do not warrant this highly result, but that could not be considered 'unavoidable' under current law." 136 CONG. REC. 61688 (June 6, 1992) (extension of remarks of Rep. McCollum) (emphasis added).

<sup>4</sup> See *Placer Inv. Serv. Co. v. Rumschick Assoc., Ltd. P'ship*, 507 U.S. 380, 396, 397 (1993) ("The [Circuit] court also appeared to focus its analysis on whether respondents did all they reasonably could in policing the conduct of their attorney, rather than on whether their attorney, as respondents' agent, did all he reasonably could to comply with the court-order bar date.

petitioner could to monitor the agent's actions and inactions, but fails to address the agent's conduct.<sup>5</sup>

Even if a petitioner ensures his agent is an attorney rather than, for example, an individual with little knowledge of the law, petitioner will still be bound by the agent's conduct. The Tenth Circuit has stated, "Plaintiff argues against the harshness of penalizing him for his attorney's conduct. But there is nothing novel here (footnote omitted). Those who act through agents are customarily bound by their agents' mistakes. It is no different when the agent is an attorney."<sup>6</sup>

The Tenth Circuit is not alone in holding parties bound by the actions of their agents. The Supreme Court has stated, with emphasis added,

- \* Petitioner voluntarily chose his attorney as his *representative* in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected *agent* ... Each party is deemed bound by the acts of his lawyer-agent and is considered to have notice of all facts, notice of which can be charged upon the attorney.<sup>7</sup>

The effects of holding petitioner bound by petitioner's agent's conduct may seem harsh. However, as footnote 10 which follows the above quotation explains,

Clients have been held to be bound by their counsels' inaction in cases . . . when the consequences have been more serious. (Citations omitted). Surely if a criminal defendant may be convicted because he did not have the presence of mind to repudiate his attorney's conduct in the course of the trial, a civil plaintiff may be deprived of his claim if he failed to see to it that his lawyer acted with dispatch in the prosecution of his lawsuit.

Petitioner has not shown that the law firm's actions were reasonable even if petitioner never informed the law firm petitioner would pay the fees. If petitioner never informed the law firm that petition would pay the fees, then Ms. Foreman's conduct does not appear to have been reasonable. Ms. Foreman did not simply make a typographical or minor clerical error. Instead, near mid-2004, she intentionally changed most, if not all of petitioner's files, to indicate petitioner would be paying the fee.

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In this, the court erred. . . . [I]n determining whether respondents' failure to file their proof of claim prior to the bar date was excusable, the proper focus is upon whether the neglect of respondents *and their counsel* was excusable." (emphasis in original). In *Higdon v. Ladd*, 973 F.2d 1564, 1567, 23 U.S.P.Q.2D (BNA) 1916 (Fed. Cir. 1992), the court determined the client was bound by the attorney's actions. The majority was unpersuaded by the dissent which states in part that the "errors occurred despite exceptional vigilance by the client."

<sup>5</sup> See 1d.

<sup>6</sup> *Giles v. City of Enid, Oklahoma*, 312 F.3d 1164, 1169 (10th Cir. 2002).

<sup>7</sup> *Link v. Wash. Railroad Co.*, 170 U.S. 626, 633-634, 6 L. Ed. 2d 714, 82 S. Ct. 1386 (1962) (quoting *Smith v. Axt*, 101 U.S. 329, 326 (1880)).

The Office notes Ms. Foreman has stated, "All of the issued patent files for this client show that the client will pay their own annuities as of mid-2004." However, the front of the files for Patent No. 6,851,189, and Patent No. 7,225,703, render the comment ambiguous. The front of each file appears to indicate the "client to pay" entries were made after mid-2004. For Patent No. 6,851,189, the entry indicating "client to pay annuities" follows the entry indicating the issue fee was paid December 30, 2004. For Patent No. 7,225,703, the entry indicating "client pays annuities" follows the entry indicating the issue fee was paid April 16, 2007. If Ms. Foreman made an error, it appears she made the same error on multiple occasions. Any request for reconsideration should be accompanied by a full discussion of each occasion Ms. Foreman changed any of petitioner's files to indicate petitioner would pay the fee.

Petitioner bears the burden of proof. A review of the petition indicates the showing of record is insufficient to prove the entire delay was unavoidable within the meaning of 37 CFR 1.378(b). Therefore, the petition must be dismissed.

#### Petitioner's current options

##### I. Petitioner may file a request for reconsideration.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 CFR 1.17. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.378(b)." This is not final agency action within the meaning of 5 U.S.C. § 704.

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable, petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

##### II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Since the petition is dismissed, petitioner may request a refund of the maintenance fee and surcharge. Petitioner is reminded that if a request for reconsideration is later filed along with the \$400 fee, the \$400 will not be refunded. A request for a refund should be sent to: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany any request for refund.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA. 22313-1450

By facsimile: (571) 273-8300  
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney  
Steven Brantley at (571) 272-3203.



Charles Steven Brantley  
Senior Petitions Attorney  
Office of Petitions

# EXHIBIT C



7-4-8

DAC

#9

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Frank Hermansen et al	Assignee:	California Crank Brothers, Inc.
Patent No.:	6,205,885	Serial No.:	09/391,709
Issued:	March 27, 2001	Filed:	September 8, 1999
Title:	Clipless Bicycle Pedal		

**MAIL STOP: PETITIONS**

Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

**AUG 12 2008**

**OFFICE OF PETITIONS**

Dear Sir:

**REQUEST FOR RECONSIDERATION OF PETITION FOR ACCEPTANCE  
OF DELAYED PAYMENT OF MAINTENANCE FEE UNDER  
RULE 1.378(b)**

Petitioner hereby respectfully requests reconsideration of the April 9, 2008 Dismissal of its October 18, 2007 Petition. Enclosed herewith by way of additional evidence are declarations of Carl Winefordner and Frank Hermansen, co-inventors of the subject patent and principals of the patent owner, California Crank Brothers, and of their patent attorney, the undersigned, Leonard Tachner.

The Declarations of Messrs. Winefordner and Hermansen provide evidence that it was an apparent misunderstanding as to who would pay the maintenance fees for the subject patent and that they did not instruct Ms. Foreman, Mr. Tachner's office manager to not pay the maintenance fees. Mr. Winefordner also described how important is the subject patent and that it had been the normal course of having Mr. Tachner's firm pay the maintenance fees for other patents and that this patent was not an exception to that normal course. They indicate that they are 100% sure and without any doubt that they instructed Ms. Foreman to pay the maintenance fees on the '885 patent.

08/05/2008 558H000 00090013 09391709

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\$100.00 EP



**REQUEST FOR RECONSIDERATION OF PETITION FOR ACCEPTANCE OF DELAYED  
PAYMENT OF MAINTENANCE FEE UNDER RULE 1.378(b)**

Leonard Tachner's Declaration describes the relevant events surrounding the delayed payment of the maintenance fee and the fact that Ms. Foreman made a profound clerical error based on her misunderstanding of the instructions from the client. He also explains that the misunderstanding stems primarily from Ms. Foreman's distraction, or confusion or unusual lack of dependable adherence to a client's instructions. He explains that after decades of her usual dependability and care in carrying out his and his client's instructions, he had reasonably come to expect accurate and true performance of her duties. Mr. Tachner also states that the misunderstanding of the client's instructions and resulting clerical error could be due in part to or exacerbated by the fact that this patent was based on an application prepared, filed and prosecuted by the client and not by Tachner's office and that this particular client had often done at least some of its own patent application preparation in order to reduce attorneys' fees before it attained its current success.

Based upon this new evidence, Mr. Tachner expresses his belief that the misunderstanding of the client's instructions by Ms. Foreman resulted in an erroneous docket entry (i.e., client to pay annuities) which was subsequently relied upon in the due course of Tachner's standard office process and that this resulted in the unavoidable delay of the maintenance fee payment. For all of the above-noted reasons, Petitioner earnestly solicits reconsideration of the dismissal and granting of the Petition to accept the delayed payment. Enclosed herewith is a check for the fee appropriate for such reconsideration per Patent Office rules.

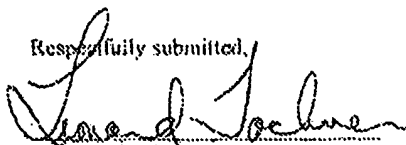
The undersigned has found this episode to be an extremely stressful and frightening experience. First and foremost because a long term, valued client, is in danger of losing a very valuable patent because of a simple human misunderstanding that resulted in a clerical error of profound significance. Second, because if this request for reconsideration of the petition is found lacking, I am personally at risk for a staggering liability which would likely terminate a 36-year

REQUEST FOR RECONSIDERATION OF PETITION FOR ACCEPTANCE OF DELAYED  
PAYMENT OF MAINTENANCE FEE UNDER RULE 1.378(b)

career as a patent professional and negatively affect the rest of my life. Therefore, I respectfully request that any doubt that there may be as to the unavoidability of the delay in payment, be looked upon in the light most favorable to the granting of the petition.

Dated: July 30, 2008

Respectfully submitted,



Leonard Tachner  
Attorney of The Petitioner  
Registration No. 26,344

(949) 752-8525 telephone  
(949) 955-2415 telefax



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Frank Hennansen et al	Assignee:	California Crank Brothers, Inc.
Patent No.:	6,205,885	Serial No.:	09/391,709
Issued:	March 27, 2001	Filed:	September 8, 1999
Title:	Clipless Bicycle Pedal		

**MAIL STOP: PETITIONS**

Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

**AUG 1 2 2008**

**OFFICE OF PETITIONS**

Dear Sir:

**DECLARATION OF LEONARD TACHNER IN SUPPORT OF REQUEST FOR  
RE-CONSIDERATION OF PETITION FOR ACCEPTANCE OF DELAYED  
PAYMENT OF MAINTENANCE FEE UNDER  
RULE 1.378(b)**

1. I am a registered patent attorney having registration No. 26,344. I was admitted as a patent agent in 1972 and as a patent attorney in 1974. I was admitted to the State Bar of California in 1973 and have remained in good standing since then. I have maintained a small law firm IP practice since 1978. Today I have a sole practice in Irvine, California. I have two secretaries working for me, Janis Foreman and Jodie Miller. Ms. Foreman is also my office manager and has been an employee of mine since the summer of 1978.

2. Over a period of almost thirty years I personally trained Ms. Foreman to carry out numerous duties in my practice. Included among these duties is that of being responsible for the timely payment of maintenance fees for our clients' issued U.S. patents. I have also instructed her in communicating with clients in a timely manner to learn whether they wish to have us pay maintenance fees for them so that we can anticipate being reimbursed for that payment and being paid a reasonable service fee. Over that period of time that I have come to rely on Ms. Foreman

DECLARATION OF LEONARD TACHNER Continued  
Patent No. 6,205,885

to properly carry out these duties, she has paid hundreds of maintenance fees to the U.S. Patent and Trademark Office. I've also come to rely on Ms. Foreman to pay issue fees for allowed patent applications and to communicate with our clients and foreign associates in regard to payment of foreign patent annuities. In order to conduct a successful and efficient practice it had become necessary for me to expect that Ms. Foreman would continue to carry out my instructions in a reliable and accurate manner that was consistent with the wishes of our clients, as she had done for so many years.

3. My firm represents a company named California Crank Brothers (the Petitioner herein), and its two owners, Carl Winefordner and Frank Hermansen who are the inventors named in U.S. Patent No. 6,205,885 which issued on March 27, 2001. The corresponding application was filed by the inventors themselves on September 8, 1999 under Serial No. 09/391,709. I was not an attorney of record in regard to that application, which was prosecuted by the inventors in pro per. It has been common for Messrs. Winefordner and Hermansen to do much of their own work in regard to patent applications in order to reduce attorney fees. I have been happy to assist them to the extent they wished, even though my relationship with them has been somewhat unusual for my practice. In the vast majority of my client relationships, I prepare, file and prosecute patent applications from an informal written or oral disclosure of an invention, consulting occasionally with the inventor as necessary.

4. In October 2007 I learned that some of the Winefordner and Hermansen issued patents, including the 6,205,885 patent had lapsed for non-payment of maintenance fees. Ms. Foreman informed me that she had been instructed by Winefordner and Hermansen that they would be paying their own maintenance fees to avoid our service fees for making those payments. I checked with the client in that regard and was told that they were sure that they had not given her such an instruction. At the time, I was not sure whom to believe since it seemed to me that avoiding service fees would be consistent with the client's prior attempts to minimize their expenses in regard to IP. Moreover, Ms. Foreman had been a trustworthy office manager

DECLARATION OF LEONARD TACHNER Continued  
Patent No. 6,205,385

for over twenty years and I had no reason to question her belief that we were no longer responsible for paying maintenance fees for Winefordner and Hermansen. However, in light of the apparent inconsistency between Ms. Foreman and the client in regard to such responsibility, I assumed that there may have been a misunderstanding and on that basis I began working on a petition for delayed acceptance of the maintenance fee for the '885 patent, which petition was filed October 18, 2007.

5. In retrospect, it seemed strange to me that neither we nor the client received a maintenance fee reminder for '885 patent. Ms. Foreman assured me that we had not received such document and the client also has informed me that they had not received such document. Moreover, on July 11, 2008 I learned that the Petitions Office had mailed a written decision (a dismissal) to my office on April 9, 2008. I received a facsimile copy of the decision on July 14, 2008 and read it for the first time on that day. I had not had any knowledge of the content of that decision until July 14, 2008 and I had no knowledge of it being rendered and mailed by the Petitions Office on April 9, 2008 until I checked PAIR for '885 patent on Friday July 11, 2008. Ms. Foreman maintained that the April 9 decision letter was not received by our office until we received the fax copy of July 14, 2008. Attached hereto as Exhibit A is our computer docket sheet for the period April 30, 2008 to June 13, 2008 showing no entry was made for the June 9, 2008 deadline for seeking reconsideration of the April 9, 2008 decision.

6. Because I did not file or prosecute the '885 patent, we have no file history for it. Apparently, Messrs. Winefordner and Hermansen still have the prosecution documents for the '885 patent. We have made a substitute file in which there is only a copy of the issued patent and a copy of our October 2007 petition. Any and all documents that might have been received by our office from the USPTO in regard to the '885 patent should be contained in that file, but there are none.

DECLARATION OF LEONARD TACHNER Continued  
Patent No. 6,205,885

7. Ms. Foreman has been a hard-working, dedicated and loyal employee of my firm for decades. I've not previously had reason to doubt her word or question her actions. Ms. Foreman has through many years of her service to the firm and in her relation with clients over that period, convinced me that she could be relied upon to communicate unambiguously with clients and to follow instructions from me and from clients in regard to what to pay or not pay to the Patent Office in behalf of clients. While I did not learn until October 2007 that Ms. Foreman had not paid the maintenance fee for the '885 patent, if she had informed me in 2004 that she had been instructed by the client that they would henceforth pay their own maintenance fees, I would have had no reason to question that instruction because after so many years I had come to rely on her for an accurate and true indication of her communications with my clients.

8. I believe that because Ms. Foreman either did not unambiguously understand the client's instruction or was distracted or confused, or was not functioning in her usually dependable way, the delayed payment of maintenance fees for the '885 patent was unavoidable. I believe that she may have been confused by the fact that the client handled this application without involving our firm in the prosecution or issuance. It was unavoidable because Ms. Foreman was convinced that she had received instructions from the client before the due date of the first maintenance fee that they would subsequently pay their own maintenance fees. It was unavoidable because I was never told that we had received a reminder of maintenance fee due. It was unavoidable because I had come to completely depend and rely on Ms. Foreman and the accuracy of her actions after so many years of reliable and dependable performance.

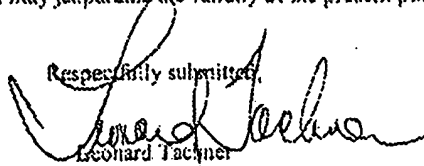
9. I am taking action immediately to reduce Ms. Foreman's duties in the office by taking on some of those obligations myself, by shifting some of Ms. Foreman's duties to our second secretary and by arranging to hire at least one additional staff employee to help. I have also instructed her to always confirm, in writing if possible, that a client does not want us to pay a maintenance fee, even if that is her prior understanding.

DECLARATION OF LEONARD TACHNER Continued  
Patent No. 6,205,885

10. I earnestly believe that Ms. Foreman misunderstood the instructions of our client Cronk Brothers in regard to who would be responsible to pay their future maintenance fees and particularly the maintenance fees for U.S. Patent No. 6, 205,885. I believe further that this misunderstanding led to a clerical error in our docketing system in the form of an erroneous 2004 entry that the client would pay the maintenance fees for this patent and others of this client in the future. I also believe that because I depend so completely on the reliability of Ms. Foreman in carrying out the instructions of our clients and we depend so completely on our docketing system, that once this erroneous entry was made by Ms. Foreman pursuant to her apparent misunderstanding, our failure to pay the maintenance fee in a timely manner was unavoidable. It was only in October 2007 after we were contacted by Carl Winefordner in regard to the status of the '885 patent, that I realized that there was a problem that had to be remedied as soon as possible.

11. Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declarations made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the present patent.

Respectfully submitted,

  
Leonard Tachner  
Attorney for Petitioner  
Registration No. 26,344

Dated: July 30, 2008

(949) 752-8525 telephone  
(949) 955-2415 telefax

WATER-35/TAIWAN Annuities 4-30-2008  
 100.335/TAIWAN Annuity Due 4-30-08  
 006/USA (5,572,228) Issued Patent/Wave Band 3rd Annuity Due (11.5 yrs.) 5-5-08  
 JULE-1 TM Renewal Due 5-5-2008  
 RIFFE-3 Appeal Brief Due 5-5-08  
 100.227/EPO Annuity Due 5-7-08  
 ZEVO-2/PCT/AUSTRALIA Annuity Due 5-7-08  
 ZEVO-2/PCT/EPO Annuity Due 5-7-08  
 RIFFE-4A Madrid Due 5-8-08  
 RIFFE-1A Madrid Due 5-8-08  
 TORT-10 Madrid Due 5-8-08  
 QTECH-1 First Annuity 5-9-08  
 PEMBER-7/TAIWAN POWER & CERT. COPY 5-9-08-----SENT 1-18-08  
 100.146/Taiwan Annuity Due 5-10-08  
 CHIP-2 PCT & TAIWAN Due 5-11-08  
 MOSK-166 Issue Fees Due 5-12-08  
 BOKAM-16 PCT & TAIWAN 5-14-08  
 GLASS-1 Statement of Use 5-13-08-----Filed Statement of Use 3-19-08  
 STEPHEN-1 Issued Patent First Annuity 5-16-08  
 HTR-14/PCT/CANADA Foreign Annuity Due 5-17-08  
 HTR-14/PCT/DIV/CANADA Foreign Annuity Due 5-17-08  
 HTR-14/PCT/CHINA Foreign Annuity Due 5-17-08  
 HTR-10/FWC Issued Patent Third Annuity 5-19-2008  
 JMC-1/CANADA Foreign Annuity Due 5-19-08  
 JMC-1/ISRAEL Next Annuities Due 5-19-2008  
 PEMBER-5 Issued Patent Second Annuity 5-21-2008  
 MOSK-176 PCT & Taiwan 5-21-08  
 MOSK-177 PCT & TAIWAN 5-24-08  
 SHEICO-18/CIP Resp. To 2<sup>nd</sup> O.A. 5-25-08  
 WT-5 Resp. To 1<sup>st</sup> O.A. 5-28-08  
 GRIP-3 Madrid Due 5-29-08  
 GRIP-4 Madrid Due 5-29-08  
 GRIP-5 Madrid Due 5-29-08  
 GRIP-6 Madrid Due 5-29-08  
 JMC-1/EPO Foreign Annuity Due 5-29-08  
 WATER-35-A/TAIWAN Annuities 5-31-2008  
 FISHER-2/CIP Issued Patent Third Annuity 6-3-2008  
 SALIDO-6 Statement of Use 6-4-08  
 GRIP-4 Madrid Due 6-5-08  
 MERLYN-1-PCT/PHILLIPINES Annuity Due 6-5-08  
 317/PCT/JAPAN (511.503/2002) Exam Due 6-6-08  
 100.317/PCT/CANADA Annuities Due 6-6-08  
 ATOMIC-22 PCT & TAIWAN 6-9-08  
 094/USA (6,158,245) Issued Patent 2nd Annuity Due (7.5 yrs.) 6-12-08  
 068/USA (6,159,398) Issued Patent 2nd Annuity Due (7.5 yrs.) 6-12-08  
 ASRC-1/AUSTRALIA Foreign Annuity Due 6-13-2008





**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Frank Hermansen et al	Assignee:	California Crank Brothers, Inc.
Patent No.:	6,205,885	Serial No.:	09/391,709
Issued:	March 27, 2001	Filed:	September 8, 1999
Title:	Clipless Bicycle Pedal		

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Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**

**AUG 12 2008**

**OFFICE OF PETITIONS**

**DECLARATION OF CARL WINEFORDNER**

Dear Sir:

I, Carl Winefordner, declare as follows:

1. Frank Hermansen and I have a long history with the Law Offices of Leonard Tachner. In all cases involving patents for us, Mr. Tachner's office has paid for our patent maintenance fees, which his office invoices us for (see for example, the attached Exhibit, an October 2001 bill for payment of maintenance fee by Mr. Tachner's office).

2. Somewhat atypically, we have worked with Mr. Tachner in three different ways in regard to obtaining and managing our patents:

a) Mr. Tachner handling the entire patent process including writing the entire patent application, filing the application with the USPTO,

DECLARATION OF CARL WINEFORDNER Continued  
Patent No. 6,205,885

handling any office actions, paying the issuing fee, and paying for maintenance fees.

b) Frank and I writing a draft of the patent application (except for the claims), and Mr. Tachner taking over all patent responsibilities including editing the application and writing the claims, filing the application with the USPTO, handling any office actions, paying the issuing fee, and paying for maintenance fees.

c) Frank and I writing a draft of the patent application (except the claims), Mr. Tachner editing the application and writing the claims, Frank and I filing the patent application and paying the issuing fee, and Mr. Tachner's office thereafter taking over all patent responsibilities including paying the maintenance fees. We sometimes worked in this way to save money, as we were a struggling financially up until fairly recently.

3. Frank Hermansen and I have regularly worked with the Law Offices of Leonard Tachner for all of our patent related needs starting in 1995 and up until now. All together, more than 20 US utility patents (and also some design patents and trademarks) have issued during this time with Mr. Tachner as our patent attorney, most of which have been marketed either by licensing, or by making the products.

4. The patent in question here is US 6,205,885. As you will see, by far, this is our single most important patent, which we never intended to become inactive. For this particular patent, we worked with Mr. Tachner using method c) above. Our plan was to turn over this patent to Mr. Tachner as soon as we

**DECLARATION OF CARL WINEFORDNER, Continued**  
**Patent No. 6,205,885**

received the first Office Action, but as it turned out, this patent was approved without any Office Actions. So Frank and I paid for the patent issue fee directly, and then met with Mr. Tachner's secretary, Janis Foreman, and requested that the Law Office of Lennard Tachner take over further responsibility for this patent including future maintenance fees.

5. I am 100% sure that I gave Mr. Tachner's secretary, Janis Foreman, instructions to pay the maintenance fees on our '885 patent and I am without any doubt sure that I never told her that I or we would pay it ourselves. I specifically told Ms. Foreman this in person while Frank and I visited the law office.

6. In 1997, Frank and I started a bicycling related company called Crank Brothers ([www.crankbrothers.com](http://www.crankbrothers.com)) with a single product based on a bicycle tire lever patent that we filed with Mr. Tachner in 1996 (and later issued as 5,857,509). Gradually, Frank and I created more and more products for Crank Brothers, often resulting in patents handled by Mr. Tachner in one of the three methods above. Crank Brothers has steadily grown from \$185,000 in sales during 1997 to over \$11,000,000 in 2007 and an expected \$17,000,000 this year. Our company's success has been almost exclusively due to our proprietary in-house products that Frank and I have created and designed, and the majority of revenue and profit comes from pedals made within our '885 patent. Without a doubt, our intellectual property is our most valuable asset. Our company, and our financial survival, directly depend on our IP, as without it, other companies would copy our products and severely reduce our profits and our way of life. Our products are often more expensive than others on the market, but our products sell because of our proprietary designs.

DECLARATION OF CARL WINEFORDNER Continued  
Patent No. 6,205,885

7. We've always felt as inventors that our direct involvement in writing the patent is essential to end up with the strongest possible patent, as during this process of working with our patent attorney, we often discover ways to strengthen the claims and describe alternative embodiments. Due to the small size of our company, and due to the fact that Frank and I have always been and still are the creative force behind the company, we would never consider adding the administrative responsibility of keeping track of and paying for our patent maintenance fees.

8. We started selling '885 pedals in September of 2001, and have sold them continuously up until the present. We always intended for the patent to remain active. The fact is that our '885 pedal sales have increased each and every year starting in 2001.

9. Of all our intellectual property, by far, the single most valuable patent we have is the '885 patent. Currently, we sell around 350,000 pairs of bicycle pedals per year that are protected by this '885 patent. Products protected by this '885 patent account for the majority of Crank Brothers' revenue and profit. Our pedals have become world famous, and the majority of all off-road bicycle professionals use our '885 pedals. More than half of the 2008 Olympic mountain biking riders will be on our pedals, and this is without financial sponsorship from us. The professionals that use our pedals do so because our pedals are simply better by design (lighter and without any problems in mud), as described in our '885 patent. With this design, we have become #1 in sales in the world of premium off-road pedals.

10. However, without our patent '885 being active, without a doubt, other companies will begin to copy our pedals. I am sure that the only reason

DECLARATION OF CARL WINEFORDNER Continued  
Patent No. 6,205,885

this has not yet happened is because other companies have not yet realized that our '885 patent has become inactive. Loss of the '885 patent will severely impact the revenue of Crank Brothers (and potentially our 15 employees), and of Frank and me personally, and for my wife and children. I have no doubt that without the re-activation of this patent, Crank Brothers will lose many millions of dollars worth of sales over the coming years. The value of this particular patent is millions of dollars.

11. Frank and I specifically communicated to the Law Offices of Leonard Tachner to take over all patent responsibilities and pay the maintenance fees of the '885 patent. Frank and I (and all Crank Brothers people) were completely unaware that this fee had not been paid until October of 2007, and when we discovered it, I immediately contacted the Law Offices of Leonard Tachner to rectify the situation. For Frank and me, unbelievably, Mr. Tachner's secretary was apparently confused over who was to pay for the maintenance fees of this particular patent, possibly related to the fact that Frank and I had filed for this particular patent directly, but then had handed the responsibility over to Tachner's law office. Frank and I never intended for this patent to become inactive, we always intended for the maintenance fees to be paid, and up until October of 2007 we thought the maintenance fees had been paid. Frank and I thought that we were entirely clear with the Law Offices of Leonard Tachner to pay the maintenance fees on this patent, and we were astonished and appalled when we discovered that they had not been paid.

12. This is a case of a clerical error, which could result in a severe hardship for Frank and me. Please allow us to pay the maintenance fees on our '885 patent.

DECLARATION OF CARL WINEFORDNER Continued  
Patent No. 6,205,885

13. Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declarations made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the present patent.

Dated: July 30, 2008

Sincerely,

  
Carl Winefordner

RECEIVED

AUG 1 2 2008

LEONARD TACHNER  
A PROFESSIONAL LAW CORPORATION  
REGISTERED PATENT ATTORNEY  
17961 SKY PARK CIRCLE  
SUITE 38-E  
IRVINE, CALIFORNIA 92614-6364

OFFICE OF PETITIONS

October 15, 2001

PATENTS  
TRADEMARKS  
COPYRIGHTS

TÉL: (949) 752-8525  
FAX: (949) 855-2415

**STATEMENT OF ACCOUNT**

Mr. Carl Winefordner  
Mr. Frank Hermansen  
21542 Ann's Lane  
Laguna Beach, CA 92651

Fees for professional services rendered re:

**SLIP-2:**

Payment of first annuity in the U.S. Patent and  
Trademark Office for U.S. Patent No. 5,876,529  
entitled "COMPACT MANUAL AIR PUMP HAVING  
SELECTABLE HIGH VOLUME AND HIGH PRESSURE  
NODES" by inventors Carl Winefordner and Frank  
Hermansen including payment of government  
fees (\$440)

(1/3 hr. Atty Time @/\$300/hr.): \$ 540.00

Current Balance Due \$ 540.00



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventor:	Frank Hermansen et al	Assignee:	California Crank Brothers, Inc.
Patent No.:	6,205,885	Serial No.:	09/391,709
Issued:	March 27, 2001	Filed:	September 8, 1999
Title:	Clipless Bicycle Pedal		

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U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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AUG 1 2 2008  
OFFICE OF PETITIONS

**DECLARATION OF FRANK HERMANSEN**

Dear Sir:

I, Frank Hermansen, declare as follows:

1. The following is my clear recollection of the events regarding the '885 patent. I have carefully read and I agree with every aspect of Carl Winefordner's declaration.

2. Carl and I together have more than 20 U.S. utility patents. The '885 patent stands out in several ways. It is by far our most successful invention and the only patent we have ever received which was approved without any office actions.



DECLARATION OF FRANK HERMANSEN Continued  
Patent No. 6,205,885

3. I recall that we paid for the patent issue fee directly and then met with Mr. Tachner's secretary, Janis Foreman, to request that the Law Office of Leonard Tachner take over all responsibility for this patent including payment of future maintenance fees.

4. Carl and I were stunned to discover that the maintenance fee had not been paid in the required way. I am in as much disbelief as Carl, that this could have happened. We made our instructions and intentions very clear to Mr. Tachner's secretary. Obviously we never intended for this patent to become inactive as this invention is the core of our business.

5. I am completely positive that we requested the Law Office of Leonard Tachner to pay the maintenance fees on this patent as I was present during this conversation. I was astonished when we discovered that the fees had not been paid.

6. Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declarations made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the present patent.

Sincerely,

Dated: 7-30-08

  
Frank Hermansen

# EXHIBIT D



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1470  
Alexandria, VA 22311-1470  
www.uspto.gov

LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

COPY MAILED

OCT 15 2008

OFFICE OF PETITIONS  
Decision on Petition

In re Patent of Hermansen et al. :  
Patent No. 6,205,885 :  
Issue Date: March 27, 2001 :  
Application No. 09/391,709 :  
Filing Date: September 8, 1999 :  
Attorney Docket No: SLIP-21 :

This is a decision on the request for reconsideration under 37 CFR 1.378(a), filed July 31, 2008, to reinstate the above-identified patent.

The petition is granted.

The instant patent issued March 27, 2001. The last day the maintenance fee could have been timely paid, with a surcharge, was Monday, March 28, 2005. The maintenance fee was not timely paid and the patent expired at midnight on March 28, 2005.

Petitioner requests reinstatement of the patent. Petitioner has met the requirements to reinstate the above-identified patent pursuant to 37 CFR 1.378(b). Therefore, the maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

As of October 1, 2007, the 3.5 year maintenance fee amount increased from \$450 to \$465. The prior petition was filed on October 18, 2007. The prior petition only included \$450 for the maintenance fee. Therefore, \$15 has been charged to petitioner's deposit account for the remainder of the fee.

The file will now be forwarded to Files Repository.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley  
Senior Petitions Attorney  
Office of Petitions

# EXHIBIT E



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22304-1450  
www.uspto.gov

LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

MAILED

JUN 03 2009

In re Patent of Hermansen et al.	:	
Patent No. 6,205,885	:	OFFICE OF PETITIONS
Issue Date: March 27, 2001	:	Decision on Petition
Application No. 09/391,709	:	
Filing Date: September 8, 1999	:	
Attorney Docket No. SLIP-21	:	

This is a *corrected* decision on the petition under 37 CFR 1.378(e), filed July 31, 2008, to reinstate the above-identified patent. The decision mailed October 15, 2008, is hereby vacated.

The petition is **DENIED**. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. 704 for purposes of seeking judicial review. See MPEP 1002.02. The terms of 37 CFR 1.378(e) *do not* apply to this decision.

Since this patent will not be reinstated, the Office has scheduled a refund of maintenance fees and surcharges submitted by petitioner. The fee for requesting reconsideration is not refundable. Therefore the Office has scheduled a refund of:

- (1) \$685 for the surcharge submitted October 18, 2007, and
- (2) \$465 for the 3.5 year maintenance fee submitted October 18, 2007.

The Office has credited the following fees back to petitioner's deposit account:

- (1) \$15 for the remainder of the \$700 surcharge paid October 18, 2007,
- (2) \$65 for the surcharge submitted November 6, 2008, and
- (4) \$1,240 for the 7.5 year maintenance fee submitted November 6, 2008.

**BACKGROUND**

The patent issued March 27, 2001. The 3.5 year maintenance fee could have been paid from March 27, 2004, through September 27, 2004, or with a surcharge during the period from September 28, 2004, to Monday, March 28, 2005. The maintenance fee was not timely paid and the patent expired at midnight on March 29, 2005.

A petition under 35 U.S.C. 41(c)(1) and 37 CFR 1.378(b) was filed October 18, 2007, and was dismissed in the decision of April 9, 2008.

Petitioner filed a request for reconsideration under 37 CFR 1.378(e) on July 31, 2008.

On October 15, 2008, the Office mailed a decision granting the July 31, 2008 petition. As a result, the patent was reinstated.

Petitioner submitted the 7.5 year maintenance fee and the required surcharge on November 6, 2008.

#### APPLICABLE STATUTE AND REGULATION

35 U.S.C. 41(b) states in pertinent part that, "Unless payment of the applicable maintenance fee is received . . . on or before the date the fee is due or within a grace period of six months thereafter, the patent shall expire as of the end of such grace period."

35 U.S.C. 41(c)(1) states that, "The Director may accept the payment of any maintenance fee . . . after the six month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable." (emphasis added)

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

A showing that . . . reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee . . . became aware of . . . the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent.

#### OPINION

**Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.**

In order for a party to prove unavoidable delay, the Office requires the party demonstrate the party exercised the "care or diligence tha[t] is generally used and observed by prudent and careful men in relation to their most important business."<sup>1</sup> However, "the question of whether [delay] was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>2</sup> The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision is based solely on the written, administrative record in existence.

<sup>1</sup> *In re Marulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). See also *Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

<sup>2</sup> *Smith v. Mosshoff*, 671 F.2d 533, 538, 215 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

Facts

Petitioner is Crank Brothers, a bicycle company. The inventors, Carl Winefordner and Frank Hermansen, own Crank Brothers.

During 1995, Attorney Leonard Tachner began representing petitioner with respect to patent matters.

Petitioner worked with Tachner in one of the following three ways with respect to the filing and prosecution of applications for patents:

- (1) Tachner would draft the entire application, file the application, prosecute the entire application, pay the issue fee, and pay maintenance fees;
- (2) The inventors would draft the application, except for the claims, and then hand all further responsibilities, including editing the draft, filing the application, prosecuting the application, paying the issue fee, and paying maintenance fees to Tachner; or
- (3) The inventors would draft the application, except for the claims, Tachner would edit the draft and add claims, the inventors would file the application and pay the issue fee, and Tachner would handle payment of maintenance fees.<sup>3</sup>

Winefordner indicates the third method was used by the inventors in order to save money. Winefordner has also stated petitioner was "struggling financially up until fairly recently."<sup>4</sup>

Winefordner indicates saving money was not the only benefit of the inventors drafting the application. Winefordner states, "We've always felt as inventors that our direct involvement in writing the patent is essential to end up with the strongest possible patent."<sup>5</sup>

The inventors appear to have used the third method when filing the application which issued as the instant patent. Winefordner states,

Our plan was to turn over this patent to Mr. Tachner as soon as we received the first Office action, but as it turned out, this patent was approved without any Office actions. So Frank and I paid the issue fee directly."<sup>6</sup>

The instant patent issued March 27, 2001.

---

<sup>3</sup> Declaration of Carl Winefordner, Paragraph 3.

<sup>4</sup> *Ibid*.

<sup>5</sup> *Id.* at paragraph 7.

<sup>6</sup> *Id.* at paragraph 4.

On or about March 2001, the inventors "met with Leonard Tachner's secretary, Janis Foreman, to request that the Law Office of Leonard Tachner take over all responsibility for this patent including payment of future maintenance fees."<sup>7</sup>

Foreman states,

Around March 2001, when the Firm received the above-captioned issued patent, I supervised [another employee] to [ensure] entries were made in the docket system for September 27, 2004 (3.5 yr annuity), September 27, 2008 (7.5 yr annuity) and September 27, 2012 (11.5 yr annuity) deadlines for payment of the maintenance fees.<sup>8</sup>

On October 15, 2001, Tachner paid the 3.5 year maintenance fee for another patent, Patent No. 5,676,529. On the same day, Tachner sent petitioner a bill charging petitioner \$440 for the maintenance fee and \$100 for handling payment of the fee.<sup>9</sup>

Tachner also paid maintenance fees for the following patents:

July 12, 2002	3.5 year fee paid for Patent No. 5,857,509 (See Exhibit D3)
February 23, 2004	3.5 year fee paid for Patent No. 6,027,319 (See Exhibit D2)
February 23, 2004	3.5 year fee paid for Patent No. 6,059,245 (See Exhibit D4)
April 15, 2004	3.5 year fee paid for Patent No. 6,085,744 <sup>10</sup>

During mid-2004, petitioner communicated with Janis Foreman. Foreman states,

I recall ... a discussion with the client indicating that they would pay their own annuities. It is not unusual for a client to express the desire to pay their own maintenance fees in order to avoid having to pay the firm the additional service fee we charge for doing so.<sup>11</sup>

Inventor Winefordner's declaration states, "I am without any doubt sure that I never told [Foreman] that I or we would pay [the maintenance fee for the instant patent] ourselves."<sup>12</sup> Inventor Hermansen's declaration states, "[Winefordner] and I were stunned to discover that the

<sup>7</sup> Declaration of Frank Hermansen, Paragraph 3. See also Winefordner Declaration, Paragraph 5.

<sup>8</sup> Declaration of Janis Foreman, Paragraph 3

<sup>9</sup> See Attachment to Winefordner declaration.

<sup>10</sup> Although a copy of the front of the folder for this patent has not been supplied, Office records indicate the 3.5 year fee was charged to Tachner's Deposit Account.

<sup>11</sup> Foreman declaration, Paragraph 4.

<sup>12</sup> Paragraph 5.



maintenance fee had not been paid [by Tachner, and] I am in as much disbelief as [Winefordner] that this could have happened."<sup>13</sup>

Foreman has stated, "[T]here appears to have been confusion between the client and myself regarding who would pay the maintenance fees."<sup>14</sup>

Foreman states the instructions for Tachner's Office to discontinue handling maintenance fees came from the "client." Foreman fails to specify if the instructions came from Winefordner, Hermansen, or both. However, Tachner's declaration indicates Foreman has stated she was "instructed by Winefordner and Hermansen that they would be paying their own maintenance fees."<sup>15</sup>

Attorney Tachner has declared, "I believe Ms. Foreman either did not unambiguously understand the client's instruction or was distracted or confused, or was not functioning in her usually dependable way."<sup>16</sup> Tachner also states, "I earnestly believe that Ms. Foreman misunderstood the instructions of our client ... in regard to who would be responsible to pay their future maintenance fees."<sup>17</sup>

After the communication between Foreman and both inventors, Foreman changed the law firm's records to indicate petitioner would be paying petitioner's own maintenance fees in the future. As a result, the maintenance fee was not timely paid for the instant patent and the patent expired on March 29, 2005. The changes to the firm's records also resulted in the expiration of Patent No. 5,676,529 on October 15, 2005, and Patent No. 5,857,509 on January 23, 2007.

During October 2007, petitioner discovered the maintenance fees had not been paid for the instant patent and immediately contacted the law firm.

#### Analysis

A reasonable and prudent owner of a patent would take steps to ensure maintenance fees would be timely paid. Such steps can take the form of retaining an attorney to notify the owner of due dates for maintenance fees.<sup>18</sup> In this case, the facts are clear that petitioner initially retained Tachner and relied on Tachner to inform petitioner of when maintenance fees became due for petitioner's patents. However, at some point prior to September 22, 2004, when the first maintenance fee became due, an entry was made in the docket records that "the client will pay

<sup>13</sup> Paragraph 4.

<sup>14</sup> Foreman declaration, Paragraph 7.

<sup>15</sup> Paragraph 4 (emphasis added).

<sup>16</sup> Declaration of Leonard Tachner, Paragraph 8.

<sup>17</sup> *Id.* at Paragraph 10.

<sup>18</sup> See *California Med. Products, Inc. v. Technol. Med. Products, Inc.*, 921 F. Supp. 1210, 1259 (D. Del. 1995).

their own annuities.<sup>19</sup> The record is not clear that an error in docketing the payment of the maintenance fees occurred. The facts as set forth in the Foreman declaration do not show that any error in docketing was made by the party responsible for maintaining the docket records. What the facts of record show is that there was confusion between the client and the attorney over who would pay the maintenance fee.<sup>20</sup> Thus it cannot be concluded that petitioner has made an adequate showing of docketing error.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish the delay was unavoidable.<sup>21</sup> Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable.<sup>22</sup> It is impossible to say which version of the facts is accurate, Foreman's or Winefordner's and Hermansen's. The finding of one set of facts to be accurate is not the duty of the Director of the United States Patent and Trademark Office. Whereas here alternative scenarios or conflicting facts are put forward, a determination will not be made by the Director as which version is true since such a determination would require the Director to make affirmative findings. Petitioner has not carried the burden.

Petitioner states that Tachner was the party relied upon to track and pay maintenance fees. Such a showing establishes that petitioner was reasonable on relying on Tachner. However, reliance on a third party representative does not, per se, constitute "unavoidable" delay. Instead, when a party relies on an attorney to take certain steps, the petition must address not only the party's actions but also address the attorney's actions or inactions.<sup>23</sup>

<sup>19</sup> Foreman declaration, paragraph 4.

<sup>20</sup> Foreman declaration, paragraph 7.

<sup>21</sup> Cf. *Commissioner A. L. l'energie Atomique v. Watson*, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 125, 128 (D.C. Cir. 1960); (35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was unavoidable, but only to explain why the applicant's petition was unavailing.).

<sup>22</sup> See *Rydeen v. Quigg*, 748 F. Supp. 990, 15 U.S.P.Q. 2d (BNA) 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991)(table); See also *Ray v. Lehman*, 55 F.3d 606 (Fed. Cir. 1995) and *Burund v. Dudas*, 496 F. Supp. 2d 643, 649 (E.D. Va. 2007) ("A patent owner seeking to reinstate an expired patent bears the burden of proving that the delay was 'unavoidable.'") (*quoting R.R. Donnelley & Sons, Co. v. Dickenson*, 123 F. Supp. 2d 456, 459 (N.D. Ill. 2000)).

<sup>23</sup> See *Pioneer Inv. Servs. Co. v. Brunswick Assoc. Ltd. P'ship*, 507 U.S. 380, 396, 397 (1993) ("The [Circuit] court also appeared to focus its analysis on whether respondents did all they reasonably could in policing the conduct of their attorney, rather than on whether their attorney, as respondents' agent, did all he reasonable could to comply with the court-order bar date. In this, the court erred. . . . [I]n determining whether respondents' failure to file their proof of claim prior to the bar date was excusable, the proper focus is upon whether the neglect of respondents and their counsel was excusable." (emphasis in original)). In *Huston v. Ludner*, 973 F.2d 1564, 1567, 23 U.S.P.Q.2d (BNA) 1910 (Fed. Cir. 1992), the court determined the client was bound by the attorney's actions. The majority was unpersuaded by the dissent which states in part that the "errors occurred despite exceptional vigilance by the client."

The Supreme Court has stated,

Petitioner voluntarily chose his attorney as his representative in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected agent ... Each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'<sup>24</sup>

Here the record fails to show that adequate steps within the meaning of 37 C.F.R. § 1.378(b)(3) were taken by or on behalf of petitioner to pay the fee after the docket entries were removed by Ms. Foreman. Petitioner is reminded that 37 C.F.R. § 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fees.<sup>25</sup> In the absence of a showing of the steps taken by or on behalf of petitioner, 37 C.F.R. § 1.378(b)(3) precludes acceptance of the maintenance fee.<sup>26</sup>

It is well established that failure in communications between a client and his or her attorney does not constitute unavoidable delay. Here it would appear that a misunderstanding has occurred over who would be responsible for tracking and paying the maintenance fee. The failure in communication is not considered to be unavoidable error. Delay resulting from a lack of proper communication between an applicant and his representative as to the responsibility for timely filing a communication with the USPTO does not constitute unavoidable delay.<sup>27</sup> Moreover, the USPTO is not the proper forum for resolving a dispute between a patent owner and his representative as to who bore responsibility for paying a maintenance fee.<sup>28</sup>

### Decision

The prior decision which accepted the delayed payment of a maintenance fee for the instant patent has been vacated. For the reasons herein, the entire delay in this case cannot be regarded

<sup>24</sup> *Link v. Wabash Railroad Co.*, 370 U.S. 626, 633-634, 81 L. Ed. 2d 734, 82 S. Ct. 1386 (1962) (quoting *Smith v. Ayer*, 191 U.S. 320, 326 (1880)).

<sup>25</sup> *Roy*, 55 F.3d at 609, 34 U.S.P.Q. 2d (BNA) at 1783.

<sup>26</sup> See *Korsinsky v. Godiet*, 2005 U.S. Dist. LEXIS 20850 at \*13 (S.D. N.Y. 2005), *aff'd sub nom. Korsinsky v. Dudas*, 2007 U.S. Dist. LEXIS 7396 (Fed. Cir. 2007); *R.R. Donnelley & Sons, Co. v. Dickerson*, 123 F. Supp. 2d 456, 459 (N.D. Ill. 2000) (failure of patent owner to itself track or obligate another to track the maintenance fee precluded acceptance of the maintenance fee); *California Med. Products, Inc. v. Technol Med. Products, Inc.*, 921 F. Supp. 1219, 1259 (D. Del. 1995); *MMTC v. Rogan*, 369 F. Supp. 2d 675 (E.D. Va. 2004) (passive reliance on USPTO reminder notice resulting in failure to take any steps to assure payment of the maintenance fee is not unavoidable delay); *Pempspec v. Dudas*, 2007 U.S. Dist. LEXIS 8482 (N.D. Cal. 2007) (lack of any steps in place to maintain patent in force by estate executor unfamiliar with patent law is not unavoidable delay); *Burandt v. Dudas*, 496 F. Supp. 2d 643, 650 (E.D. Va. 2007) (delay not unavoidable where no steps shown to be employed to remind responsible party to timely pay maintenance fees).

<sup>27</sup> See *In re Kim*, 12 U.S.P.Q. 2d (1595 (Comm'r Pat. 1988)); *Roy v. Lehman*, 55 F.3d 606, 610, 34 U.S.P.Q. 2d (BNA) 1786, 1789 (Fed. Cir. 1995).

<sup>28</sup> *Roy*, 55 F.3d at 610, 34 U.S.P.Q. 2d at 1789.

as unavoidable within the meaning of 35 U.S.C. 41(e)(1) and 37 CFR 1.378(b). Therefore, the petition is denied.

As stated in 37 CFR 1.378(e), the Office will not further consider or review the matter of the reinstatement of the patent.

The patent file is being forwarded to Files Repository.

Telephone inquiries may be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read "Charles Pearson", followed by a horizontal line.

Charles Pearson  
Director  
Office of Petitions

# EXHIBIT F

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	Atty Docket No.: 70614.30
Frank HERMANSEN, et al.	§	
	§	U.S. Patent No. 6,205,885
Appln. No.: 09/391,709	§	
	§	Issued: March 27, 2001
Filed: Sept. 8, 1999	§	
	§	
For: CLIPLESS BICYCLE PEDAL	§	

**DECLARATION OF TOM CHEN IN SUPPORT OF SUPPLEMENTAL PETITION FOR  
RECONSIDERATION AND ACCEPTANCE OF DELAYED PAYMENT OF  
MAINTENANCE FEES UNDER 37 C.F.R. § 1.182, § 1.183, and § 1.378**

**Mail Stop Petitions**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Tom Chen, declare and say that I have direct knowledge of all facts set forth in this Declaration and:

1. I am a registered patent attorney. I was admitted to the State Bar of California in 1996 (Cal. Bar No. 184,843) and have remained in good standing since then. I was admitted to practice before the United States Patent & Trademark Office ("USPTO") in 1998 (Reg. No. 42,406). I am a partner of Haynes and Boone, LLP. Ms. Annie McNally is my administrative assistant.
2. I am now an attorney of record in connection with U.S. Patent No. 6,205,885 to Hermansen et al. ("Hermansen '885"), which is assigned of record to California Crank Brothers, Inc. ("Crank Brothers").
3. On January 21, 2010, APTA (Associated Patent & Trademark Attorneys) (an Italian firm representing Selle Royal S.p.A., now the parent of Crank Brothers) asked me if we had received any confirmation from the USPTO about the late payment of the maintenance fees for Hermansen '885.
4. Attached as Exhibit 1 is a copy of a document that Ms. McNally downloaded for me from the USPTO PAIR system on January 21, 2010. Exhibit 1 indicates that Hermansen '885 expired on March 27, 2009.
5. On or about February 17, 2010, I had a telephone conversation with Leonard Tachner, Crank Brothers' prior patent counsel, who told me that he believed Hermansen '885 was still in

PATENT

force since the last correspondence he received from the USPTO was a Decision dated October 15, 2008 which granted a Petition for Acceptance of Delayed Payment of Maintenance Fees for Hermansen '885.

6. During my telephone conversation with Mr. Tachner that took place on or about February 17, 2010, Mr. Tachner stated that he had not received any correspondence from the USPTO which indicated that Hermansen '885 had expired and that none of the maintenance fees he paid for Hermansen '885 had been credited to his Deposit Account with the USPTO.

7. The original file jacket covers for Crank Brothers' U.S. patent matters that were transferred to Haynes and Boone by Tachner do not include any erasures, white-outs, or coverups, and the only changes to such file covers that were made by Haynes and Boone are the addition of a tracking label in the upper left corner and an attorney docket number in the upper right corner.

8. On July 7, 2010, I sent an email to Mr. Tachner and asked him if he had any copies of maintenance fee correspondences between both the PTO and Crank Brothers. Also, on July 7, 2010, Mr. Tachner responded to my email and stated that:

"I don't remember any special treatment of the Crank Brothers files, but as a general rule we don't keep separate files for maintenance fees."

Attached as Exhibit 2 is a copy of the email I sent to Mr. Tachner on July 7, 2010 and his response of the same date.

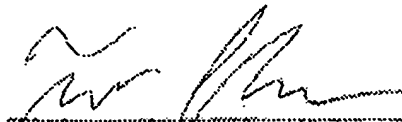
9. I declare that all statement made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and that these statements were made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. § 1001 and may jeopardize the validity of the present patent.

Respectfully submitted,

HAYNES AND BOONE, L.L.P.

July 19, 2010

Date



Tom Chen

(Reg. No. 42,406)

HAYNES & BOONE LLP

Customer No. 27683

Phone: 949-202-3030

Fax: 214-200-0853

# EXHIBIT 1



[Return To](#)[USPTO Home Page](#)[Finance Online Shopping Page](#)

**United States  
Patent and  
Trademark Office**

Patent Bibliographic Data		01/21/2010 12:27 PM	
Patent Number:	6205885	Application Number:	09391709
Issue Date:	03/27/2001	Filing Date:	08/08/1999
Title:	CLIPLESS BICYCLE PEDAL		
Status:	APC status indicates patent expired on: 03/27/2009		Entity: Small
Window Opens:	03/29/2004	Surcharge Date:	03/28/2004
Fee Amt Due:	\$0.00	Surchg Amt Due:	\$0.00
Fee Code:		Total Amt Due:	\$0.00
Surcharge Fee Code:			
Most recent events (up to 7):	06/04/2009 Refund - Payment of Maintenance Fee, 4th Yr, Small Entity. 06/04/2009 Refund - Surcharge, Petition to Accept Pynt After Exp, Unava 06/04/2009 Refund - Payment of Maintenance Fee, 8th Yr, Small Entity. 06/04/2009 Refund - 7.5 yr surcharge - late pmt w/in 6 mo, Small Entity 06/03/2009 Petition Related to Maintenance Fees Denied/Dismissed. 10/15/2008 Petition Related to Maintenance Fees Granted. 07/31/2008 Petition Related to Maintenance Fees Filed. --- End of Maintenance History ---		
Address for fee purposes:	LEONARD TACHNER, A PROFESSIONAL LAW CORPORATION 17861 SKY PARK CIRCLE, SUITE 38-E IRVINE, CA 92614		
NOTE: All USPTO fees are subject to change. If you are making a payment by mail or fax, please visit this <a href="#">link</a> or contact the Maintenance Fee Branch (571-272-6500) to confirm the amount due on the date payment is to be made. A maintenance fee payment can be timely made using the certificate of mailing or transmission procedure set forth in 37 CFR 1.8.			
<input type="button" value="Run Another Query"/>			

[Need Help?](#) | [USPTO Home Page](#) | [Finance Online Shopping Page](#) | [Alerts Page](#)

# **EXHIBIT 2**

Chen, Tom

---

From: Ltachner@aol.com  
Sent: Wednesday, July 07, 2010 4:38 PM  
To: Chen, Tom  
Subject: Re: Crank Brothers documents

Tom: I don't remember any special treatment of the Crank Brothers files, but as a general rule we don't keep separate files for maintenance fees. Leonard

In a message dated 7/7/2010 2:48:29 P.M. Pacific Standard Time, Tom.Chen@haynesboone.com writes:

Hi Leonard,

Please let me know if you have any copies of maintenance fee correspondences (between both the PTO and Crank Brothers). We have the various files you sent over, but was wondering if there was anything not included, such as if you kept separate files for maintenance fees. Thanks.

Tom

7/12/2010

# EXHIBIT G

Carl Winefordner

From: Carl Winefordner (carl@crankbrothers.com)  
Sent: Thursday, March 27, 2008 6:10 PM  
To: JFOREMANTACHLAW@aol.com  
Subject: RE: slip 26 PCT  
Attachments: image001.gif

Dear Janis:

Okay, noted to the PCT cost. Yes, please proceed with the SLIP 26 PCT.

Is Slip 21 the file name for the 6,205,885 patent? If so, then is there anything that we can/should do to up the odds that it goes through? Can we expedite it? Can we send a person in to meet with the USPTO? There are many millions of dollars of revenue potentially riding on this, because I'm sure that we will be copied heavily if the bike industry figures out that we don't have an active patent. Last year we sold over \$7,000,000 worth of pedals under this patent, and this year it will be more. It is the majority of our business still. I'm really worried that our patent is not active.

Thanks,

Carl

© 2008 Winefordner LLC  
carl@crankbrothers.com  
318 Broadway  
Aspen, CO 81601  
P: 970 924 2519 F: 970 924 2010  
carl@crankbrothers.com



From: JFOREMANTACHLAW@aol.com [mailto:JFOREMANTACHLAW@aol.com]  
Sent: Thursday, March 27, 2008 4:44 PM  
To: carl@crankbrothers.com  
Subject: Re: slip 26 PCT

Hi Carl: I will prepare the PCT application for SLIP-26 and get it filed by the deadline of April 5th. The cost will be \$4,500.00 (there are claims over 20 and an additional independent claim). I am attaching our Statement of Account for the PCT application. SLIP-21, I have checked with the USPTO but they haven't made a decision yet.

Best regards, Janis

Create a Home Theater Like the Pros. Watch the video on AOL Home.

# EXHIBIT H

PLEASE ACKNOWLEDGE BY DATE STAMPING, RECEIPT OF THE FOLLOWING:

1. CHANGE OF CORRESPONDENCE ADDRESS (PATENT), FOR U.S. PATENT NO. 6,205,885, ISSUED MARCH 27, 2001, APPLICATION SERIAL NO. 09/391,709 FILED ON SEPTEMBER 8, 1999 BY FRANK HERMANSEN et al, ATTORNEY DOCKET NO. SLIP-21 (1 Page).



# EXHIBIT I



FO2/6778  
DASHING  
#28-3

OF LEONARD TACHNER

REGISTERED PATENT ATTORNEY

3990 WESTERLY PLACE

SUITE 205

NEWPORT BEACH, CALIFORNIA 92660

(714) 752 8525

ISSUED

01/02/1990  
06/29/2010

INVENTOR

FRANK LERMANSEN and CARL WINEFORDNER

SERIAL NO

08/680,749

FILED

7-15-96

TITLE

Compact Manual Air Pump Having Selectable  
High Volume and High Pressure Modes

ASSIGNEE

ASSIGNMENT RECORDED

REEL

FRAME

OFFICE ACTIONS

AMENDMENTS

1-27-94 Reply to O.A.

2-12-96 a me

3-5-97 Issue fees + Drugs

5-5-97 P. Drugs

4-14-2001 First Annuity

10-15-2001 pt upwork

4-14-2003 Second Annuity

pt upwork 10-3-03

4-14-2009 Third Annuity

CANADIAN

INVENTOR

LEONARD TACHNER

SERIAL NO

08/680,749

OFFICE FILED

FINAL DATE PAID

October 14, 1997

ISSUED

# EXHIBIT J



0870614-08338  
 102716783  
 083116783  
 082853

OF LEONARD TACHNER

REGISTERED PATENT ATTORNEY

3990 WESTERLY PLACE

SUITE 295

NEWPORT BEACH, CALIFORNIA 92660

(714) 752-8525

ISSUED

INVENTOR Carl Wierfordner and Frank Wierfordner  
 SERIAL NO. 08/245,068 FILED 4-21-97  
 TITLE Compact Manual Air Pump Having  
Selectable High Volume and High Pressure Modes

ASSIGNEE

ASSIGNMENT RECORDED

FEEL

FRAME

OFFICE ACTIONS

AMENDMENTS

3-31-99 Resp to First O.A.

4-18-99 amend lms. etc.

4-16-99 Supp. Claim

2-8-99 Resp to 2nd O.A.

9-3-99 amend

12-27-99 Issue First Formal Days

12-23-99 pt. admiss. - add. cl. 1

8-22-03 First Annulity

2-23-04 cl. upsur

8-22-07 Second Annulity

10-3-07 pt. upsur

8-22-2011 Third Annulity

07/09/2010

FINAL FEE PAID

DATE February 22, 2000

ISSUED

CLIENT'S TITLE

08/245,068

CANDID

INVENTOR

SERIAL NO.

08/245,068

OTHER PUBLICATION

# EXHIBIT K



15000

INVENTOR Cyril Elmer Foxworth and Frank Veronesi  
SERIAL NO. 08/713,166 FILED 9-25-96  
TITLE Improved Bicycle Tire Lever



ASSISTANT RECORDED

FEEL

FINNE

### OFFICE ACTIONS

ABENDSENTE

1-24-97 Resp. to First O.A.

11/10/81

3-24-98 Resp. to Second (final) D.A.

1952-1953

10-14-98 Dwyer fees + formal time

10-14-90

7-1-2001 First Anniversary

7-12-2006 Second Activity

10-3-07

7-12-2010 Third Activity

陈鹤琴

◆ 2011 年 12 月 11 日

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January 12, 1993

ISSUE

06/29/2010

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# EXHIBIT L



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SLIP-51612  
Johannson Frank et al

# EXHIBIT M





# EXHIBIT N



15000

ASSIGNMENT RECORDED September 9, 2006 REEL 018334 FRAME 000

06/29/2010



OFFICE ACTIONS	AMENDMENTS
3-16-25 P. To Tamm due	Added 3-16-25
10-14-26 Rep. to 1 <sup>st</sup> O.A.	10-23-26 amc
10-27-26 Rep. to 2 <sup>nd</sup> Am. O.A.	
4-16-27 L. to Sec. Due	4-16-27 pd
12-5-12 First Annuitiy	
12-5-14 Second Annuitiy	
12-5-18 Third Annuitiy	

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DISNEY HOME



10/802,105

ALLOWED	FINAL FEE PAID
PATENT NO. US 7,215,703 B2	DATE June 5, 2007

1. **Religion**  
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 99. **Religion**  
 100. **Religion**

Issued

# EXHIBIT O



01/27/99  
02/16/00  
STARS 181  
02055

ISSUED

INVENTOR Frank Hermansen and Carl Winiford Qner  
 SERIAL NO 09/391,709 FILED 9-8-99  
 TITLE Clipless Bicycle Pedal

ASSIGNEE \_\_\_\_\_  
 ASSIGNMENT RECORDED \_\_\_\_\_ REEL \_\_\_\_\_ FRAME \_\_\_\_\_

OFFICE ACTIONS	AMENDMENTS
9-27-04 First Annunity	Amended to include subject as of 11-6-03 update
9-27-08 Second Annunity	
9-27-12 Third Annunity	

06/29/2010

CLIENT OR TITLE

SLIP-21

INVENTOR

Hermansen

Frank

et al

SERIAL NO

09/391,709

OTHER REFERENCE

March 27, 2001

ISSUED

# EXHIBIT P



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22303-1450  
www.uspto.gov

P75H  
LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

DATE PRINTED  
04/27/05

NOTICE OF PATENT EXPIRATION

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, you may call the USPTO Contact Center at 800-786-9199 or 703-308-4357.

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
6205885	09391709	03/27/01	09/08/99	03/28/05	19760

# EXHIBIT Q



Carl Winefordner

From: Carl Winefordner [carl@crankbrothers.com]  
Sent: Monday, July 14, 2008 9:02 AM  
To: l.bachner@aol.com  
Cc: Frank Hermanson  
Subject: pedal patent  
Attachments: image001.gif

Dear Leonard:

Thank you again for meeting with us last Friday.

Upon more thought, I wanted to make a couple of comments and suggestions regarding getting our pedal patent active.

1. We asked if there was a second chance (an appeal) if the USPTO declined the petition, and you said that you were fairly sure that there was. I think it's important that you make absolutely sure that there will be a second chance if they come back the first time with a "no" answer.
2. If there is no second chance, then it seems like we better do whatever is possible before they answer to ensure a "yes" answer.
3. We don't know what you included in the petition, but it seems like there are a few facts that heavily support the reality that we never intended this patent to go inactive. Specifically the fact that our company make millions of dollars in revenue making pedals that fall within this patent (hundreds of thousands of pedals per year), and that of our more than 20 patents, this is the single most important one. Even if this is not a legal argument, perhaps it would help our case? For sure, we would suffer a significant hardship if this patent stays inactive, and it would put our company at risk. Can this info be passed along to the examiner?
4. It seems logical that what the patent office wants to prevent is people purposely letting their patents go invalid, and only after some other company starts making an "infringing" product, do they change their minds and want to get it valid again. In that case, it's possible that another company has actually relied upon that patent being invalid in coming out with their product. However, in our case, this is absolutely not the case. There is currently nobody infringing on us (yet), but it could happen at anytime.

Please let me know your thoughts.

Sincerely,

Carl

# EXHIBIT R

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	Atty Docket No.: 70614.30
Frank HERMANSEN, et al,	§	
	§	
Appln. No.: 09/391,709	§	U.S. Patent No. 6,205,885
	§	
Filed: Sept. 8, 1999	§	Issued: March 27, 2001
	§	
For: CLIPLESS BICYCLE PEDAL	§	

**DECLARATION OF CARL WINEFORDNER IN SUPPORT OF SUPPLEMENTAL  
PETITION FOR RECONSIDERATION AND ACCEPTANCE OF DELAYED  
PAYMENT OF MAINTENANCE FEES UNDER 37 C.F.R. § 1.182, § 1.183, and § 1.378**

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Carl Winefordner, declare and say that I have direct knowledge of all facts set forth in this Declaration and:

1. I am named as an inventor of the subject matter claimed in U.S. Patent No. 6,205,885 to Hermansen et al, ("Hermansen '885").
2. I am a principal of Crankbrothers, Inc., formerly known as California Crank Brothers, Inc. ("Crank Brothers") the current assignee of record of Hermansen '885. I have reviewed and approved the Supplemental Petition in connection with the effort to revive Hermansen '885.
3. In the past, Crank Brothers' engaged the services of Leonard Tachner ("Tachner") for patent preparation, prosecution and maintenance for both United States and foreign matters. I was the contact person at Crank Brothers for all correspondence and contacts with Tachner.
4. During the attempts by Tachner to reinstate Hermansen '885, Tachner never provided me or, to the best of my knowledge, anyone else at Crank Brothers with copies of (i) the Petition for Acceptance of Delayed Payment of Maintenance Fee Under Rule 1.378(b) (the "Petition") filed by Tachner on October 18, 2007, (ii) the Declaration of Janis Foreman filed with the Petition, (iii) the Request for Reconsideration of Petition for Acceptance of Delayed Payment of Maintenance Fee Under Rule 1.378(b) (the "Request") filed by Tachner on July 31, 2008, nor (iv) the Declaration of Leonard Tachner filed with the Request.
5. I learned within the last month from Crank Brothers' current patent counsel that Crank Brothers' U.S. Patent No. 5,676,529 to Hermansen ("Hermansen '529") expired twice, namely

on or about October 15, 2001 and on or about October 15, 2005. While I learned about the second expiration as discussed below, it was only recently that I learned from current patent counsel that the '529 patent expired a first time in 2001. Tachner never informed me or Crank Brothers that Hermansen '529 had expired either time. Tachner also never provided me or, to the best of my knowledge, anyone at Crank Brothers with copies of the Petition to Accept Late Payment of Maintenance Fee filed by Tachner on October 3, 2007, the Decision on the Petition granting the second reinstatement, or any other communications to or from the U.S. Patent and Trademark Office ("USPTO") concerning either expiration and reinstatement of Hermansen '529.

6. I have been informed recently by Crank Brothers' current patent counsel that Crank Brothers' U.S. Patent No. 5,857,509 to Winefordner ("Winefordner '509") expired on or about January 13, 2007. I have also been informed recently by Crank Brothers' current patent counsel that a Petition to Accept Late Payment of Maintenance Fee for Winefordner '509 was filed by Tachner on October 3, 2007 and was apparently granted by a Decision on the Petition was mailed on October 3, 2007. Tachner never informed me or, to the best of my knowledge, anyone at Crank Brothers that Winefordner '509 had ever expired. Tachner also never provided me or Crank Brothers with copies of the Petition to Accept Late Payment of Maintenance Fee, the Decision on the Petition or any other documents concerning the expiration and reinstatement of Winefordner '509.

7. As a result of my attendance at the 2007 Interbike tradeshow in Las Vegas I first learned that Tachner had failed to pay the first maintenance fee for Hermansen '529. The 2007 Interbike tradeshow was held from September 25 to September 30, 2007 and on Thursday, September 27, 2007, I met with one of Crank Brothers' bicycle pump vendors who Crank Brothers had accused of infringing Hermansen '529. At this meeting, Crank Brothers' pump vendor informed me that the maintenance fee had not been paid on Hermansen '529 and as such the patent was not enforceable. After the meeting, I immediately contacted Tachner. Attached as Exhibit 1 is a copy of an email sent to me on September 28, 2007 by Tachner's secretary Janis Foreman. As noted in Exhibit 1, Ms. Foreman stated that:

"Unfortunately the patent office website is down. I will check into this first thing on Monday when the website is working again. I have it listed as paid."

To the best of my recollection, upon my return home from the Interbike tradeshow, I went onto the USPTO website to check the status of Hermansen '529 and at that point also discovered that Hermansen '885 had expired for failure to pay the first maintenance fee. I immediately contacted Tachner again to inform him about this additional problem. Attached as Exhibit 2 is a copy of an email sent to me on October 3, 2007 by Tachner's secretary Janis Foreman. As noted in Exhibit 2, Ms. Foreman stated that:

"I will file a petition for SLIP-21 [Hermansen '885] but I won't have any feedback today because they are three hours ahead.

...

Attached is the maintenance fee statement showing the annuity has been paid for SLIP-2 [Hermansen '529]."

8. Regarding the first and second maintenance fees for Hermansen '885, attached as Exhibit 3 is a copy of an invoice dated October 21, 2008 that Tachner sent to Crank Brothers for such maintenance fees. It is my understanding that these fees were refunded by the USPTO to Tachner's deposit account on June 4, 2009. Crank Brothers has never received any notification from Tachner that these fees were refunded by the USPTO to Tachner. Crank Brothers has also never received a refund of these fees from Tachner.

9. I declare that all statement made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and that these statements were made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. § 1001 and may jeopardize the validity of the present patent.

Respectfully submitted,

Date

July 19, 2010

Carl Windfordner

D:\874215\_1.DOC

# EXHIBIT 1



# EXHIBIT 2



Message | Archive PDF | Print | Forward | Reply | Reply All | Delete | Move to Folder | Create New Folder | Add Address | Add Contact | Add Calendar | Add Task | Add Note | Add Reminder | Add Event | Add Appointment | Add Meeting | Add Conference | Add Webinar | Add Training | Add Workshop | Add Seminar | Add Presentation | Add Lecture | Add Course | Add Program | Add Project | Add Task | Add Note | Add Reminder | Add Event | Add Appointment | Add Meeting | Add Conference | Add Webinar | Add Training | Add Workshop | Add Seminar | Add Presentation | Add Lecture | Add Course | Add Program | Add Project

☐ Reply ☐ Reply All ☐ Forward ☐ Delete ☐ Move to Folder ☐ Create New Folder ☐ Add Address ☐ Add Contact ☐ Add Calendar ☐ Add Task ☐ Add Note ☐ Add Reminder ☐ Add Event ☐ Add Appointment ☐ Add Meeting ☐ Add Conference ☐ Add Webinar ☐ Add Training ☐ Add Workshop ☐ Add Seminar ☐ Add Presentation ☐ Add Lecture ☐ Add Course ☐ Add Program ☐ Add Project

Follow up:  
 You forwarded this message on 10/10/2007 4:05 PM.  
 From: POLARIS PATENT AND TRADEMARKS  
 To: Carl W. Winkler  
 Subject: Re: Pat. Polaris and Trademarks

Sent: Wed 10/10/2007 4:05 PM

Message | Print | Forward | Reply | Reply All | Delete | Move to Folder | Create New Folder | Add Address | Add Contact | Add Calendar | Add Task | Add Note | Add Reminder | Add Event | Add Appointment | Add Meeting | Add Conference | Add Webinar | Add Training | Add Workshop | Add Seminar | Add Presentation | Add Lecture | Add Course | Add Program | Add Project

Dear Carl, I respond as follows:

1. Attached is the new trademark list
2. How that SLF-20 is issued it might make it easier to get SLF-20/200P allowed, I'm sure the Examiner will review the parent's history since it is the same Examiner who allowed the parent.
3. I will not do anything for SLF-7. I will file a petition for SLF-21 but I won't have any feedback today because they are three hours ahead
4. Attached is the maintenance fee statement showing the annuity has been paid for SLF-2. As far as infringement is concerned, the period between October 14, 2005 through October 2, 2007 you would not be able to collect any monies for infringement activity. Do you know when these people started making the infringing device?

Best regards, Janis F.

See what's new at [AOL.com](http://AOL.com) and [Make AOL Your Homepage](http://Make AOL Your Homepage).

# EXHIBIT 3

LEONARD LACINER  
A PROFESSIONAL LAW CORPORATION  
REGISTERED PATENT ATTORNEY  
11061 RISKY PARK CIRCLE  
SUITE 10-B  
IRVINE, CALIFORNIA 92614-6304

October 21, 2000

PATENTS  
TRADEMARKS  
COPYRIGHTS

TEL: (949) 782-0828  
FAX: (949) 960-2418

# STATEMENT OF ACCOUNT

Mr. Carl Wingender  
Mr. Frank Hermanson  
Crack Smithers, Inc.  
310 Broadway  
Laguna Beach, CA 92653

Fees for professional services to

## SLIP-21:

Payment of 1<sup>st</sup> annuity in the U.S. Patent and  
Trademark Office for U.S. Patent No.  
6,205,883 entitled CLIPLESS BI-CYCLE PEDAL  
by inventors Carl Wingender and Frank  
Hermanson including payment of government  
fees (\$400)

(U.S. in Any Time (\$400.00))

\$ 400.00

## SLIP-21:

Payment of 2<sup>nd</sup> annuity in the U.S. Patent and  
Trademark Office for U.S. Patent No.  
6,205,883 entitled CLIPLESS BI-CYCLE PEDAL  
by inventors Carl Wingender and Frank  
Hermanson including payment of government  
fees (\$1,100)

(U.S. in Any Time (\$1,100.00))

\$ 1,100.00

Current Balance Due

\$ 1,500.00

# EXHIBIT S

08/680,749	COMPACT MANUAL AIR PUMP HAVING SELECTABLE HIGH VOLUME AND HIGH PRESSURE MODES	07-13- 2010:09:01:06
------------	--	-------------------------

**Transaction History**

Date	Transaction Description
10-03-2007	Mail-Petition Decision - Accept Late Payment of Maintenance Fees - Granted
10-03-2007	Petition to Accept Late Payment of Maintenance Fee Payment Filed
11-16-2005	Expire Patent
03-07-2002	Reinstate Patent
11-20-2001	Expire Patent
10-14-1997	Recordation of Patent Grant Mailed
09-08-1997	Issue Notification Mailed
05-07-1997	Issue Fee Payment Verified
06-14-1997	Drawing(s) Processing Completed
06-14-1997	Drawing(s) Matched to Application
06-13-1997	Drawing(s) Received at Publications
05-17-1997	Mailroom Date of Drawing(s)
02-03-1997	Mail Notice of Allowance
02-03-1997	Notice of Allowance Data Verification Completed
02-03-1997	Mail Examiner's Amendment
02-03-1997	Examiner's Amendment Communication
01-29-1997	Case Docketed to Examiner in GAU
01-16-1997	Date Forwarded to Examiner
12-17-1996	Response after Non-Final Action
10-22-1996	Mail Non-Final Rejection
10-15-1996	Non-Final Rejection
09-06-1996	Case Docketed to Examiner in GAU
08-29-1996	Application Captured on Microfilm
07-29-1996	Initial Exam Team nn

[Close Window](#)

# EXHIBIT T

08/18/2006 BICYCLE TIRE LEVER

07-13-  
2010:09:01:48**Transaction History**

Date	Transaction Description
10-03-2007	Mail-Petition Decision - Accept Late Payment of Maintenance Fees - Granted
10-03-2007	Petition to Accept Late Payment of Maintenance Fee Payment Filed
02-14-2007	Expire Patent
01-12-1999	Recordation of Patent Grant Mailed
12-22-1998	Issue Notification Mailed
12-07-1998	Issue Notification Mailed
10-21-1998	Issue Fee Payment Verified
10-30-1998	Drawing(s) Processing Completed
10-30-1998	Drawing(s) Matched to Application
10-22-1998	Drawing(s) Received at Publications
10-21-1998	Mallroom Date of Drawing(s)
07-14-1998	Mail Notice of Allowance
07-14-1998	Notice of Allowance Data Verification Completed
07-08-1998	Date Forwarded to Examiner
06-29-1998	Amendment after Final Rejection
06-29-1998	Request for Extension of Time - Granted
06-25-1998	Examiner Interview Summary Record (PTOL - 413)
06-10-1998	Change In Power of Attorney (May Include Associate POA)
03-04-1998	Mail Final Rejection (PTOL - 326)
03-03-1998	Final Rejection
03-02-1998	Date Forwarded to Examiner
02-20-1998	Continuing Prosecution Application - Continuation (ACPA)
02-20-1998	Mail Express Abandonment (During Examination)
02-20-1998	Express Abandonment (during Examination)
12-24-1997	Mail Final Rejection (PTOL - 326)
12-23-1997	Final Rejection
11-21-1997	Date Forwarded to Examiner
11-10-1997	Response after Non-Final Action
09-24-1997	Mail Non-Final Rejection
09-18-1997	Non-Final Rejection
02-04-1997	Case Docketed to Examiner in GAU
01-10-1997	Transfer Inquiry
12-05-1996	Application Captured on Microfilm
10-03-1996	Initial Exam Team nn

[Close Window](#)

# EXHIBIT U



Carl Winefordner

From: JFOREMANTACHLAW@aol.com  
Sent: Wednesday, October 03, 2007 12:36 PM  
To: Carl Winefordner  
Subject: Re: FW: Patents and Trademarks  
Attachments: status-list.SLIP-PATENTS.pdf

Dear Carl: Attached is an updated list for your patents. I have not yet finished the trademark list, that's next. I will respond to each of your questions.

1. Will add info to updated trademark list shortly
2. SLIP-20 Issued and SLIP-20/CIP is pending.
3. I have found a problem with the maintenance fees for SLIP-7 (toy submarine) and SLIP-21 (clipless bicycle pedal) and I am trying to correct them as I did for the item 4 discussed below.
4. Carl I found out that the Patent Office website lists the annuity unpaid. However, to correct the situation I filed a petition online and paid the petition and annuity fee which is automatically granted. I have to research some more and contact the maintenance division to further find out why I listed it paid and they did not. In any case it is now paid or again paid.

I am trying my best to get these done as quickly as possible for you.

Best regards, Janis

See what's new at [AOL.com](http://AOL.com) and [Make AOL Your Homepage](http://Make AOL Your Homepage).

# EXHIBIT V

**CALIFORNIA CRANK BROTHERS, INC.**  
small entity  
California corporation; county of Orange

October 3, 1957

## Patent and Patent Applications

Code	Country	Patent No./ Issue Date	Serial No./ Filing Date	Title	Inventor(s)	Priority/Related Files	Comments/Instructions
2	USA	5,871,766 08-12-1999	08,000,766 07-18-1996	Improved Bicycle Tire Lever	Carl Winafordiner	None	11.5 yr. priority date 07-12-2010 expires 09-25-2016
201P	USA	6,851,189 02-08-2005	08,000,766 07-18-1996	Method Of Fabricating A Clipless Bicycle Pedal	Carl Winafordiner	None	11.5 yr. priority date 08-08-2012 expires 02-27-2023
3	USA	5,871,766 01-12-1999	08,000,766 07-18-1996	Improved Bicycle Tire Lever	Carl Winafordiner	None	11.5 yr. priority date 07-12-2010 expires 09-25-2016
3RCT	PCT	—	PCT/US97/17161 08-24-1997	Method Of Fabricating A Clipless Bicycle Pedal	Carl Winafordiner	None	11.5 yr. priority date 08-08-2012 expires 02-27-2023
5	USA	5,871,766 01-12-1999	08,000,766 07-18-1996	Improved Bicycle Tire Lever	Carl Winafordiner	None	11.5 yr. priority date 07-12-2010 expires 09-25-2016
5CIP	USA	6,851,189 02-08-2005	08,000,766 07-18-1996	Method Of Fabricating A Clipless Bicycle Pedal	Carl Winafordiner	None	11.5 yr. priority date 08-08-2012 expires 02-27-2023
6	USA	6,851,189 02-08-2005	08,000,766 07-18-1996	Method Of Fabricating A Clipless Bicycle Pedal	Carl Winafordiner	None	11.5 yr. priority date 08-08-2012 expires 02-27-2023
6	TAIWAN	92104809 05-19-2004	92104809 05-19-2004	Method Of Fabricating A Clipless Bicycle Pedal	Carl Winafordiner	None	11.5 yr. priority date 08-08-2012 expires 02-27-2023

Code SLIP	Country	Patent No./ Issue Date	Serial No./ Filing Date	Title	Inventor(s)	Priority/Related Files	Comments/Instructions
8PCT	PCT	---	PCT/US2004/005542 02-26-2004			10375243, now Exam No. 6,851,185 (SLIP-6)	Completed
8PCT	EPO	---	04715132.5				Yearly annuity due 02-27
8	USA	---	10/19/0571 07-16-2005	Bicycle Brake Device	Boris K. Hermannsen Carl Winsfordner	Note	Alan Smith's action
9	USA	---	10/412,397 04-12-2003	Bicycle Crank Arm	Frank Hermannsen Carl Winsfordner	Note	2-24-06 response to third office action - sent to Washington available to interview Examiner
9	TAIWAN	---	93109571 04-05-2004				04-05-2007 exam due
9PCT	PCT	---	PCT/US2004/005559 03-23-2004			10412,397 (SLIP-3)	completed
9PCT	EPO	---	64739737				Yearly annuity due 04-12
20	USA	7,225,703 06-04-2007	10/802,103 03-16-2004	Bicycle Pedal And Crank Offsets	Carl Winsfordner Frank Hermannsen	Note	2-3-06 annuity due 12-15-2010 2-3-06 exam due 12-15-2010 11-27-07 annuity due 12-15-2010 exams 03-16-2004
20PCT	USA	---	10/124,015 02-13-2004			10/107,109 (SLIP-20)	Pending, waiting to first office action
20PCT	TAIWAN	---	93109571 02-13-2004			10/307,103 (SLIP-20) 20/2001/001,615 (SLIP-20CIP)	07-11-2008 exam due date
20PCT	PCT	---	PCT/US2005/008025 05-16-2005			10/307,109 (SLIP-20) 20/2001/001,615 (SLIP-20CIP)	reopened

Ceds SLIP	Country	Patent No./ Issue Date	Serial No./ Filing Date	Title	Inventor(s)	Priority/Related Files	Comments/Instructions
21	USA	6,295,885 03-27-2001	09/351,709 08-08-1999	Clippers Recycle Path	Frank Henningsen Carl Winckfordner	Note	3.5 yr. priority due 09-17-2004 7.5 yr. priority due 08-27-2008 11.5 yr. priority due 09-27-2012 expires 09-02-2019
22	USA PCT		11/238,146 03-26-2005 PCT/03/004430/46 03-14-2006	Bicycle Pedal	Frank Henningsen Carl Winckfordner	Note	Pending waiting for first office action 11-25-07 National filing and 1.5 yr. priority
23	USA		11/220,996 03-06-2005	Steering Bearing Assembly For Bicycles	Frank Henningsen Carl Winckfordner	Note	12-14-2007 Response to first office action due
24	USA		11/546,203 10-11-2006	Bicycle Wheel	Frank Henningsen Carl Winckfordner		10-19-2007 PCT & Taiwan due
25	USA		11/657,751 01-25-2007	Motorcycle Foot Peg and Boot Clear Assembly	Steve L. Boeltnke Frank Henningsen Carl Winckfordner Andrew Elbrick		01-25-2008 PCT & Taiwan due
26	USA		11/732,984 03-05-2007	Quick Release Camming Mechanism	Carl Winckfordner Frank Henningsen		03-05-2009 PCT & Taiwan due
A	USA	DE 437,541 02-13-2001	129,276 09-08-2000	Multi-tool device	Frank Henningsen Carl Winckfordner	Note	Expires 02-13-2015

# EXHIBIT W



United States  
Patent and  
Trademark Office

[Home Page](#)
[USPTO Home Page](#)
[Finance Online Shopping Page](#)

<b>Patent Bibliographic Data</b>		<b>07/21/2010 04:42 PM</b>	
Patent Number:	6205885	Application Number:	09391709
Issue Date:	03/27/2001	Filing Date:	09/08/1999
Title:	CLIPLESS BICYCLE PEDAL		
Status:	APC status indicates patent expired on: 03/27/2009		
Window Opens:	03/27/2004	Surcharge Date:	09/28/2004
Fee Amt Due:	\$0.00	Surchg Amt Due:	\$0.00
Fee Code:		Total Amt Due:	\$0.00
Surcharge Fee Code:			
Most recent events (up to 7):	06/04/2009 Refund - Payment of Maintenance Fee, 4th Yr, Small Entity. 06/04/2009 Refund - Surcharge, Petition to Accept Pymt After Exp. Unavo 06/04/2009 Refund - Payment of Maintenance Fee, 8th Yr, Small Entity. 06/04/2009 Refund - 7.5 yr surcharge - late pmt w/in 6 mo, Small Entity 06/03/2009 Petition Related to Maintenance Fees Denied/Dismissed. 10/15/2008 Petition Related to Maintenance Fees Granted. 07/31/2008 Petition Related to Maintenance Fees Filed. --- End of Maintenance History ---		
Address for fee purposes:	HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219		
NOTE: All USPTO fees are subject to change. If you are making a payment by mail or fax, please visit this <a href="#">link</a> or contact the Maintenance Fee Branch (571-272-6500) to confirm the amount due on the date payment is to be made. A maintenance fee payment can be timely made using the certificate of mailing or transmission procedure set forth in 37 CFR 1.8.			
<a href="#">Run Another Query</a>			

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 [Alerts Page](#)

# EXHIBIT X



From: Carl Winefordner [carl@crankbrothers.com]  
Sent: Friday, December 18, 2009 3:03 PM  
To: Chen, Tom; McNally, Annie  
Subject: Fwd: Patents and Patent Applications in the name of Crank Brothers  
Attachments: General situation CBs - IP @ 15.12.2009.xlsx

Dear Tom:

Please see the below email from APTA, and the attachment, and then see my reply to him in blue. Please note that there is a request to you in my reply him.

Let me know if you have any questions or comments.

Possibly, I have straightened out the confusion where APTA was asking you for files that they should not have been requesting.

Best regards,

Carl

Dear Dr.ssa Giulia Bordinon:

Thank you for your email.

You asked about whether or not APTA should handle the patents shown in green. In general, I believe the procedure we are to follow is that Haynes and Boone handle all US patents, and APTA handle all other patents. With that in mind, the first green item: Method of Fabricating A Clipless Bicycle Pedal application # 04715134.5 should be handled by APTA because this patent is not filed in the US. I will ask Haynes and Boone to send you the file on this patent, as it appears that perhaps you do not have it.

However, the bottom two green items (pump and wheel) should be handled by Haynes and Boone, because they are US only.

Regarding the bottom yellow item, the Clipless Bicycle Pedal (US patent number 6205895) should be handled by Haynes and Boone, as it is a US patent. Also, it is not abandoned, nor should it be abandoned. Our previous patent attorney made a mistake and did not pay the maintenance fee on time which caused it to be briefly shown as abandoned, but the that patent attorney petitioned to the USPTO and were able to pay the fee and make the patent active again.

Best regards,

Carl  
Carl Winefordner

----- Forwarded message -----

From: Giulia Bordinon <bordinon@aptalaw.com>  
Date: Tue, Dec 15, 2009 at 8:58 AM  
Subject: Patents and Patent Applications in the name of Crank Brothers  
To: Carl Winefordner <carl@crankbrothers.com>, Stefano Segato <stefano.segato@scelleroyal.com>, Barbara Bigolin <barbara.bigolin@scelleroyal.com>  
Cc: Studio Legale Feltrinelli <feltrinelli@feltrinelli-brogi.com>, fuochi@aptalaw.com

Dear Sirs,

This is to send you the enclosed updated database of patents in the name of CrankBrothers.

7/13/2010

We would like to underline that the lines filled in orange concerns to changes in the status of patents in respect to your database and the lines filled in green concerns to patents or patents applications that were not present in your database.

We kindly ask you if we have to handle also the applications highlighted in green.

Thank you for your collaboration.

We remain at your disposal for any further information you may need.

Best regards.

- Dr.ssa Giulia Bordinon -



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Fax 02.54126114	Fax 045.8350695	Fax 051.4214218	Fax 059.359848		Fax 049.723154

7/13/2010

Web site: [www.aptafaw.com](http://www.aptafaw.com)

—  
Carl Winefordner  
crankbrothers engineering

7/13/2010



# EXHIBIT Y

**McNally, Annie**

---

**From:** McNally, Annie  
**Sent:** Wednesday, February 17, 2010 9:16 AM  
**To:** Chen, Tom  
**Subject:** RE: Patent in the name of Crank Brothers - Further information

Just left another message. The petition office has assigned a person (Steven Brintley 571-272-3203) to handle this case, so there is progress.

---

**From:** McNally, Annie  
**Sent:** Tuesday, February 16, 2010 3:39 PM  
**To:** Chen, Tom  
**Subject:** RE: Patent in the name of Crank Brothers - Further information

I haven't forgotten about this. The patent office was closed most of last week.

---

**From:** Chen, Tom  
**Sent:** Tuesday, February 16, 2010 3:37 PM  
**To:** McNally, Annie  
**Subject:** RE: Patent in the name of Crank Brothers - Further information

Please keep checking on this. Thanks.

---

**From:** McNally, Annie  
**Sent:** Monday, January 25, 2010 9:47 AM  
**To:** Chen, Tom  
**Subject:** RE: Patent in the name of Crank Brothers - Further information

Talked to Michael Eason at the petition branch. She couldn't figure it out since there isn't much electronically. She need to pull the file and will call me back.

---

**From:** Chen, Tom  
**Sent:** Friday, January 22, 2010 5:05 PM  
**To:** McNally, Annie  
**Subject:** FW: Patent in the name of Crank Brothers - Further information

Please call the Maintenance Fee Branch (571-272-6500) to confirm when this patent actually expired. It appears to have expired March 27, 2009. However, the attached statement shows that the 4th year maintenance fee was refunded, so if the 4th year maintenance was not paid, then the patent may have expired March 27, 2005. So, basically check to see if the 4th year maintenance fee was paid. Thanks.

Tom

---

**From:** Chen, Tom  
**Sent:** Friday, January 22, 2010 4:15 PM  
**To:** McNally, Annie  
**Subject:** FW: Patent in the name of Crank Brothers - Further information

Annie,

Please get me this file ASAP. Just talked to Carl, and he believes all files, including this one, was sent to us. The confusion is that the statement shows the Petition was Granted on Oct. 15, 2008 but then denied/dismissed June 9, 2009.

Tom

7/14/2010

**From:** McNally, Annie  
**Sent:** Thursday, January 21, 2010 9:45 AM  
**To:** Chen, Tom  
**Subject:** RE: Patent in the name of Crank Brothers - Further information

This is not good. Prior attorney filed a petition revive for unavoidable abandonment and the petition was denied in 06/09. The decision was mailed to the prior attorney. The patent stands abandoned.

The patent expired on 03/27/09. I think the time limit to revive is 2 years from expiration (also the statute of limitation to bring infringement lawsuits). So we could suggest to revive for unintentional. We did an estimate for Printronix last year, I think the total cost is around \$3000 (not sure if they get Small Entity discount for these). Please double check the time limit again before replying to the client.

The statement from the USPTO is attached.

**From:** Chen, Tom  
**Sent:** Thursday, January 21, 2010 9:13 AM  
**To:** McNally, Annie  
**Subject:** FW: Patent in the name of Crank Brothers - Further information

Annie,

Please check on item 2) below and respond when you have some information. Thanks.

Tom

**From:** Giulia Bordinon [mailto:bordinon@aptalaw.com]  
**Sent:** Thursday, January 21, 2010 1:42 AM  
**To:** Chen, Tom  
**Cc:** McNally, Annie; 'Studio Legale Feltrinelli'; fuochi@aptalaw.com  
**Subject:** R: Patent in the name of Crank Brothers - Further Information

Dear Mr Chen,  
 with reference to our previous communications, this is to give you the following other information:

1) Our ref. for the following US and EPC cases are:

APTA ref.: 10174	Compact Manual Air Pump Having Selectable High Volume And High Pressure Models	Filing date: 21/04/1997	Application Number: 06/645,068	Grant date: 22/02/2000	Patent number: US 6,027,318	Inventors: Frank Hermanson; Carl Winefordner
APTA ref.:16175 Cbros ref.:70814.39 Attorney ref.:M-17589 US	Bicycle wheel	Filing date: 11/10/2006	Application Number: 11/546206	Grant date: 22/12/2008	Patent number: US 7,635,170	Inventors: Hermanson; Frank . et al
APTA ref.:16173 Attorney ref.: M-17589 EPC	Method Of Fabricating A Clipless Bicycle Pedal	Filing date: 26/02/2004	Application Number: EP 04715134.5	Publication date: 10/03/2004	Publication number: EP1635976	Inventors: Frank Hermanson; Carl Winefordner

Also for these cases, APTA S.r.l will handle directly annuity fee payments. We confirm that you could remove these and the previous communicated cases from your docket.

- 2) As for US patent No. US 6205885 (O ref. 16001 Y ref. SUP-30), Mr Winefordner informed us on December 19, 2009 that "Regarding the bottom yellow item, the Clipless Bicycle Pedal (US patent number 6205885) should be handled by Haynes and Boone, as it is a US patent. Also, it is not abandoned, nor should it be abandoned. Our previous patent attorney made a mistake and did not pay the maintenance fee on time which caused it to be briefly shown as abandoned, but the that patent attorney petitioned to the USPTO and were able to pay the fee and make the patent active again". Could you please let us know if you have received some confirmation about the late payment from USPTO?

7/14/2010

Thank you for your collaboration.  
Best regards.

- Dr.ssa Giulia Bordinon -



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Associated Patent & Trademark Attorneys

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Web site: [www.aptalaw.com](http://www.aptalaw.com)

Da: Chen, Tom [mailto:Tom.Chen@haynesboone.com]

Inviato: martedì 15 dicembre 2009 18.46

A: Giulia Bordinon

Cc: McNally, Annie; Studio Legale Feltrinelli; fuochi@aptalaw.com

Oggetto: RE: Patent in the name of Crank Brothers - New Patent representative O. ref.: 10508 SAF/GB/mb

Dear Dr. Bordinon,

We acknowledge your instructions. For the U.S. and foreign annuities/maintenance fees, do you want us to docket and send reminders as needed to you or can we remove these items from our docket?

For US patent application No. 11/732894 (HNB Ref. 70614.00022; APTA ref. 14993): The Patent Office did not register our change of POA, so we did not receive Notice of Allowance. Thank you for bringing this to our attention. We will report this out to Crankbrothers and ask for instructions today.

For US patent application No. 11/136134 (HNB Ref. 70614.00024; APTA ref. 14995): We see that the Patent Office issues a communication today, but it is not available electronically yet. We should be receiving this within the next few days and will let you know. Regarding the divisional, we are still determining whether one should be filed (there was a restriction requirement in the current application and a few of the claims were withdrawn). However, since this application has not been allowed, we have plenty of time to file a divisional if needed. We will know more once we receive the next Office Action. So, the Dec. 19 date is not a hard date, and we do not plan on filing a divisional by that date, although we may yet still file a divisional at a later date.

Thank you.

Regards,  
Tom

From: Giulia Bordinon [mailto:bordinon@aptalaw.com]

Sent: Tuesday, December 15, 2009 9:40 AM

To: Chen, Tom

Cc: McNally, Annie; Studio Legale Feltrinelli; fuochi@aptalaw.com

Subject: R: Patent in the name of Crank Brothers - New Patent representative O. ref.: 10508 SAF/GB/mb

7/14/2010



Dear Mr. Chen,  
with reference to your database sent on November 28, 2009, we would like to inform you that the following cases will be handled directly by APTA S.r.l.:

1. Taiwanese case Cbros ref. 70614.00012 (O. ref. 14984) Application No. 93104809;
2. Taiwanese case Cbros ref. 70614.00015 (O. ref. 14987) Application No. 93109371;
3. European case Cbros 70614.00036 (O. ref. 16007) Application No. 04750737.2 entitled "Bicycle crank arm";
4. European case Your ref. M-17598 Application No. 04715134.5 entitled "Method of fabricating a clipless bicycle pedal".

We would like to inform you also that we will handle directly all annuity fees to be paid for foreign and US cases in the name of Crank Brothers.

Our ref. for US cases are the following:

Cbros ref.	APTA ref.
70614.00016	14988
70614.00022	14993
70614.00024	14995
70614.00026	14997
70614.00030	16001
70614.00034	16005
70614.00037	16008

We kindly ask you to record them and to report them in your further communications.

We would like to kindly ask you the following questions.

1. US patent application No. 11/722894 Cbros ref. 70614.00022 APTA ref. 14993 has received the Notice of Allowance with corresponding fees due before January 16, 2010. Have you already communicated it to Crank Brothers? Have those fees been duly paid?
2. US patent application No. 11/138134 Cbros ref. 70614.00024 APTA ref. 14995: you have indicated that you are awaiting an office action and preparing a divisional application if possible (by December 19, 2009). We kindly ask you to inform us promptly about these actions.

Please acknowledge safe receipt of this communication and provide us with the reply to the above-questions.

Thank you for your collaboration.  
Best regards.

- Dr.ssa Giulia Bordignon -



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Fax 0444.235006

35137 Padova  
Via S. Cristoforo, 66  
Tel. 049.725751  
Fax 049.725554

Web site: [www.aptalaw.com](http://www.aptalaw.com)

**Da:** Chen, Tom [mailto:Tom.Chen@haynesboone.com]  
**Inviato:** lunedì 23 novembre 2009 19:54  
**A:** Martina  
**Cc:** Giulia Bordignon; McNally, Annie  
**Oggetto:** RE: Patent in the name of Crank Brothers - New Patent representative O. ref.: 10508 SAF/GB/mb

Dear Martina,

Please find the list of U.S. cases handled by us, with due dates shown in bold. Please let us know if you have any questions.

Regards,  
Tom

---

**From:** Martina [mailto:martina@aptalaw.com]  
**Sent:** Thursday, November 19, 2009 11:57 PM  
**To:** Chen, Tom  
**Cc:** 'Giulia Bordignon'  
**Subject:** I: Patent in the name of Crank Brothers - New Patent representative O. ref.: 10508 SAF/GB/mb  
**Importance:** High

RE M I N D E R

k.a.: Mr. Tom Chen

Dear Mr. Chen,

we refer to our e-mail below and we kindly ask you to let us have a short report of all US cases handled by your office for Crank Brothers, underlining the urgencies, as soon as possible.

We thank you for your cooperation.

Best Regards,

The Secretary

---

**Da:** Martina [mailto:martina@aptalaw.com]  
**Inviato:** martedì 3 novembre 2009 9:57  
**A:** 'tom.chen@haynesboone.com'  
**Cc:** 'Giulia Bordignon'  
**Oggetto:** Patent in the name of Crank Brothers - New Patent representative O. ref.: 10508 SAF/GB/mb

O. ref.: 10508 SAF/GB/mb

k.a.: Mr. Tom Chen

Please see the enclosed letter.

Acknowledge safe receipt of this letter.

Best Regards,  
The Secretary



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Fax 02.54125114	Fax 045.8350090	Fax 051.250368	Fax 059.355808	Fax 0444.235005	Fax 049.723354

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# Petitioner's Exhibit V

Post-Issuance History in  
Pat. No. 5,678,541  
“Atomic-1”

Exhibit V



Leonard Tachner  
Suite 38-E  
17961 Sky Park Circle  
Irvine, CA 92614

**MAILED**

OCT 06 2011

OFFICE OF PETITIONS

In re Patent of Garraffa	:	
Patent No. 5,678,541	:	
Issue Date: October 21, 1997	:	Request for Information
Application No. 08/616,223	:	
Filing Date: March 5, 1996	:	
Attorney Docket No. Atomic-1	:	

**Request for Information**

This communication responds to a renewed petition under 37 C.F.R. § 1.378(b) filed April 22, 2011.

By Petitioner's own admission, the Tachner firm, or persons employed by that firm, have not been truthful with the USPTO. Furthermore, there is a specter of bias in the declaration of Dr. Albert since, at the time of his diagnosis, he was not Janis Foreman's doctor and he was paid to provide his opinion by Mr. Tachner. The record fails to include any evidence corroborating Dr. Albert's diagnosis. Given the circumstances of this case, corroborating evidence for Dr. Albert's diagnosis is required. It is extremely odd that the people that were closest to Ms. Foreman did not notice that, as stated by Dr. Albert, she exhibited "destabilizing behavior" or that "she lost her sense of reality" or "lost her sense of proportionality." Further, as stated in Mr. Tachner's declaration, it appears that for about two years, Ms. Foreman was failing to bill clients or pay firm obligations even though the performance of these tasks appears to have been her primary duty. Therefore, it is not clear from the record how Mr. Tachner could have failed to recognize Ms. Foreman was failing to properly bill clients and pay firm obligations.

In response to the instant request for information, Petitioner is required to provide a rebuttal to all the assertions set forth in the petition filed July 21, 2010 in U.S. Patent No. 6,205,885.<sup>1</sup> Furthermore, Petitioner must explain why the current explanation provided in this case is any more believable than other explanations previously provided. Petitioner is required to provide corroborating evidence of Ms. Foreman's condition from a source that is independent of Dr. Albert. Additionally, Petitioner must fully discuss how the actions of Ms. Foreman, with regard

---

<sup>1</sup> A copy of the petition can be accessed using the Office's Public Patent Application Information Retrieval system located at <http://portal.uspto.gov/external/portal/pair>.

to the docket, went undetected from early 2005 until January 2011. Further, Petitioner must explain how Ms. Foreman's failure to bill clients and pay firm obligations went undetected from early 2005 until the end of 2007.

Petitioner must submit the requested information within TWO MONTHS of the mailing date of this letter. Extensions of time may not be obtained. No additional fee is due for a response to the instant request for information. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight  
Director  
Office of Petitions

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APR 22 2011

Attorney Docket No.: ATOMIC-1

## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

Patentee: Dean R. Garaffa )  
Patent No.: 5,678,541 )  
Issued: October 21, 1997 )  
For: IMPROVED BREATHING REGULATOR )  
APPARATUS HAVING AUTOMATIC )  
FLOW CONTROL )

USPTO  
RECEIPTS ACCOUNTING  
DIVISION  
2011 APR 26 PM 4:40**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENT****MAIL STOP: PETITIONS**

Attn: Charles Steven Brantley  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justifies

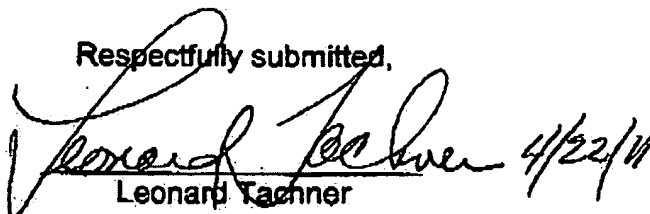
04/27/2011 DALLEN 00000007 060930 5678541

01 FC:1599 2055.00 DA  
02 FC:1462 400.00 DA

reconsideration and granting of the pending petition and such is respectfully solicited.

A fee of \$2,455.00 (for the third annuity of \$2,055.00 and \$400.00 for the requested reconsideration) should be deducted from Deposit Account No. 06-0930.

Respectfully submitted,

  
Leonard Tachner 4/22/11

Attachments:

1. Additional Declaration of Leonard Tachner (3 pages)
2. Declaration of Samuel H. Albert, M.D. (2 pages)
3. Additional Declaration of Janis Foreman (3 pages)



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APR 22 2011

Attorney Docket No.: **ATOMIC-1****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Dean R. Garraffa )  
Patent No.: 5,678,541 )  
Issued: October 21, 1997 )  
For: IMPROVED BREATHING REGULATOR )  
APPARATUS HAVING AUTOMATIC )  
FLOW CONTROL )

USPTO  
RECEIPTS ACCOUNTING  
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2011 APR 26 PM 4:40**ADDITIONAL DECLARATION OF LEONARD TACHNER****MAIL STOP: PETITIONS**

Attn: Charles Steven Brantley  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Leonard Tachner, do hereby declare as follows:

1. I submit this declaration as an addition to my prior declaration submitted with the subject petition. This statement is part of the evidence I am filing in support of a request for reconsideration.

2. When Ms. Foreman told me in 2008 in regard to U.S. Patent No. 6, 205,885 that the client told her that they would pay their own maintenance fees, at first it didn't seem suspicious because the client usually wrote most or all of the specification of their patent applications in order to reduce their fees. They left the claims to me to write. Only when the client disputed Ms. Foreman's statement did I begin to wonder whether Ms. Foreman was mistaken. However, I still accepted her assertion that she believed the client had made that statement

because up to then (by 2008 she had worked for me for 30 years) I had no reason to doubt her reliability. Only in late 2010 when she asserted that other clients (ATOMIC and CSUF) had also taken on the responsibility to pay their own maintenance fees, did I realize that I could no longer trust her because there was evidently something seriously wrong with Ms. Foreman. That is when I decided that I needed to have her see Dr. Albert.

3. Over the 33 years that I have been in my own practice, I have filed applications that issued into roughly 600 U.S. patents for my clients. In a small number of these applications and patents, it has been necessary to file a petition to revive due to a delayed response to an Office Action, a late issue fee payment and occasionally a late maintenance fee. Some of these petitions were necessary because of failures of clients to communicate in a timely manner. Up to the recent events; a few such petitions were made necessary by innocent clerical errors of my staff. However, to the best of my recollection, every one of those petitions to revive an application or to accept a late maintenance fee filed by my firm, had ultimately been granted. It would be impossible for us to know the precise numbers of such petitions, because once resolved, we do not retain any data summarizing such events. Moreover, many of such files have since been transferred to other firms or otherwise disposed of.

4. I now better understand the specific behavior that was Ms. Foreman's issue with meeting office deadlines primarily for paying maintenance fees to the U.S. Patent & Trademark Office. She would entirely overlook a payment deadline. Then rather than inform me in a timely manner so that I could remedy the delay, she would "cover up" her omission by alleging that the corresponding client had told her in a phone call or face to face discussion that they would pay such fees themselves. By way of example, here enclosed is a copy of a docket sheet entry apparently made by Ms. Foreman for this particular patent, showing that the client would pay their own maintenance fee. Only when

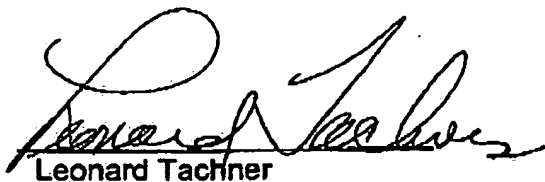
I began to see this type of entry more than once did I begin to understand that I had a serious problem.

5. I believe that the heavy workload I had assigned to Ms. Foreman over the past years has contributed to her aberrant behavior. However, I believe that her actions went beyond merely normal stress and anxiety. Based on my discussions with Dr. Albert, I now recognize that Ms. Foreman had for several years since as early as 2005 and as recently as four months ago, been ill and unable to cope with her responsibilities. I also believe that her illness was a direct cause of the firm's failure to act in a timely manner in behalf of the client in this matter.

6. I regard Ms. Foreman as more than just my employee. After more than three decades of a close working relationship, Ms. Foreman is more like a member of my family. I believe that is the reason that I did not recognize her problems earlier. She will continue to see Dr. Albert at my expense. In the meantime I will transfer time-based responsibilities from Ms. Foreman to another employee.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4/22/11



Leonard Tachner  
Attorney for the Petitioner  
Registration No. 26,344

APR 22 2011

**(714) 752-8525**

**ISSUED**

DEAN R. GAROFA

08/616,223

**FILED**

3-15-96

**TITLE**

### Improved Breathing Regulator Apparatus Having Automatic Flow Control.

**ASSIGNEE**

**ASSIGNMENT RECORDED**

REEL

**FRAME**

## OFFICE ACTIONS

## AMENDMENTS

1-18-97 Issue Fees + Drugs.

6-18-97 pd a drugs

4-21-2001 First Anniversary

10-22-01 pd w/surich

4-21-2005 Second Anniversary

Chart will pay fees

4-21-2009 Third Annuity

CLIENT & TITLE  
DIVISION OF  
CONTINUATION IN PART OF

**CANADIAN**

INVENTOR:

**SERIAL NO**

08/6/6, 223

**ALLOWED**

**FINAL FEE PAID**

PATENT NO.

5,678,541

DATE \_\_\_\_\_

October 21, 1997

ISSN: 0022-0181

RECEIVED 007  
CENTRAL FAX CENTER  
APR 22 2011

Attorney Docket No.: **ATOMIC-1**

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Dean R. Garraffa )  
Patent No.: 5,678,541 )  
Issued: October 21, 1997 )  
For: IMPROVED BREATHING REGULATOR )  
APPARATUS HAVING AUTOMATIC )  
FLOW CONTROL )

**ADDITIONAL DECLARATION OF JANIS FOREMAN**

**MAIL STOP: PETITIONS**

Attn: Charles Steven Brantley  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Janis Foreman, do hereby declare as follows:

1. This declaration is a supplement to my prior declaration submitted in regard to a petition to accept an unavoidably delayed payment of the maintenance fee for the above-identified patent.

2. Over the past few months I have, as a result of discussions with and medical treatment from Dr. Samuel Albert, begun to understand that over the last five or six years I have been ill and unable to function normally and rationally in my employment as Office Manager at the Tachner Law Firm. My mindset was more attuned to survival than to properly carrying out my duties.

3. In regard to the subject patent in particular, my duty was to communicate in a timely manner with the client who is the patentee of the subject patent, to ascertain whether that client wished to have our firm pay the maintenance fee that was required in order to retain the patent. Normally, I would have sent a letter or an email to the client about 45 days before the due date for payment of the maintenance fee. Then, if I receive a positive response, I would have prepared and mailed or emailed a statement to the client so that payment from the client would be received in time to forward the payment to the U.S. Patent & Trademark Office before the due date.

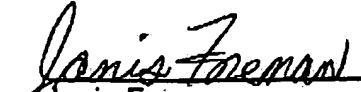
4. It is my current recollection that what I did instead was to recognize that a maintenance fee was coming due for this patent, but continually put it off as something that I could attend to in due course, since I had more urgent things to do before I could get to that matter. Then I would rationalize that I could rely on a six-month surcharge period if needed and continue to put off communicating with the client. Eventually, I ran out of time, but it would occur to me that this client had wanted to pay its own maintenance fees and I would simply make such an entry in the corresponding docket sheet.

5. There was no logic or rational explanation for my behavior. I simply felt hopelessly overwhelmed and this was a way for me to handle it. I had no animosity toward the client or toward the law firm. It was just my way of coping with what I perceived to be an impossible situation without admitting to Mr. Tachner that I could no longer handle all of my usual responsibilities.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or

both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4-22-11

  
Janis Foreman

**Samuel H. Albert, M.D., Inc.**  
**Diplomate**  
**American Board of Psychiatry & Neurology**

I, Dr. Samuel Albert, do hereby declare as follows:

1. This declaration supplements my prior statement submitted previously in regard to this matter.
2. Based upon my interviews with Ms. Janice P. Foreman, and Mr. Leonard Tachner, it is evident that her problems at her employment stemmed from a significant increase in her workload and responsibilities that occurred at about the beginning of 2002 when another law firm went out of business and several hundred files were transferred to the Tachner firm. Evidently, she was able to handle the sudden workload increase for a period of two to three years. However, beginning in late 2004, early 2005 she started falling behind and could no longer keep current.
3. In retrospect she now realizes that within a few months thereafter she started a pattern of behavior which she now recognizes as irrational. Such behavior for example included making up false excuses for failing to take required actions such as contacting clients and responding to Mr. Tachner's questions with answers that may have had no factual basis, but which she believed would satisfy his inquiry. In my opinion, it was during this period beginning in mid-2005 when Ms. Foreman went through a transition from being merely over-worked and highly stressed to being clinically ill.
4. It appears that the extent of her illness varied depending upon her level of stress and anxiety, but that it didn't fully abate until the early months of 2011. The principal symptom of this illness was her inability to separate real events from imagined ones. From time to time during this period, she would let her behavior and her actions be dictated by what she perceived to have previously occurred as opposed to events that had actually taken place.
5. In my opinion therefore, between mid-2005 and late 2010, and based upon her prior reliable behavior in regard to her duties at the Tachner firm, Ms. Foreman's failure to take proper actions were due to a psychosis that



manifested in her inability to distinguish real events from imagined ones. This condition was of such a degree, that she could not function normally and if she were to be questioned or challenged in regard to her behavior, that would raise her stress level and exacerbate her condition. I have advised Mr. Tachner and Ms. Foreman that it would be my recommendation that Ms. Foreman enter treatment on a regular basis so that I can monitor her progress and be sure that there is no regression.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: \_\_\_\_\_

April 11 2011 Samuel Albert MD

Dr. Samuel Albert



Leonard Tachner  
Suite 38-E  
17961 Sky Park Circle  
Irvine, CA 92614

**MAILED**

**FEB 22 2011**

**OFFICE OF PETITIONS**

In re Patent of Garraffa :  
Patent No. 5,678,541 :  
Issue Date: October 21, 1997 :  
Application No. 08/616,223 :  
Filing Date: March 5, 1996 :  
Attorney Docket No. Atomic-1 :

Decision on Petition

This is a decision on the petition under 37 C.F.R. § 1.378(b), filed December 22, 2010, to reinstate the above-identified patent.

The petition is **DISMISSED**.

**Facts**

The instant application was filed March 5, 1996.

Attorney Leonard Tachner handled prosecution of the instant application.

The application issued as a patent on October 21, 1997.

The 3.5 year maintenance fee of \$440 and a surcharge of \$65 were timely paid on October 22, 2001.

The 7.5 year maintenance fee could have been paid from October 21, 2004, to April 21, 2005, or with a surcharge from April 22, 2005, to October 21, 2005. The fee was not timely paid. As a result, the patent expired October 22, 2005.

The petition states the patent is owned by Atomic Aquatics. Dean Garraffa is the sole inventor and a principal of Atomic Aquatics.

On November 17, 2010, Garraffa contacted Janis Foreman, Tachner's Office manager, and requested she supply him with a tabular report showing the current status of Petitioner's patents handled by Tachner's firm.

During the creation of the report, Foreman noticed several of Petitioner's patents had expired as a result of non-payment of maintenance fees since early 2005.

Garraffa received the report on or about November 24, 2010. Thereafter, Garraffa promptly requested a meeting with Tachner to discuss the report. The petition states the expired status of the patents shocked Garraffa, as well as another principal of Petitioner.

The petition states, with emphasis added,

The declaration evidence shows that over a protracted period[,] beginning in 2005[,] Ms. Foreman experienced a psychological breakdown or psychotic episode as described by Dr. Albert.... The breakdown of Ms. Foreman caused her to fail in her office duties which included notifying the patentee of the need to pay maintenance fees.... **Only [in the] past few weeks has her strange and unexpected behavior come to light.**

Ms. Foreman has been a loyal and reliable employee of Tachner's office for more than thirty-two years. She did not exhibit any form of overt personality characteristics or behavior which would have led Mr. Tachner to anticipate that she would not have fulfilled her normal office duties as she had done for more than three decades. Based upon Dr. Albert's interview and diagnosis of Ms. Foreman, **it is only now understood that she was overworked and stressed beyond her limit ...** but that she was "programmed" to hide her predicament for fear of losing her position.

Tachner's declaration states,

[Foreman and I] have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney.... Her actions in dealing with clients, the U.S. Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communication are to be reviewed by me.

The petition is accompanied by a declaration by Samuel H. Albert, M.D., a practicing psychiatrist. Foreman met with Dr. Albert during late November 2010 at Tachner's request. Dr. Albert's declaration states,

Based upon [the] facts communicated to me, my reading of the Tachner and Foreman statements and my interview with Ms. Foreman, I have formed a preliminary medical opinion as follows:

Ms. Foreman's irrational behavior is a result of her reaction to a temporary but continually increasing workload which became more than she could handle....

[S]he evidently became so busy that she's lost the ability to bill clients in a timely manner and pay the firm's obligations when they were due....

She began feeling a sense of guilt for not being able to properly handle these responsibilities. She did not want to inform Mr. Tachner of these problems.... [S]he spent more time concerned with her problems [than] with solving her problems.

She began to do and say unreasonable and unrealistic things.... She lost any sense of reality.... Her goal became one of maintaining a sense of continuity and stability for Mr. Tachner even by misleading him and making false statements to him and to others. Ms. Foreman was suffering from an acute psychotic breakdown brought on by rising pressures at her most important environment, her workplace where she had succeeded for decades....

I believe Ms. Foreman's illness is amenable to treatment.

The instant petition does not appear to be the only petition filed by Tachner on behalf of Petitioner. Additional petitions include, but are not necessarily limited to:

1. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 5,803,073 on December 22, 2010,
2. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,761,163 on January 3, 2011,
3. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,463,640 on January 3, 2011,
4. A petition under 37 C.F.R. § 1.137(a) filed for Application No. 29/238,632 on January 12, 2011,
5. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,098,924 on January 24, 2011, and
6. A petition under 37 C.F.R. § 1.378(b) filed for Patent No. 6,347,766 on January 24, 2011.

### Law

A grantable petition under 37 C.F.R. § 1.378(b) must be accompanied by a showing to the satisfaction of the Director that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable.

In order for a party to show unavoidable delay, the party must show "reasonable care was taken to ensure that the maintenance fee would be promptly paid."<sup>1</sup> The level of "reasonable care" required to be shown is the same as the level of "care or diligence ... generally used and observed by prudent and careful men in relation to their most important business."<sup>2</sup> When determining if a

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<sup>1</sup> 37 C.F.R. § 1.378(b).

<sup>2</sup> *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). See also *Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was

period of delay has been shown to have been unavoidable, the Office will take "all the facts and circumstances into account" and will decide each petition "on a case-by-case basis."<sup>3</sup>

35 U.S.C. § 41(c)(1) states, with emphasis added, "The Director may accept the payment of any maintenance fee . . . after the six month grace period if the delay is *shown to the satisfaction of the Director* to have been unavoidable." Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

The Office and Congress have recognized the unavoidable standard can be very difficult to meet. During 1992, Congress considered the difficulty involved in reinstating a patent under the unavoidable. Congressional representatives described the unavoidable standard as inflexible, extremely hard to meet, too stringent and harsh.<sup>4</sup> Congress did NOT take steps to make the unavoidable standard more flexible, easier to meet, less stringent, or less harsh. Instead, Congress determined that it would allow patent owners the ability to reinstate a patent under an "unintentional" standard as long as the petition was filed within 24 months of the expiration of the patent. Congress chose to continue requiring proof of unavoidable delay for petitions filed after the 24 month time period.

### Analysis

#### The Error That Led to Non-Payment of the 7.5 year Maintenance Fee

The petition argues the 7.5 year fee was not paid as a result of an error by Foreman. However, the petition does not actually identify the error made by Foreman. In view of Petitioner's failure to identify Foreman's error, the Office is unable to conclude Tachner's reliance on Foreman not to make such an error was reasonable and prudent. In other words, the record fails to establish the failure to timely pay the fee was unavoidable.

### Causation

The petition fails to prove the 7.5 year maintenance fee would have been paid absent Foreman's medical condition.

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unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

<sup>3</sup> *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

<sup>4</sup> "[The unavoidable] standard has been found to be extremely hard to meet. Some patent owners have lost their patent rights due to this inflexible standard." 138 CONG. REC. S16613, 16614 (September 30, 1992) (Rep. DeConcini) (emphasis added). "The unavoidable standard has proved to be too stringent in many cases." 138 CONG. REC. H1115 (October 3, 1992) (Rep. Hughes) (emphasis added). "The unavoidable standard is too stringent. Some patent owners have lost their patent rights due to circumstances that do not warrant this harsh result, but that could not be considered 'unavoidable' under current law." 138 CONG. REC. E1688 (June 4, 1992) (extension of remarks of Rep. McCollum) (emphasis added).

The petition asserts Foreman was “overworked and stressed beyond her limits.”

Dr. Albert’s statement indicates:

1. Tachner began continuously increasing Foreman’s workload on an unidentified date;
2. Foreman became overworked and stressed;
3. “[T]he Tachner law firm is a very busy firm and Ms. Foreman has a “heavy workload with many varied and important business responsibilities,” and
4. Foreman was unable “to vent her frustration, the worry, and concern” she felt as she fell further and further behind in her work.

Dr. Albert indicates Foreman eventually suffered an acute psychotic breakdown. However, Dr. Albert does not identify the date, or a specific time-frame during which, Foreman transitioned from being overworked, stressed employee to an employee suffering from an acute psychotic breakdown. In other words, the record fails to prove Foreman’s error, resulting in the expiration of the patent during October 2005, took place during the period of time Foreman was suffering from an acute psychotic breakdown.

Even if Foreman was suffering from an acute psychotic breakdown during the entire period from early 2005 until the date the petition was filed, the record would be insufficient to establish causation. The petition appears to simply assume the error was the result of the medical condition. However, the record implies the error may have well been the result of other factors, such as being overworked and being placed under a heavy workload.

#### Foreman’s Work Environment

On an unidentified date, Tachner began to continuously increasing Foreman’s workload, As a result of the heavier workload, she became overworked, stressed, and too busy to properly perform her duties.

In general, an inverse relationship exists between quality and an employee’s workload. In other words, the chance of an employee making an error when performing a task increases as the time the employee is allowed to spend on the task decreases. Therefore, a reasonable and prudent employer, treating the supervision of an employee as the employer’s most important business, would not simply assume an employee’s past quality of work would not suffer as the employer continuously increased the employee’s workload. Instead, such an employer would take steps to ensure the employee could adequately handle the new workload without a drop in quality. The record fails to indicate Tachner took any steps to ensure Foreman could adequately handle the new workload without a drop in quality.

If an employer has created a work environment in which employees feel 100% comfortable bringing workload issues to the employer’s attention, the employer might be reasonable in expecting an employee to inform the employer if the employee’s workload begins to impact the quality of the employee’s work. However, the record fails to prove Tachner created such a work environment. For example, the petition states, with emphasis added, “[Foreman] was

overworked and stressed beyond her limit ... [but was] “programmed” to hide her predicament *for fear of losing her position.*”

Tachner’s Continued Reliance on Foreman After the Expiration the Patent

In order for relief to be warranted under 37 C.F.R. § 1.378(b), the record must establish the entire delay in the submission of the fee was unavoidable.

If the expiration of the instant patent been discovered on an earlier date, a petition to reinstate the patent could have been filed on an earlier date. Therefore, the Office must determine if the failure to discover the expiration of the patent on an earlier date was unavoidable.

The petition asserts:

1. Foreman has been a reliable employee for more than thirty-two years;
2. “Only [in the] past few weeks has her strange and unexpected behavior come to light;” and
3. “[I]t is only now understood that she was overworked and stressed beyond her limit.”

Despite the assertions above, the evidence is insufficient to demonstrate Tachner had no reason to suspect Foreman’s past work was unreliable prior to discovering the expiration of the patent during November 2010.

The instant decision will discuss facts involving Patent No. 6,205,885, since such facts demonstrate Tachner had reasons to doubt the reliability of Foreman’s work well before November 2010.

Patent No. 6,205,885 expired as a result of Foreman removing all future maintenance fee due dates for all of a client’s patents from the docketing system. Tachner filed a renewed petition to reinstate the patent under 37 C.F.R. § 1.378(b) on July 31, 2008. Tachner clearly recognized Foreman had made an error. For example, page 2 of the petition stated, with emphasis added,

[The attached Tachner declaration indicates] Ms. Foreman made a *profound clerical error* ... [as a result of] Ms. Foreman’s distraction, or confusion or unusual lack of dependable adherence to client instructions.

Tachner’s declaration filed with the July 31, 2008 petition references concerns Tachner has concerning Foreman’s recent conduct and her current ability to perform her job. The declaration stated,

In retrospect, it seemed strange to me that neither we nor the client received a maintenance fee reminder for the “855 patent. Ms. Foreman assured me that we had not received such document.... [I also did not receive the prior decision mailed April 9, 2008.] Ms. Foreman maintained that the April 9 decision letter was not received by our office....<sup>5</sup>

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<sup>5</sup> Paragraph 5.

I've not previously had reason to doubt [Foreman's] work or question her actions....<sup>6</sup>

I am taking action immediately to reduce Ms. Foreman's duties in the office.<sup>7</sup>

In view of the prior facts, Tachner appears to have had reasons to doubt Foreman's reliability *at least* as early as July 31, 2008, which was almost 28 months before he discovered the expiration of the instant patent. Despite the existence of such reasons, the record fails to indicate Tachner took any steps to determine the identity of any other patents which may have expired as a result of error(s) by Foreman. The record fails to indicate Tachner would not have learned of the expiration of the instant patent on an earlier date if such steps had been taken. Therefore, the showing of record is insufficient to prove the *entire* delay in the submission of the 7.5 year maintenance fee was unavoidable.

Any request for reconsideration should discuss the extent to which Tachner was, or was not, reasonable in failing to take steps after July 31, 2008, to identify patents which may have unintentionally expired as a result of an error by Foreman.

Any request for reconsideration should clearly identify *all* applications in which Tachner filed a petition under 37 C.F.R. § 1.137 between October 1, 2004, and February 1, 2011. The request should also identify and fully discuss any errors by Foreman and/or Tachner, which contributed to the abandonment of each application.

Any request for reconsideration should clearly identify all patents in which Tachner filed a petition under 37 C.F.R. § 1.378 between October 1, 2004, and February 1, 2011. The request should also identify and fully discuss any errors by Foreman and/or Tachner, which contributed to the expiration of the patent.

Any request for reconsideration should clearly identify all patents, that Tachner is aware of, where a party other than Tachner filed a petition under 37 C.F.R. § 1.378(b) between October 1, 2004, and February 1, 2011, asserting Tachner, Foreman, or Tachner's firm made an error which contributed to the expiration of the patent.

#### Foreman's Authority to Take Various Actions

The Office is concerned statements in the instant petition involving Foreman's authority, or lack of authority, to take various actions. Information provided with petitions filed in Patent No. 6,205,885, appears to indicate Foreman was allowed to take actions in response to instructions from clients without first discussing the matter with Foreman. However, Tachner's declaration in this case states,

[Foreman and I] have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney.... Her actions in dealing with clients, the U.S.

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<sup>6</sup> Paragraph 7.

<sup>7</sup> Paragraph 9.



Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communication are to be reviewed by me.

Any request for reconsideration should *fully* discuss the extent to which Foreman was, or was not, permitted to take actions involving the payment of maintenance fees without first discussing the matter with Tachner.

In view of the prior discussion, the showing of record is not sufficient to establish that the entire delay was unavoidable within the meaning of 37 C.F.R. § 1.378(b).

### **The Address of Record**

The address on the petition is different than the address of record. As a courtesy, the Office is mailing the instant decision to the address on the petition. However, future communications will be mailed solely to the current address of record absent the filing of a request to change the address of record.

### **Petitioner's Current Options**

#### **I. Petitioner may file a request for reconsideration.**

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision and include a non-refundable petition fee of \$400. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.378(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

*After a decision on the petition for reconsideration is issued, no further reconsideration or review of the matter will be undertaken by the Director.* Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must **prove** that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

#### **II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.**

Since the petition is dismissed, petitioner may request a refund of the maintenance fee and surcharge. Petitioner is reminded that if a request for reconsideration is later filed along with the \$400 fee, the \$400 will not be refunded. A request for a refund should be sent to: Mail Stop 16,

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany any request for refund.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.<sup>8</sup>  
Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300  
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley  
Senior Petitions Attorney  
Office of Petitions

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<sup>8</sup> General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.

DEC 22 2010

JAN 12 2011

18 pages

## OFFICE OF PETITIONS

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0651-0018

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))**Docket Number (Optional)  
ATOMIC-1

Mail to: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450  
Fax: (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

Patent Number: 5,878,541Application Number: 08/616,223Issue Date: October 21, 1997Filing Date: March 15, 1996

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.368(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

☐ is a reissue of original Patent No. 01/11/2011 DALLIN 00000010 060930  
original application number 01/11/2011 DALLIN 00000010 060930  
original filing date 01/11/2011 DALLIN 00000010 060930

☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application  
filed on 01/11/2011 DALLIN 00000010 060930

**CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

12/22/10  
Date

Leonard Tachner  
Signature

LEONARD TACHNER

Typed or printed name of person signing Certificate

[Page 1 of 4]

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

DEC 22 2010

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0851-0016

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 1. SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

## 2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

## 3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$ _____	3 ½ yr fee	(1551)	<input type="checkbox"/> \$ _____	3 ½ yr fee	(2551)
<input type="checkbox"/> \$ _____	7 ½ yr fee	(1552)	<input checked="" type="checkbox"/> \$ 1240	7 ½ yr fee	(2552)
<input type="checkbox"/> \$ _____	11 ½ yr fee	(1553)	<input checked="" type="checkbox"/> \$ 2055	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ 3295

## 4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ 700

## 5. MANNER OF PAYMENT

- ☐ Enclosed is a check for the sum of \$ \_\_\_\_\_
- ☒ Please charge Deposit Account No. 06-0930 the sum of \$ 3995
- ☐ Payment by credit card. Form PTO-2038 is attached.

## 6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

- ☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 06-0930

[Page 2 of 4]

DEC 22 2010

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0551-0016

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 7. OVERPAYMENT

As to any overpayment made, please

☒ Credit to Deposit Account No. 06-0930

OR

☐ Send refund check

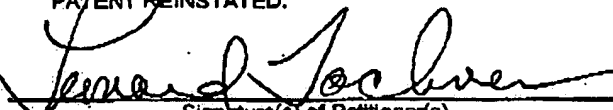
## WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

## 8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

## 9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

  
Signature(s) of Petitioner(s)12/22/10  
Date

LEONARD TACHNER

Typed or printed name(s)

26,344

Registration Number, if applicable

17961 SKY PARK CIRCLE, SUITE 38-E

Address

949-752-8525

Telephone Number

IRVINE, CALIFORNIA 92614

Address

## ENCLOSURES:

- ☒ Maintenance Fee Payment  
☒ Statement why maintenance fee was not paid timely  
☒ Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)  
☐ Other:

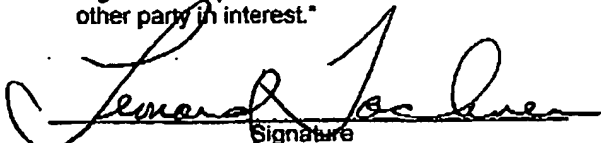
(Page 3 of 4)

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0851-0016  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

  
Signature12/22/10  
Date

LEONARD TACHNER

Type or printed name

26,344

Registration Number, if applicable

**STATEMENT**

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

This petition is supported by declarations of the undersigned, Leonard Tachner counsel for the patentee, the office manager of counsel's office, Ms. Janis foreman and a physician, Dr. Samuel A. Albert who is a board certified psychiatrist.

The declaration evidence shows that over a protracted period beginning in 2005 Ms. Foreman experienced a psychological breakdown or psychotic episode as described by Dr. Albert who has interviewed her for purposes of making his enclosed Statement/Declaration. The breakdown of Ms. Foreman caused her to fail in her office duties which included notifying the patentee of the need to pay maintenance fees, obtaining the client's authorization to make such payments and then proceeding to send such payments to the U.S. Patent & Trademark Office in a timely manner. Only in the past few weeks has her strange and unexpected behavior come to light.

Ms. Foreman has been a loyal and reliable employee of Tachner's office for more than thirty-two years. She did not exhibit any form of overt personality characteristics or behavior which would have led Mr. Tachner to anticipate that she would not have fulfilled her normal office duties as she had done for more than three decades. Based upon Dr. Albert's interview and diagnosis of Ms. Foreman, it is only now understood that she was overworked and stressed beyond her limit (see Dr. Albert's Statement/Declaration) but that she was "programmed" to hide her predicament for fear of losing her position. Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justify a granting of this petition and such is respectfully solicited.

(Please attach additional sheets if additional space is needed)

[Page 4 of 4]

RECEIVED

JAN 12 2011

I, Leonard Tachner, do hereby declare as follows: OFFICE OF PETITIONS

**A. INTRODUCTION**

1. I am a member of the State Bar of California (1973) and admitted to practice before the U.S. Patent and Trademark Office (1971). I make this declaration in support of petition under Rule 1.378(b). This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

**B. BACKGROUND AND PROFESSIONAL EXPERIENCE**

2. I earned a Bachelor of Science degree in Electrical Engineering from City College of the State University of New York in 1965 and a Master of Science degree in Electrical Engineering from California State University at Long Beach in 1969. I received a Juris Doctor degree cum laude from Western State University in 1973.

3. I was admitted to practice before the United States Patent and Trademark Office as a patent agent since about December 1971 and I was assigned registration number 26,344. I was admitted to the State Bar of California in 1973. Over my entire career no disciplinary action has been taken against me by the United States Patent and Trademark Office, the State Bar of California or any other agency or administrative body.

4. I am admitted to practice before the U.S. Supreme Court, the Court of Appeals for the Federal Circuit, the Ninth Circuit Court of Appeals, all the U.S. District Courts of California and the Supreme Court of California.

5. I began my legal career in 1973 and have more than 35 years of private practice experience in intellectual property matters including patent, trademark, copyright and unfair competition. I began my own private practice as a patent attorney in March 1978, initially as a partner in a small firm and later as a sole practitioner in 1984.

6. I have prepared and prosecuted over 800 U.S. patent applications. In addition, I have been lead trial counsel in numerous U.S. District Court trials involving patent validity and infringement and served as a testifying patent law expert in federal district court litigation and arbitration proceedings.

7. I have an "Av" Martindale-Hubbell Peer Review rating.

**C. LAW PRACTICE MANAGEMENT**

8. I have two employees working full time as office staff. Janis Foreman is my office manager. Ms. Foreman was hired in June 1978 and has been continually employed by me since that time. In 1988 I hired Jodie Pyle as a typist. Jodie, now Mrs. Jodie Miller, has been continually employed by me since that time.

9. For at least the past twenty years, Ms. Foreman, as office manager, has been responsible for entering information into my patent and trademark docket and handling routine communications with clients and associates, all under my direction and supervision. In addition, Ms. Foreman does the bookkeeping for my office including billing and tracking our accounts receivable and accounts payable. She also prepares the final version of documents to be filed in the U.S. Patent and Trademark Office.

10. I have personally devoted uncountable hours to training and teaching Ms. Foreman over the past three decades. Over the last thirty two years of employment, she has become well-trained in every aspect of the administration of my practice. However, despite her acumen, we have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney. Her work is done under my supervision. She is not authorized to make any decision that could affect, diminish or be inimical in any way to a client's rights. Her actions in dealing with clients, the U.S. Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communications are to be reviewed by me.

11. I maintain a docketing system whereby Ms. Foreman receives all incoming correspondence and docketed relevant dates in our electronic docket. As each due date in the docket is responded to Ms. Foreman has the responsibility for noting when the due date was met.



12. I maintain supervisory authority of the docket. I routinely check the docket to keep aware of upcoming deadlines. I also regularly confer with Janis regarding matters coming up on the docket. Ms. Foreman also reviews the docket for upcoming due dates. Where appropriate, Ms. Foreman consults with me regarding matters entered into the docketing system.

13. When Ms. Foreman is either sick or on vacation or otherwise unavailable, Jodie fills in. Jodie's responsibilities include, typing drafts of patent applications and prosecution documents and preparing form letters to clients.

14. Over the years of her employment in my office, Ms. Foreman has been a loyal and devoted employee. Janis has normally handled her responsibilities in a professional and competent manner.

D. CHRONOLOGY OF EVENTS IN THIS MATTER

15. On or about Monday November 22, 2010 Ms. Foreman showed me a table of patent-related matters of Atomic Aquatics that she had prepared at the request of Mr. Dean Garraffa, one of that company's principals. Atomic Aquatics has been an important client of mine for about the past fifteen years and I have known its principals, Dean Garraffa and Doug Toth for more than twenty years.

16. I noticed that the table had a number of entries for Atomic Aquatics issued U.S. Patents which indicated that they had become abandoned for failure to pay maintenance fees between 2005 and 2008. She informed me that she believed that these abandonments were known to the client's principals and were the result of their lack of adequate funds or because the corresponding products had become obsolete. To the best of my knowledge, Ms. Foreman sent this table to Mr. Garraffa that day on Wednesday morning, November 24. On that same day I left Southern California for the four-day Thanksgiving weekend, arriving at my destination that evening. I checked my email and opened an email from Ms. Foreman stating that Mr. Garraffa had received the table and had called the office that day and expressed a desire to see me as soon as I returned from the Thanksgiving weekend.

17. When I returned to the office on Monday November 29, 2010, Mr. Garraffa was already waiting for me in the lobby talking to Ms. Foreman. He indicated a need to meet with me to speak to me about the contents of the table Ms. Foreman had sent to him. Mr. Garraffa then proceeded to explain that he and Mr. Toth were shocked to learn that several of their issued U.S. patents had apparently expired without their knowledge and that they needed to find out how it had happened and what could be done to remedy the situation. I told him that I would investigate the various files involved and report to him as soon as possible.

18. Over the ensuing two days I had discussions with Ms. Foreman and I examined a number of the Atomic Aquatics patent files. I also spoke to Mr. Garraffa about a provisional application that was supposed to be followed by a corresponding non-provisional but hadn't been.. In examining the file, I found various instructions I had prepared for Ms. Foreman including a set of claims for the non-provisional, but no evidence that Ms. Foreman had carried out my instructions or that a non-provisional had been prepared and filed. It became evident to me that Ms. Foreman had failed to do her work in regard to a number of Atomic Aquatics files including the file No. ATOMIC-1 (Patent No. 5,678,541) for which this petition is being filed.

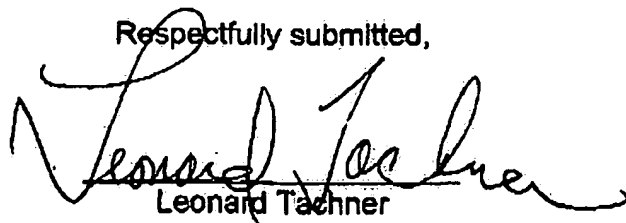
19. When I confronted her, she eventually admitted to me that she had lost control of her tasks, particularly over a several year period between 2005 and 2008 when she just couldn't keep up with the demands of the job and perform all of her duties in a timely manner. She revealed that she was too afraid and embarrassed to tell me about this behavior. I then reported to Mr. Garraffa and advised him that I would immediately begin preparation of petitions to revive the Atomic Aquatics patents that had been lost as a result of Ms. Foreman's shocking and totally unexpected behavior.

20. I arranged for Ms. Foreman to consult with a psychiatrist acquaintance so I could learn whether her problems were treatable and whether I could trust her work in the future. A Declaration Report of Dr. Samuel Albert is enclosed herewith.

21. Based upon Dr. Albert's Report and my own observations, I believe that Ms. Foreman, as a result of overwork and stress beyond her limit, experienced a lengthy period of irrational behavior. During this period she simply didn't carry out all of her usual responsibilities including communicating with clients and paying patent issue and maintenance fees including the following: file No. ATOMIC-1 for Patent No. 5,678,541 maintenance fees. Furthermore, Ms. Foreman was afraid to admit her inadequacies and endanger her position which had become such a predominant aspect of her life. Consequently, she did all she could to hide the problems until just recently.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Respectfully submitted,

  
Leonard Tachner

12/22/10

I, Janis Foreman, do hereby declare as follows:

**A. INTRODUCTION**

1. This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

**B. BACKGROUND AND PROFESSIONAL EXPERIENCE**

2. I am the office manager for attorney Leonard Tachner. I was hired in June 1978 and have been continually employed by Mr. Tachner since that time.

3. Over the past thirty two years, I have received an extensive amount of training and instruction from Mr. Tachner in all aspects of his practice. For the last approximately twenty years, I have been responsible for entering information into Mr. Tachner's patent and trademark docket. I handle routine communications with clients and associates, all under Mr. Tachner's direction and supervision. I also manage the bookkeeping, billing, and tracking of Mr. Tachner's accounts receivable and accounts payable. I prepare the final version of documents to be filed in the U.S. Patent and Trademark Office.

4. Our office procedures are clearly defined by Mr. Tachner. I receive all incoming correspondence and docket relevant dates in our electronic docket. As each due date in the docket is responded to, I am responsible for noting in the electronic docket when the due date was met.

5. Mr. Tachner maintains supervisory authority of the docket and routinely checks it for accuracy and upcoming deadlines. Mr. Tachner regularly confers with me regarding matters coming up on the docket. I review the docket daily for upcoming due dates and Mr. Tachner periodically reviews the docket for the same purpose. Where appropriate, I consult with Mr. Tachner regarding matters entered into the docketing system.

6. In connection with preparing this declaration, I have reviewed correspondence, emails and other documents relating to this matter. Though I cannot explain or justify many of my actions described below, I have set forth in this declaration my true recollection of the events.

C. CHRONOLOGY OF EVENTS IN THIS MATTER

7. On or about November 17, 2010, I received a phone call from Mr. Dean Garraffa of Atomic Aquatics. He asked me to prepare a tabular report showing the current status of all of their patent-related files in our office.

8. In response to Mr. Garraffa's request, I spent the following two days carefully examining all of the patent-related files of Atomic Aquatics. I found that there were a number of issued patents that had expired for non-payment of maintenance fees that had been due to be paid since as early as 2005. I also found a pending design patent application that had become abandoned for failure to pay an issue fee and a provisional application that had been allowed to lapse without filing a corresponding non-provisional.

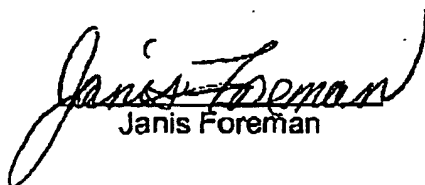
9. I actually filled out the tabular report to reflect the true status of all of the Atomic Aquatic files, but I could not fully understand why there appeared to be numerous problems associated with these files, particularly in regard to the past several years. My initial reaction was that the client had communicated authorization to withhold such payments and filings because of their financial problems or product obsolescence, but I could not find any documents or other evidence supporting these "feelings". In retrospect, I now realize that these were unsupported rationalizations that cover a period of several years during which I was functioning at less than my normal capabilities.

10. I don't know precisely what may have affected my mental performance during this period, but I do recall that I was under a great deal of pressure and stress due to my work load and that I was feeling continuously overwhelmed and unable to keep up. However, I was reluctant to tell Mr. Tachner of my concerns because I did not want to disappoint him after so many years.

11. Upon discussing this matter with Mr. Tachner and Dr. Samuel Albert, I now realize that it was a mistake to keep Mr. Tachner in the dark in regard to my sense of being overwhelmed and that I should have informed Mr. Tachner of my need for help. I also now realize the harm my actions have caused the client and Mr. Tachner. I am truly sorry.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dec 22, 2010

  
Janis Foreman

**CONFIDENTIAL**Statement of Samuel H. Albert, M.D.

I, Samuel H. Albert, M.D., am a practising Psychiatrist having an office in Fountain Valley, California. I have been a licensed physician in the State of California beginning July 1, 1969. I have been in practice as a Psychiatrist since October 1, 1972 and a board certified Psychiatrist since November 1978.

In late November 2010 I was asked to render professional consultation as a psychiatric expert for the purpose of diagnosing a Ms. Janis Foreman, who is a legal secretary and office manager for Attorney Leonard Tachner in Irvine, California.

I was presented with certain facts relating to Ms. Foreman's job role and apparent irrational behaviour over the past few years or so in regard to her performance of her duties at Mr. Tachner's office. As I understand these facts, Ms. Foreman has had for over thirty years working in the Tachner law firm, the responsibility for billing clients for professional services carried out by the Tachner firm, as well as communicating with vendors of outside services for the firm and its clients, and generally running the day to day activities of the firm according to established rules and instructions of Mr. Tachner.

Besides Ms. Foreman and Mr. Tachner, I am informed that there is another full time secretary who takes instruction directly from Ms. Foreman and that from time to time there are one or two additional part time employees who may be brought in to carry out certain maintenance-type activities such as library upkeep, filing, copying, mail preparation and the like.

As I understand their relationship, Mr. Tachner spends his time mostly doing legal work for the firm's clients and he depends heavily on Ms. Foreman to run the business aspects of the firm including billing, docketing, payroll and communicating with outside service providers. She also handles Mr. Tachner's document preparation and maintaining his files which are quite numerous. Clearly from what I've learned, the Tachner law firm is a very busy firm and Ms. Foreman has a heavy workload with many varied and important responsibilities.

I have had the opportunity to read Mr. Tachner's statement regarding Ms. Foreman's behaviour in relation to the client Atomic Aquatics. I have also read Ms. Foreman's statement pertaining to those matters. In addition, I have had a two hour interview with Ms. Foreman in which she participated voluntarily at the request of Mr. Tachner.

**CONFIDENTIAL**

I do not consider Ms. Janis Foreman to be a patient of mine at this time because I have been asked to consult in the capacity of an expert with the intent of communicating my diagnosis with the constraints of physician-patient privilege. I have made this special purpose of my participation in this matter clear to Ms. Foreman and she has acknowledged that she understands that she is not my patient and that I am not her physician.

Based upon these facts communicated to me, my reading of the Tachner and Foreman statements and my interview with Ms. Foreman, I have formed a preliminary medical opinion as follows:

Ms. Foreman's irrational behaviour is a result of her reaction to a temporary but continually increased work overload which became more than she could handle without any apparent way to vent the frustration, the worry and concern that's she increasingly felt as she fell behind in her work.

She correctly regards her most significant responsibility as control of cash flow by timely billing of clients and payments to vendors. In the period from early 2005 to the end of 2007, she evidently became so busy that's she lost the ability to bill clients in a timely manner and pay the firm's obligations when they were due.

She began feeling a sense of guilt for not being able to properly handle these responsibilities. She did not want to inform Mr. Tachner of these problems because she did not want to have her position diminished or lose any esteem in the eyes of her boss. She had no one else to tell of these difficulties and therefore no way to share these problems. After almost 30 years of being so capable and trustworthy, she could not bring herself to admit any inability to handle her responsibilities. She worried about her job, she worried about what Mr. Tachner would think of her, she spent more time concerned with her problems then with solving her problems.

This type of destabilizing behaviour resulted in a spiralling down in her ability to think and act rationally. She began to do and say unreasonable and unrealistic things. She lost any sense of reality. She lost her sense of proportionality. Her goal became one of maintaining a sense of continuity and stability for Mr. Tachner even by misleading him and making false statements to him and to others. Ms. Foreman was suffering from an acute psychotic breakdown brought on by rising pressures at her most important environment, her workplace where she had succeeded for decades.



**CONFIDENTIAL**

If Ms. Foreman were my patient I would propose that she undergo a program of therapy designed to give her a better sense of balance to handle such occasions of high levels of work pressure in a more motive and stable manner. I would prescribe an anti-depressant medication to address her symptoms of depression. Such medications include Prozac, Paxil, Zoloft, Lexapro, Wellbutrin and others. I would prescribe an anti-anxiety medication to address her symptoms of anxiety. Such medications include Librium, Ativan, Klonopin, Tranxene and others.

I would suggest to her that she should help her employer adjust her office responsibilities to reduce her work load if possible. I believe that Ms. Foreman's illness is amenable to treatment.

I declare under penalty of perjury that the foregoing is true and correct.  
Executed this 13 day of December 2010 at Fountain Valley, California.

By: Samuel H Albert MD  
Samuel H. Albert, M.D.

# CONFIDENTIAL

The following information is appended so as to provide medical basis and reasoning for my conclusion:

## Assigned Duties and Work Load of Ms. Foreman:

Ms. Janis Foreman is a Caucasian female age 61, born 4-26-1949. She has been an employee since June 19, 1978 of Leonard Tachner, Esq. Ms. Foreman is the office manager.

Ms. Foreman states that she is a Legal Secretary and is the Manager of the office where she works. She describes her assigned duties as numerous, detailed and often overwhelming.

She states, "I have a giant case load. I do many jobs." Among the long list of tasks for which she is responsible, she mentioned the following:

## TASKS RELATED TO THE LEGAL WORK OF THE OFFICE:

1. Managing the foreign filing of patent information,
2. Managing the United States filing of patent information,
3. File patent application in the United States,
4. File world-wide trademarks, a cumbersome process,
5. File United States trademark applications,
6. Obtain required documents from the client and the United States Patent Office,
7. Obtains a United States copy of certified documents,
8. Prepares and files Assignment documents in the United States and Worldwide,
9. She does docketing of all the documents that enter the office,
10. She sends out form letters,
11. Prepares and obtains Power of Attorneys from companies,
12. She types all amendments and applications,
13. She files copyrights,
14. She does filing, pulling and replacing files,
15. She does drawing corrections and declarations. "I'll get the draftsman to come in and do new drawings".
16. Oversee preparation of photocopying (me or Jodie),
17. She does work related to the international Patent Cooperation Treaty (PCT). She does work related to the PCT, an international treaty involving nations that have signed the PCT agreement with the U.S.A.,
18. Letters take a great deal of time and each letter has to be placed in the file appropriate to the letter,
19. From the parent case there are often several other cases that come from the parent case, each having its own number,
20. Oversight of the office docketing system,

**CONFIDENTIAL**

21. Typing of drafts of patent applications and prosecution documents.

TIME PRESSURES often become extreme due to the following factors

1. Everything received by the office has a deadline of 30, 60 or 90 days,
2. Often the inventor works for a company and then leaves the company.

OVERWORK of Ms. Foreman can be ascertained by examining these factors:

The quantity of documents is massive.

Locate a misplaced document might take several hours or days.

Ms. Foreman often works 2 or 3 nights extra each week to 7-10 PM depending on what is going on in the office.

#### ASSIGNED OFFICE TASKS NOT RELATED TO THE LEGAL WORK

1. Ms. Foreman does the billing of clients for the office, and the bill paying. The attorney in the office signs the checks.
2. Pays bills.
3. Bills clients.
4. Bill clients for costs.
5. "I am responsible to obtain supplies for the office; I order or buy supplies at Sam's Warehouse or Costco stores or stationary stores including soft drinks and bulk paper".
6. She cleans the office on the weekends.

HELP AND ASSISTANCE ARE PRAOVIDED BY ADDITIONAL EMPLOYEES IN THE OFFICE, TO A LIMITED DEGREE.

The Secretary (Jodie) does help a bit.

# CONFIDENTIAL

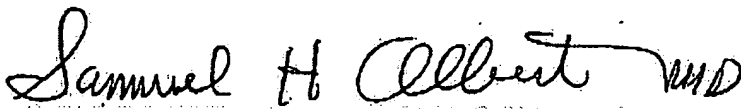
**Current psychiatric mental status evaluation:**

Caucasian Female appearing her stated age. Judgement intact for basic activities of daily life, but is revealed to be quite weak during the time of the events starting in early 2005. She did think in a way that can only be described as psychotic at the time. She made extremely poor decisions, thought in unusual manners, believed events to be true that were in fact false, and acted upon these convictions rather than logic or the usual standing orders of her employer.

Her mood is one of anxiety with an undercurrent of depression. Her daily life is usually non-eventful. She spends most of our evaluation session talking about the events which occurred while she was employed by the law firm of Leonard Tachner. She has many recollections of the events. Speech is grammatical most of the time. No stutter, stammer or lisp. Dress is casual, with cotton-wash pants and a nondescript shirt. No jewelry other than an inexpensive wristwatch. No symptoms to indicate disorientation, hallucinations, illusions, delusions, true phobias, obsessive thinking, compulsive or stereotypic movement inappropriate affect. Affect is congruent to speech and thought and is appropriate mood. Psychological understanding and insight is absent.

**Diagnosis:** Major Depression, severe, with psychotic episodes.  
Generalized Anxiety Disorder

Very truly yours,

  
Samuel H. Albert, M.D.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

P75M

LEONARD TACHNER  
SUITE 295  
3990 WESTERLY PLACE  
NEWPORT BEACH CA 92660

DATE PRINTED

11/23/05

**NOTICE OF PATENT EXPIRATION**

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). **THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD.** 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, you may call the USPTO Contact Center at 800-786-9199 or 703-308-4357.

	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
PATENT NUMBER					
578541	08616223	10/21/97	03/15/96	10/21/05	



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

LEONARD TACHNER  
SUITE 295  
3990 WESTERLY PLACE  
NEWPORT BEACH CA 92660

P75M

DATE PRINTED

11/27/01

## NOTICE OF PATENT EXPIRATION

According to the records of the Patent and Trademark Office, payment of the maintenance fee for the patents listed below has not been timely received prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b).

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(m) are paid, AND THE DELAY IN PAYMENT OF THE MAINTENANCE FEE IS SHOWN TO THE SATISFACTION OF THE COMMISSIONER TO HAVE BEEN UNAVOIDABLE. 35 U.S.C. 41(c)(1).

IF THE COMMISSIONER ACCEPTS PAYMENT OF THE MAINTENANCE FEE UPON PETITION, THE PATENT SHALL BE CONSIDERED AS NOT HAVING EXPIRED, BUT WOULD BE SUBJECT TO THE INTERVENING RIGHTS AND CONDITIONS SET FORTH IN 35 U.S.C. 41(c)(2).

NOTICE OF THE EXPIRATION WILL BE PUBLISHED IN THE OFFICIAL GAZETTE.

PATENT NUMBER	U.S. SERIAL NUMBER	PATENT DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
5678541	08616223	10/21/97	03/15/96	10/21/01	



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

Paper No. 6

BENOIT CASTEL  
745 SOUTH 23RD STREET  
ARLINGTON, VA 22202

**COPY MAILED**

**AUG 8 2001**

In re Patent No. 5,678,541  
Issue Date: October 21, 1997  
Application No. 08/616,223  
Filed: March 15, 1996  
Attorney Docket No. ATOMIC-1

OFFICE OF PETITIONS  
A/C PATENTS

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Files Repository.

*Wan Laymon*

Wan Laymon  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

# Petitioner's Exhibit W

Post-Issuance History in  
Pat. No. 5,803,073  
“Atomic-2”

Exhibit W



Organization \_\_\_\_\_ Bldg./Room \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

P.O. Box 1450

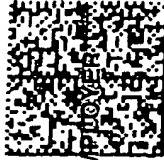
Alexandria, VA. 22313-1450

If Undeliverable Return In Ten Days

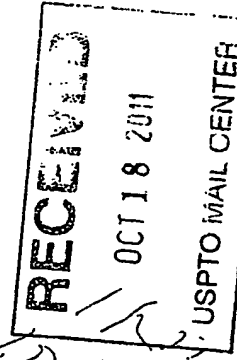
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Penalty For Private Use, \$300

AN EQUAL OPPORTUNITY EMPLOYMENT ACT



\$ 00.44<sup>0</sup>  
MAILED FROM ZIP CODE 22314



NIXIE

917 DE 1 00-10/13/11

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BC: 22313145050 \*1500-01356-13-35

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United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

LEONARD TACHNER  
SUITE 295  
3990 WESTERLY PLACE  
NEWPORT BEACH CA 92660

MAILED

OCT 06 2011

OFFICE OF PETITIONS

In re Patent No. 5,803,073  
Issue Date: September 8, 1998  
Application No. 08/613,070  
Filed: March 8, 1996  
Atty. Dkt. No. ATOMIC-2

: REQUEST FOR INFORMATION  
:  
:  
:

This letter is in response to the petition under 37 CFR 1.378(e), filed April 18, 2011. The required petition fee of \$400.00 has been charged to the authorized deposit account.

By Petitioner's own admission, the Tachner firm, or persons employed by that firm, have not been truthful with the USPTO. Furthermore, there is a specter of bias in the declaration of Dr. Albert since, at the time of his diagnosis, he was not Janis Foreman's doctor and he was paid to provide his opinion by Mr. Tachner. The record fails to include any evidence corroborating Dr. Albert's diagnosis. Given the circumstances of this case, corroborating evidence for Dr. Albert's diagnosis is required.

It is extremely odd that the people that were closest to Ms. Foreman did not notice that, as stated by Dr. Albert, she exhibited "destabilizing behavior" or that "she lost her sense of reality" or "lost her sense of proportionality." Further, as stated in Mr. Tachner's declaration, it appears that for about two years, Ms. Foreman was failing to bill clients or pay firm obligations even though the performance of these tasks appears to have been her primary duty. Therefore, it is not clear from the record how Mr. Tachner could have failed to recognize Ms. Foreman was failing to properly bill clients and pay firm obligations.

In response to the instant request for information, Petitioner is required to provide a rebuttal to all the assertions set forth in the petition filed July 21, 2010 in U.S. Patent No. 6,205,885.<sup>1</sup> Furthermore, Petitioner must explain why the current explanation provided in this case is any more believable than other explanations previously provided. Petitioner is required to provide corroborating evidence of Ms. Foreman's condition from a source that is independent of Dr. Albert. Additionally, Petitioner must fully discuss how the actions of Ms. Foreman, with regard to the docket, went undetected from early 2005 until January 2011. Further, Petitioner must explain how Ms. Foreman's failure to bill clients and pay firm obligations went undetected from early 2005 until the end of 2007.

Petitioner must submit the requested information within TWO MONTHS of the mailing date of this letter. Extensions of time may not be obtained. No additional fee is due for a response to the instant

<sup>1</sup> A copy of the petition can be accessed using the Office's Public Patent Application Information Retrieval system located at <http://portal.uspto.gov/external/portal/pair>.

request for information. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Mail Stop PETITIONS  
                              Commissioner for Patents  
                              Post Office Box 1450  
                              Alexandria, VA 22313-1450

By hand:                   Customer Service Window  
                              Mail Stop Petitions  
                              Randolph Building  
                              401 Dulany Street  
                              Alexandria, VA 22314

By fax:                   (571) 273-8300  
                              ATTN: Office of Petitions

Any questions concerning this matter may be directed to Attorney Advisor Alesia M. Brown at (571) 272-3205.



Anthony Knight  
Director  
Office of Petitions



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

LEONARD TACHNER  
SUITE 295  
3990 WESTERLY PLACE  
NEWPORT BEACH CA 92660

**MAILED**  
**OCT 06 2011**  
**OFFICE OF PETITIONS**

In re Patent No. 5,803,073 :  
Issue Date: September 8, 1998 : REQUEST FOR INFORMATION  
Application No. 08/613,070 :  
Filed: March 8, 1996 :  
Atty. Dkt. No. ATOMIC-2 :

This letter is in response to the petition under 37 CFR 1.378(e), filed April 18, 2011. The required petition fee of \$400.00 has been charged to the authorized deposit account.

By Petitioner's own admission, the Tachner firm, or persons employed by that firm, have not been truthful with the USPTO. Furthermore, there is a specter of bias in the declaration of Dr. Albert since, at the time of his diagnosis, he was not Janis Foreman's doctor and he was paid to provide his opinion by Mr. Tachner. The record fails to include any evidence corroborating Dr. Albert's diagnosis. Given the circumstances of this case, corroborating evidence for Dr. Albert's diagnosis is required.

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                                    Commissioner for Patents  
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                                    Alexandria, VA 22313-1450

By hand:                     Customer Service Window  
                                    Mail Stop Petitions  
                                    Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

By fax:                        (571) 273-8300  
                                    ATTN: Office of Petitions

Any questions concerning this matter may be directed to Attorney Advisor Alesia M. Brown at (571) 272-3205.



Anthony Knight  
Director  
Office of Petitions

**RECEIVED  
CENTRAL FAX CENTER****APR 22 2011**Attorney Docket No.: **ATOMIC-10****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 6,463,640 )  
Issued: October 15, 2002 )  
For: STRAP CONNECTING BUCKLE )

USPTO  
RECEIPTS ACCOUNTING  
DIVISION  
2011 APR 28 PM 4:29

**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENT****MAIL STOP: PETITIONS**

Attn: Christine Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

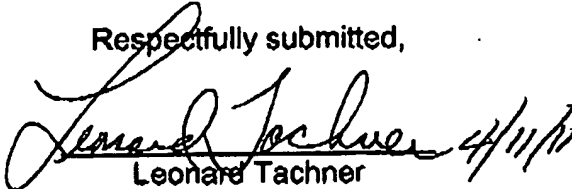
Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justifies reconsideration and granting of the pending petition and such is respectfully solicited.

6,463,640

A fee of \$1,640.00 (for the second annuity \$1,240.00 and \$400.00 for the requested reconsideration) should be deducted from Deposit Account No. 06-0930.

Respectfully submitted,

  
Leonard Tachner

Attachments:

1. Additional Declaration of Leonard Tachner (3 pages)
2. Declaration of Samuel H. Albert, M.D. (2 pages)
3. Additional Declaration of Janis Foreman (3 pages)

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CENTRAL FAX CENTER

APR 22 2011

LEONARD TACHNER  
A PROFESSIONAL LAW CORPORATION  
REGISTERED PATENT ATTORNEY  
17961 SKY PARK CIRCLE  
SUITE 38-E  
IRVINE, CALIFORNIA 92614-6364

PATENTS  
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COPYRIGHTS

TEL: (949) 752-8525  
FAX: (949) 955-2415

2011 APR 28 PM 4:29

USPTO  
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APR 28 2011**PLEASE DELIVER THE FOLLOWING MATERIAL AS SOON AS POSSIBLE**TO: Christina Tartera Donnell, Senior Petitions AttorneyFROM: Leonard TachnerNUMBER OF PAGES: 6 (INCLUDING THIS COVER PAGE)DATE SENT: 4-22-11 TIME SENT: 11 AMRE: 5,803,073 and 6,463,640 (CLIENT AND/OR DOCKET NO.)PLEASE NOTIFY OPERATOR IMMEDIATELY IF THE ABOVE IS NOT RECEIVED PROPERLY AT (949) 752-8525

UNLESS OTHERWISE INDICATED OR OBVIOUS FROM THE NATURE OF THE TRANSMITTAL, THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS ATTORNEY/CLIENT PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR EMPLOYEE, OR AGENT RESPONSIBLE TO DELIVER IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR OR ARE NOT SURE WHETHER IT IS PRIVILEGED, PLEASE IMMEDIATELY NOTIFY US BY COLLECT TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA THE U.S. POSTAL SERVICE AT OUR EXPENSE. THANK YOU.

Dear Ms. Donnell: We recently filed Requests For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patents by delayed acceptance of previously unpaid maintenance fees. (see copy of transmittal letter for each case attached). The transmittal letters requested the fees be deducted from our Deposit Account 06-0930. We have noticed that an extra \$1,240.00 in fees was charged for 6,463,640 on April 14. That overcharge resulted in a deficiency on April 19 when the fees needed for 5,803,073 were deducted from our Deposit Account. Please can you correct the overcharge for Patent 6,463,640 of \$1,240.00 and deduct the remaining fees for Patent No. 5,803,073 of \$2,055.00 from our Deposit Account. We are enclosing a copy of our Deposit Account statement for April 2011. Thank you for your assistance.



**RECEIVED**  
**CENTRAL FAX CENTER**  
**APR 22 2011**  
0005

08/613,070

Attorney Docket No.: **ATOMIC-2****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 5,803,073 )  
Issued: September 8, 1998 )  
For: AN IMPROVED SECOND STAGE )  
SCUBA DIVING REGULATOR )  
HAVING A PNEUMATIC DEPENDENT )  
ANTI-SET FEATURE )

2011 APR 28 PM 4:29

USPTO  
PATENT ACCOUNTING  
DIVISION**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENT****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justifies

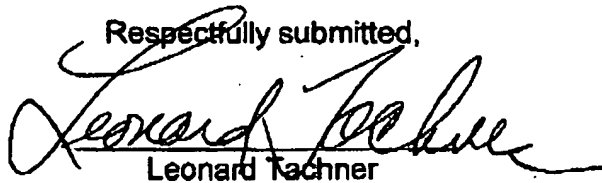
5,803,073

reconsideration and granting of the pending petition and such is respectfully solicited.

A fee of \$4,355.00 (for the second annuity \$1,240.00; third annuity \$2,055.00; Original Petition Fee \$700.00; and \$400.00 for the requested reconsideration) should be deducted from Deposit Account No. 06-0930.

Respectfully submitted,

4-15-11

  
Leonard Tachner

Attachments:

1. Additional Declaration of Leonard Tachner (3 pages)
2. Declaration of Samuel H. Albert, M.D. (2 pages)
3. Additional Declaration of Janis Foreman (3 pages)

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APR 22 2011

Attorney Docket No.: ATOMIC-2

## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

Patentee: Douglas J. Toth )  
Patent No.: 5,803,073 )  
Issued: September 8, 1998 )  
For: AN IMPROVED SECOND STAGE )  
SCUBA DIVING REGULATOR )  
HAVING A PNEUMATIC DEPENDENT )  
ANTI-SET FEATURE )

COPY FOR YOUR  
INFORMATION**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENT****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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~~5~~ 5,803,073

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**CENTRAL FAX CENTER**

**APR 15 2011**

Attorney Docket No.: **ATOMIC-2**

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
 Patent No.: 5,803,073 )  
 Issued: September 8, 1998 )  
 For: AN IMPROVED SECOND STAGE )  
 SCUBA DIVING REGULATOR )  
 HAVING A PNEUMATIC DEPENDENT )  
 ANTI-SET FEATURE )

2011 APR 18 PM 4:20  
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**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
 PETITION TO REVIVE A PATENT**

**MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
 Senior Petitions Attorney  
 Commissioner for Patents  
 U.S. Patent & Trademark Office  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

04/19/2011 DALLEN 00000000 060930 5803073  
 01 FC:1599 1940.00 DA  
 02 FC:1462 400.00 DA

Dear Sir:

Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

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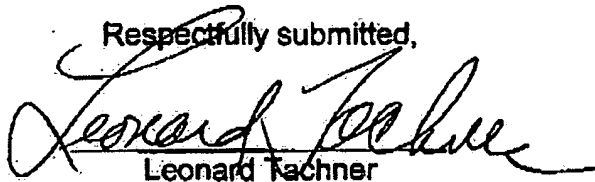
APR 15 2011

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4-15-11

  
Leonard Tachner

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**RECEIVED  
CENTRAL FAX CENTER****APR 15 2011**Attorney Docket No.: **ATOMIC-2****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 5,803,073 )  
Issued: September 8, 1998 )  
For: AN IMPROVED SECOND STAGE )  
SCUBA DIVING REGULATOR )  
HAVING A PNEUMATIC DEPENDENT )  
ANTI-SET FEATURE )

**ADDITIONAL DECLARATION OF LEONARD TACHNER****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Leonard Tachner, do hereby declare as follows:

1. I submit this declaration as an addition to my prior declaration submitted with the subject petition. This statement is part of the evidence I am filing in support of a request for reconsideration.

2. When Ms. Foreman told me in 2008 in regard to U.S. Patent No. 6, 205,885 that the client told her that they would pay their own maintenance fees, at first it didn't seem suspicious because the client usually wrote most or all of the specification of their patent applications in order to reduce their fees. They left the claims to me to write. Only when the client disputed Ms. Foreman's statement did I begin to wonder whether Ms. Foreman was mistaken. However, I

still accepted her assertion that she believed the client had made that statement because up to then (by 2008 she had worked for me for 30 years) I had no reason to doubt her reliability. Only in late 2010 when she asserted that other clients (ATOMIC and CSUF) had also taken on the responsibility to pay their own maintenance fees, did I realize that I could no longer trust her because there was evidently something seriously wrong with Ms. Foreman. That is when I decided that I needed to have her see Dr. Albert.

3. Over the 33 years that I have been in my own practice, I have filed applications that issued into roughly 600 U.S. patents for my clients. In a small number of these applications and patents, it has been necessary to file a petition to revive due to a delayed response to an Office Action, a late issue fee payment and occasionally a late maintenance fee. Some of these petitions were necessary because of failures of clients to communicate in a timely manner. Up to the recent events, a few such petitions were made necessary by innocent clerical errors of my staff. However, to the best of my recollection, every one of those petitions to revive an application or to accept a late maintenance fee filed by my firm, had ultimately been granted. It would be impossible for us to know the precise numbers of such petitions, because once resolved, we do not retain any data summarizing such events. Moreover, many of such files have since been transferred to other firms or otherwise disposed of.

4. I now better understand the specific behavior that was Ms. Foreman's issue with meeting office deadlines primarily for paying maintenance fees to the U.S. Patent & Trademark Office. She would entirely overlook a payment deadline. Then rather than inform me in a timely manner so that I could remedy the delay, she would "cover up" her omission by alleging that the corresponding client had told her in a phone call or face to face discussion that they would pay such fees themselves. By way of example, here enclosed is a copy of a docket sheet entry apparently made by Ms. Foreman for this particular patent, showing that the client would pay their own maintenance fee. Only when



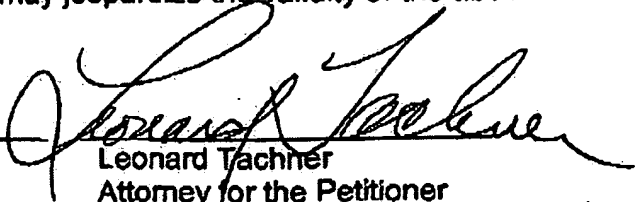
I began to see this type of entry more than once did I begin to understand that I had a serious problem.

5. I believe that the heavy workload I had assigned to Ms. Foreman over the past years has contributed to her aberrant behavior. However, I believe that her actions went beyond merely normal stress and anxiety. Based on my discussions with Dr. Albert, I now recognize that Ms. Foreman had for several years since as early as 2005 and as recently as four months ago, been ill and unable to cope with her responsibilities. I also believe that her illness was a direct cause of the firm's failure to act in a timely manner in behalf of the client in this matter.

6. I regard Ms. Foreman as more than just my employee. After more than three decades of a close working relationship, Ms. Foreman is more like a member of my family. I believe that is the reason that I did not recognize her problems earlier. She will continue to see Dr. Albert at my expense. In the meantime I will transfer time-based responsibilities from Ms. Foreman to another employee.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4-15-11

  
Leonard Tachner  
Attorney for the Petitioner  
Registration No. 26,344

**(714) 752-8525**

ISSUED

INVENTOR Douglas J. Toth  
SERIAL NO. 08/613,070 FILED March 8, 1996  
TITLE AN Improved Second Stage Scuba Diving  
Regulator Having A Pneumatic-Operant Anti-Set Feature

**ASSIGNEE**

**ASSIGNMENT RECORDED**

## BEER

**FRAME**

[illegible]

**ALLOWED**

**FINAL FEE PAID**

PATENT NO.

5,803.073

DATE \_\_\_\_\_

September 8, 1998

ISSUED

CLIENT or TITLE  
DIVISION OF  
CONTINUATION IN PART OF

**CANADIAN**

OTHER FOREIGN

**CLIENT or TITLE**

INVENTOR

**SERIAL NO**

**Samuel H. Albert, M.D., Inc.**  
**Diplomate**  
**American Board of Psychiatry & Neurology**

I, Dr. Samuel Albert, do hereby declare as follows:

1. This declaration supplements my prior statement submitted previously in regard to this matter.

2. Based upon my interviews with Ms. Janice P. Foreman, and Mr. Leonard Tachner, it is evident that her problems at her employment stemmed from a significant increase in her workload and responsibilities that occurred at about the beginning of 2002 when another law firm went out of business and several hundred files were transferred to the Tachner firm. Evidently, she was able to handle the sudden workload increase for a period of two to three years. However, beginning in late 2004, early 2005 she started falling behind and could no longer keep current.

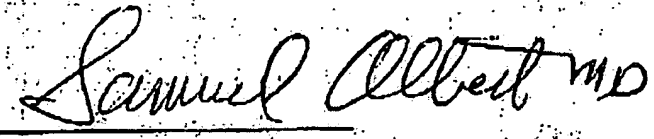
3. In retrospect she now realizes that within a few months thereafter she started a pattern of behavior which she now recognizes as irrational. Such behavior for example included making up false excuses for failing to take required actions such as contacting clients and responding to Mr. Tachner's questions with answers that may have had no factual basis, but which she believed would satisfy his inquiry. In my opinion, it was during this period beginning in mid-2005 when Ms. Foreman went through a transition from being merely over-worked and highly stressed to being clinically ill.

4. It appears that the extent of her illness varied depending upon her level of stress and anxiety, but that it didn't fully abate until the early months of 2011. The principal symptom of this illness was her inability to separate real events from imagined ones. From time to time during this period, she would let her behavior and her actions be dictated by what she perceived to have previously occurred as opposed to events that had actually taken place.

5. In my opinion therefore, between mid-2005 and late 2010, and based upon her prior reliable behavior in regard to her duties at the Tachner firm, Ms. Foreman's failure to take proper actions were due to a psychosis that

manifested in her inability to distinguish real events from imagined ones. This condition was of such a degree, that she could not function normally and if she were to be questioned or challenged in regard to her behavior, that would raise her stress level and exacerbate her condition. I have advised Mr. Tachner and Ms. Foreman that it would be my recommendation that Ms. Foreman enter treatment on a regular basis so that I can monitor her progress and be sure that there is no regression.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: April 11, 2011

Dr. Samuel Albert

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APR 15 2011

Attorney Docket No.: **ATOMIC-2****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 5,803,073 )  
Issued: September 8, 1998 )  
For: AN IMPROVED SECOND STAGE )  
SCUBA DIVING REGULATOR )  
HAVING A PNEUMATIC DEPENDENT )  
ANTI-SET FEATURE )

**ADDITIONAL DECLARATION OF JANIS FOREMAN****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Janis Foreman, do hereby declare as follows:

1. This declaration is a supplement to my prior declaration submitted in regard to a petition to accept an unavoidably delayed payment of the maintenance fee for the above-identified patent.

2. Over the past few months I have, as a result of discussions with and medical treatment from Dr. Samuel Albert, begun to understand that over the last five or six years I have been ill and unable to function normally and rationally in my employment as Office Manager at the Tachner Law Firm. My mindset was more attuned to survival than to properly carrying out my duties.

3. In regard to the subject patent in particular, my duty was to communicate in a timely manner with the client who is the patentee of the subject patent, to ascertain whether that client wished to have our firm pay the maintenance fee that was required in order to retain the patent. Normally, I would have sent a letter or an email to the client about 45 days before the due date for payment of the maintenance fee. Then, if I receive a positive response, I would have prepared and mailed or emailed a statement to the client so that payment from the client would be received in time to forward the payment to the U.S. Patent & Trademark Office before the due date.

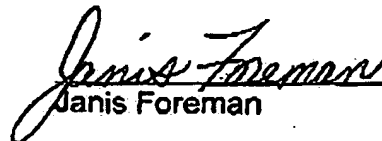
4. It is my current recollection that what I did instead was to recognize that a maintenance fee was coming due for this patent, but continually put it off as something that I could attend to in due course, since I had more urgent things to do before I could get to that matter. Then I would rationalize that I could rely on a six-month surcharge period if needed and continue to put off communicating with the client. Eventually, I ran out of time, but it would occur to me that this client had wanted to pay its own maintenance fees and I would simply make such an entry in the corresponding docket sheet.

5. There was no logic or rational explanation for my behavior. I simply felt hopelessly overwhelmed and this was a way for me to handle it. I had no animosity toward the client or toward the law firm. It was just my way of coping with what I perceived to be an impossible situation without admitting to Mr. Tachner that I could no longer handle all of my usual responsibilities.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or

both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4-15-11

  
Janis Foreman



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

**MAILED**  
**FEB 15 2011**  
**OFFICE OF PETITIONS**

In re Patent No. 5,803,073	:	
Issue Date: September 8, 1998	:	DECISION ON PETITION
Application No. 08/613,070	:	
Filed: March 8, 1996	:	
Attorney Docket No. ATOMIC-2	:	

This is a decision in response to the petition under 37 CFR 1.378(b), filed December 22, 2010, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The patent issued on September 8, 1998. The maintenance fee could have been paid during the period from September 8, 2005 through March 8, 2006, or with a surcharge during the period from March 9, 2006 through September 8, 2006. Accordingly, this patent expired on September 9, 2006, for failure to timely remit the maintenance fee.

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The present petition lacks items (1), (2) and (3).



The USPTO finance record reveals that the Deposit Account contains insufficient funds to charge the \$1,240.00 maintenance fee due at 7.5 years, the \$2,055.00 maintenance fee due at 11.5 years, and the \$700.00 surcharge after expiration. The Office notes that the maintenance fees, as well as the required surcharge, must be paid as a condition for accepting the late maintenance fee on petition.

In view of the above, the Office is unable to treat the present petition on the merits until petitioner submits a new petition under 37 CFR 1.378(b), the payment for the surcharge after expiration (currently \$700.00), the maintenance fees due at 7.5 and 11.5 years, as well as documentary evidence in support of a showing of unavoidable delay. Thus, the petition is dismissed. The Office reminds petitioner that the fees must be paid in the amount due on the date the new petition is filed.

Although the Office will not address the petition on its merits, the Office reminds petitioner that 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).

That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd,

143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987).

In the present petition, petitioner asserted that over a protracted period beginning in 2005, counsel's office manager, Ms. Foreman, experienced a medical condition that caused her to fail in her office duties which included notifying the patentee of the need to pay the maintenance fees, obtaining the client's authorization to pay the maintenance fee, and proceeding to send the payment to the USPTO. In support of the petition, petitioners provided a statement from patent practitioner Leonard Tachner, office manager Ms. Foreman, and Dr. Samuel A. Albert.

To establish a showing of "unavoidable" delay based upon medical incapacitation, petitioner must demonstrate that the incapacitation was of such a nature and degree as to render the person unable to conduct business (e.g., correspond with the USPTO) during the period when the maintenance fee was due. Such a showing must be supported by a statement(s) from the person's treating physician(s), and such statement(s) must provide the nature and degree of the person's medical condition during the period from when the maintenance was due until the filing of a grantable petition. Namely, petitioner should provide the USPTO with a statement from a treating physician, asserting that from the time the maintenance fee was due until the filing of a grantable petition, the person's medical condition was of such a degree of severity that it prevented her from timely paying the maintenance fee. Additionally, the treating physician must describe the person's medical condition, the degree of incapacitation, and the duration of the medical illness. Lastly, petitioner should submit evidence to show that "but for" the person's medical condition, the maintenance fee would have been timely paid. Without a thorough

explanation or documentary evidence, the Office is left to speculate as to the circumstances that transpired.

The Office cautions petitioner to remove or mark through any personal information in any document submitted to the USPTO that could contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioner should consider deleting such personal information from the documents before submitting them to the USPTO. Petitioner is advised that the patent file is available to the public after the issuance of a patent. However, checks and credit card authorization forms (PTO-2038) submitted for payment purposes are not retained in the application file, and therefore, are not publicly available.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                    Mail Stop Petition  
                              Commissioner for Patents  
                              P.O. Box 1450  
                              Alexandria, VA 22313-1450

By FAX:                    (571) 273-8300  
                              Attn: Office of Petitions

By hand:                   Customer Services Window  
                              Randolph Building  
                              401 Dulany Street  
                              Alexandria, VA 22314

Correspondence may also be submitted electronically via EFS-Web.

The patent file is being returned to Files Repository.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.



Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

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DEC 22 2010

JAN 12 2011

OFFICE OF PETITIONS

18 pages

PTO/SB/85 (03-09)

Approved for use through 03/31/2012. OMB 0851-0018

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))

Docket Number (Optional)  
ATOMIC-2

Mail to: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450  
Fax: (571) 273-8300

01/11/2011 DALLEN 00000019 060930 5 03073

01 FC:1599 1940.00 DA

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

Patent Number: 5,803,073

Application Number: 08/613,070

Issue Date: September 8, 1998

Filing Date: March 8, 1996

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

☐ Is a reissue of original Patent No. \_\_\_\_\_ original issue date \_\_\_\_\_  
original application number \_\_\_\_\_  
original filing date \_\_\_\_\_

☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application  
\_\_\_\_\_ filed on \_\_\_\_\_

## CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

12/22/10  
Date

*Leonard Tachner*  
Signature

LEONARD TACHNER

Typed or printed name of person signing Certificate

[Page 1 of 4]

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

DEC 22 2010

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0551-0016

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 1. SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

## 2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

## 3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$	3 ½ yr fee	(1551)	<input type="checkbox"/> \$	3 ½ yr fee	(2551)
<input type="checkbox"/> \$	7 ½ yr fee	(1552)	<input checked="" type="checkbox"/> \$ 1240	7 ½ yr fee	(2552)
<input type="checkbox"/> \$	11 ½ yr fee	(1553)	<input checked="" type="checkbox"/> \$ 2055	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ 3295

## 4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ 700

## 5. MANNER OF PAYMENT

- ☐ Enclosed is a check for the sum of \$ \_\_\_\_\_
- ☒ Please charge Deposit Account No. 06-0930 the sum of \$ 3995
- ☐ Payment by credit card. Form PTO-2038 is attached.

## 6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

- ☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 06-0930

[Page 2 of 4]

DEC 22 2010

PTO/SB/85 (03-09)

Approved for use through 03/31/2012. OMB 0851-0018

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 7. OVERPAYMENT

As to any overpayment made, please

☒ Credit to Deposit Account No. 06-0930

OR

☐ Send refund check


## WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

## 8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

## 9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

  
Signature(s) of Petitioner(s)12/22/10  
Date

LEONARD TACHNER

Typed or printed name(s)

26,344

Registration Number, if applicable

17961 SKY PARK CIRCLE, SUITE 38-E

Address

949-752-8525

Telephone Number

IRVINE, CALIFORNIA 92614

Address

## ENCLOSURES:

- ☒ Maintenance Fee Payment  
☒ Statement why maintenance fee was not paid timely  
☒ Surcharge under 37 CFR 1.20(I)(1) (fee for filing the maintenance fee petition)  
☐ Other:

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0851-0016

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

  
Signature12/22/10  
DateLEONARD TACHNER

Type or printed name

26,344

Registration Number, if applicable

STATEMENT

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

This petition is supported by declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and a physician, Dr. Samuel A. Albert who is a board certified psychiatrist.

The declaration evidence shows that over a protracted period beginning in 2005 Ms. Foreman experienced a psychological breakdown or psychotic episode as described by Dr. Albert who has interviewed her for purposes of making his enclosed Statement/Declaration. The breakdown of Ms. Foreman caused her to fail in her office duties which included notifying the patentee of the need to pay maintenance fees, obtaining the client's authorization to make such payments and then proceeding to send such payments to the U.S. Patent & Trademark Office in a timely manner. Only in the past few weeks has her strange and unexpected behavior come to light.

Ms. Foreman has been a loyal and reliable employee of Tachner's office for more than thirty-two years. She did not exhibit any form of overt personality characteristics or behavior which would have led Mr. Tachner to anticipate that she would not have fulfilled her normal office duties as she had done for more than three decades. Based upon Dr. Albert's interview and diagnosis of Ms. Foreman, it is only now understood that she was overworked and stressed beyond her limit (see Dr. Albert's Statement/Declaration) but that she was "programmed" to hide her predicament for fear of losing her position.

Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justify a granting of this petition and such is respectfully solicited.

(Please attach additional sheets if additional space is needed)

[Page 4 of 4]

I, Leonard Tachner, do hereby declare as follows:

**A. INTRODUCTION**

1. I am a member of the State Bar of California (1973) and admitted to practice before the U.S. Patent and Trademark Office (1971). I make this declaration in support of petition under Rule 1.378(b). This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

**B. BACKGROUND AND PROFESSIONAL EXPERIENCE**

2. I earned a Bachelor of Science degree in Electrical Engineering from City College of the State University of New York in 1965 and a Master of Science degree in Electrical Engineering from California State University at Long Beach in 1969. I received a Juris Doctor degree cum laude from Western State University in 1973.

3. I was admitted to practice before the United States Patent and Trademark Office as a patent agent since about December 1971 and I was assigned registration number 26,344. I was admitted to the State Bar of California in 1973. Over my entire career no disciplinary action has been taken against me by the United States Patent and Trademark Office, the State Bar of California or any other agency or administrative body.

4. I am admitted to practice before the U.S. Supreme Court, the Court of Appeals for the Federal Circuit, the Ninth Circuit Court of Appeals, all the U.S. District Courts of California and the Supreme Court of California.

5. I began my legal career in 1973 and have more than 35 years of private practice experience in intellectual property matters including patent, trademark, copyright and unfair competition. I began my own private practice as a patent attorney in March 1978, initially as a partner in a small firm and later as a sole practitioner in 1984.

6. I have prepared and prosecuted over 800 U.S. patent applications. In addition, I have been lead trial counsel in numerous U.S. District Court trials involving patent validity and infringement and served as a testifying patent law expert in federal district court litigation and arbitration proceedings.



7. I have an "Av" Martindale-Hubbell Peer Review rating.

C. LAW PRACTICE MANAGEMENT

8. I have two employees working full time as office staff. Janis Foreman is my office manager. Ms. Foreman was hired in June 1978 and has been continually employed by me since that time. In 1988 I hired Jodie Pyle as a typist. Jodie, now Mrs. Jodie Miller, has been continually employed by me since that time.

9. For at least the past twenty years, Ms. Foreman, as office manager, has been responsible for entering information into my patent and trademark docket and handling routine communications with clients and associates, all under my direction and supervision. In addition, Ms. Foreman does the bookkeeping for my office including billing and tracking our accounts receivable and accounts payable. She also prepares the final version of documents to be filed in the U.S. Patent and Trademark Office.

10. I have personally devoted uncountable hours to training and teaching Ms. Foreman over the past three decades. Over the last thirty two years of employment, she has become well-trained in every aspect of the administration of my practice. However, despite her acumen, we have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney. Her work is done under my supervision. She is not authorized to make any decision that could affect, diminish or be inimical in any way to a client's rights. Her actions in dealing with clients, the U.S. Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communications are to be reviewed by me.

11. I maintain a docketing system whereby Ms. Foreman receives all incoming correspondence and docketed relevant dates in our electronic docket. As each due date in the docket is responded to Ms. Foreman has the responsibility for noting when the due date was met.

12. I maintain supervisory authority of the docket. I routinely check the docket to keep aware of upcoming deadlines. I also regularly confer with Janis regarding matters coming up on the docket. Ms. Foreman also reviews the docket for upcoming due dates. Where appropriate, Ms. Foreman consults with me regarding matters entered into the docketing system.

13. When Ms. Foreman is either sick or on vacation or otherwise unavailable, Jodie fills in. Jodie's responsibilities include, typing drafts of patent applications and prosecution documents and preparing form letters to clients.

14. Over the years of her employment in my office, Ms. Foreman has been a loyal and devoted employee. Janis has normally handled her responsibilities in a professional and competent manner.

**D. CHRONOLOGY OF EVENTS IN THIS MATTER**

15. On or about Monday November 22, 2010 Ms. Foreman showed me a table of patent-related matters of Atomic Aquatics that she had prepared at the request of Mr. Dean Garraffa, one of that company's principals. Atomic Aquatics has been an important client of mine for about the past fifteen years and I have known its principals, Dean Garraffa and Doug Toth for more than twenty years.

16. I noticed that the table had a number of entries for Atomic Aquatics issued U.S. Patents which indicated that they had become abandoned for failure to pay maintenance fees between 2005 and 2008. She informed me that she believed that these abandonments were known to the client's principals and were the result of their lack of adequate funds or because the corresponding products had become obsolete. To the best of my knowledge, Ms. Foreman sent this table to Mr. Garraffa that day on Wednesday morning, November 24. On that same day I left Southern California for the four-day Thanksgiving weekend, arriving at my destination that evening. I checked my email and opened an email from Ms. Foreman stating that Mr. Garraffa had received the table and had called the office that day and expressed a desire to see me as soon as I returned from the Thanksgiving weekend.

17. When I returned to the office on Monday November 29, 2010, Mr. Garraffa was already waiting for me in the lobby talking to Ms. Foreman. He indicated a need to meet with me to speak to me about the contents of the table Ms. Foreman had sent to him. Mr. Garraffa then proceeded to explain that he and Mr. Toth were shocked to learn that several of their issued U.S. patents had apparently expired without their knowledge and that they needed to find out how it had happened and what could be done to remedy the situation. I told him that I would investigate the various files involved and report to him as soon as possible.

18. Over the ensuing two days I had discussions with Ms. Foreman and I examined a number of the Atomic Aquatics patent files. I also spoke to Mr. Garraffa about a provisional application that was supposed to be followed by a corresponding non-provisional but hadn't been. In examining the file, I found various instructions I had prepared for Ms. Foreman including a set of claims for the non-provisional, but no evidence that Ms. Foreman had carried out my instructions or that a non-provisional had been prepared and filed. It became evident to me that Ms. Foreman had failed to do her work in regard to a number of Atomic Aquatics files including the file No. ATOMIC-2 (Patent No. 5,803,073) for which this petition is being filed.

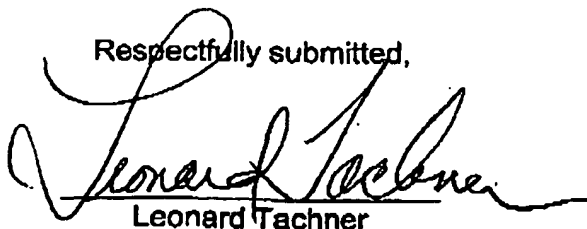
19. When I confronted her, she eventually admitted to me that she had lost control of her tasks, particularly over a several year period between 2005 and 2008 when she just couldn't keep up with the demands of the job and perform all of her duties in a timely manner. She revealed that she was too afraid and embarrassed to tell me about this behavior. I then reported to Mr. Garraffa and advised him that I would immediately begin preparation of petitions to revive the Atomic Aquatics patents that had been lost as a result of Ms. Foreman's shocking and totally unexpected behavior.

20. I arranged for Ms. Foreman to consult with a psychiatrist acquaintance so I could learn whether her problems were treatable and whether I could trust her work in the future. A Declaration Report of Dr. Samuel Albert is enclosed herewith.

21. Based upon Dr. Albert's Report and my own observations, I believe that Ms. Foreman, as a result of overwork and stress beyond her limit, experienced a lengthy period of irrational behavior. During this period she simply didn't carry out all of her usual responsibilities including communicating with clients and paying patent issue and maintenance fees including the following: file No. ATOMIC-2 for Patent No. 5,803,073 maintenance fees. Furthermore, Ms. Foreman was afraid to admit her inadequacies and endanger her position which had become such a predominant aspect of her life. Consequently, she did all she could to hide the problems until just recently.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Respectfully submitted,

  
Leonard Tachner

12/22/10

I, Janis Foreman, do hereby declare as follows:

**A. INTRODUCTION**

1. This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

**B. BACKGROUND AND PROFESSIONAL EXPERIENCE**

2. I am the office manager for attorney Leonard Tachner. I was hired in June 1978 and have been continually employed by Mr. Tachner since that time.

3. Over the past thirty two years, I have received an extensive amount of training and instruction from Mr. Tachner in all aspects of his practice. For the last approximately twenty years, I have been responsible for entering information into Mr. Tachner's patent and trademark docket. I handle routine communications with clients and associates, all under Mr. Tachner's direction and supervision. I also manage the bookkeeping, billing, and tracking of Mr. Tachner's accounts receivable and accounts payable. I prepare the final version of documents to be filed in the U.S. Patent and Trademark Office.

4. Our office procedures are clearly defined by Mr. Tachner. I receive all incoming correspondence and docket relevant dates in our electronic docket. As each due date in the docket is responded to, I am responsible for noting in the electronic docket when the due date was met.

5. Mr. Tachner maintains supervisory authority of the docket and routinely checks it for accuracy and upcoming deadlines. Mr. Tachner regularly confers with me regarding matters coming up on the docket. I review the docket daily for upcoming due dates and Mr. Tachner periodically reviews the docket for the same purpose. Where appropriate, I consult with Mr. Tachner regarding matters entered into the docketing system.

6. In connection with preparing this declaration, I have reviewed correspondence, emails and other documents relating to this matter. Though I cannot explain or justify many of my actions described below, I have set forth in this declaration my true recollection of the events.

**C. CHRONOLOGY OF EVENTS IN THIS MATTER**

7. On or about November 17, 2010, I received a phone call from Mr. Dean Garraffa of Atomic Aquatics. He asked me to prepare a tabular report showing the current status of all of their patent-related files in our office.

8. In response to Mr. Garraffa's request, I spent the following two days carefully examining all of the patent-related files of Atomic Aquatics. I found that there were a number of issued patents that had expired for non-payment of maintenance fees that had been due to be paid since as early as 2005. I also found a pending design patent application that had become abandoned for failure to pay an issue fee and a provisional application that had been allowed to lapse without filing a corresponding non-provisional.

9. I actually filled out the tabular report to reflect the true status of all of the Atomic Aquatic files, but I could not fully understand why there appeared to be numerous problems associated with these files, particularly in regard to the past several years. My initial reaction was that the client had communicated authorization to withhold such payments and filings because of their financial problems or product obsolescence, but I could not find any documents or other evidence supporting these "feelings". In retrospect, I now realize that these were unsupported rationalizations that cover a period of several years during which I was functioning at less than my normal capabilities.

10. I don't know precisely what may have affected my mental performance during this period, but I do recall that I was under a great deal of pressure and stress due to my work load and that I was feeling continuously overwhelmed and unable to keep up. However, I was reluctant to tell Mr. Tachner of my concerns because I did not want to disappoint him after so many years.

11. Upon discussing this matter with Mr. Tachner and Dr. Samuel Albert,, I now realize that it was a mistake to keep Mr. Tachner in the dark in regard to my sense of being overwhelmed and that I should have informed Mr. Tachner of my need for help. I also now realize the harm my actions have caused the client and Mr. Tachner. I am truly sorry.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

*Dec 22, 2010*

*Janis Foreman*  
Janis Foreman

**CONFIDENTIAL**Statement of Samuel H. Albert, M.D.

I, Samuel H. Albert, M.D., am a practising Psychiatrist having an office in Fountain Valley, California. I have been a licensed physician in the State of California beginning July 1, 1969. I have been in practice as a Psychiatrist since October 1, 1972 and a board certified Psychiatrist since November 1978.

In late November 2010 I was asked to render professional consultation as a psychiatric expert for the purpose of diagnosing a Ms. Janis Foreman, who is a legal secretary and office manager for Attorney Leonard Tachner in Irvine, California.

I was presented with certain facts relating to Ms. Foreman's job role and apparent irrational behaviour over the past few years or so in regard to her performance of her duties at Mr. Tachner's office. As I understand these facts, Ms. Foreman has had for over thirty years working in the Tachner law firm, the responsibility for billing clients for professional services carried out by the Tachner firm, as well as communicating with vendors of outside services for the firm and its clients, and generally running the day to day activities of the firm according to established rules and instructions of Mr. Tachner.

Besides Ms. Foreman and Mr. Tachner, I am informed that there is another full time secretary who takes instruction directly from Ms. Foreman and that from time to time there are one or two additional part time employees who may be brought in to carry out certain maintenance-type activities such as library upkeep, filing, copying, mail preparation and the like.

As I understand their relationship, Mr. Tachner spends his time mostly doing legal work for the firm's clients and he depends heavily on Ms. Foreman to run the business aspects of the firm including billing, docketing, payroll and communicating with outside service providers. She also handles Mr. Tachner's document preparation and maintaining his files which are quite numerous. Clearly from what I've learned, the Tachner law firm is a very busy firm and Ms. Foreman has a heavy workload with many varied and important responsibilities.

I have had the opportunity to read Mr. Tachner's statement regarding Ms. Foreman's behaviour in relation to the client Atomic Aquatics. I have also read Ms. Foreman's statement pertaining to those matters. In addition, I have had a two hour interview with Ms. Foreman in which she participated voluntarily at the request of Mr. Tachner.



**CONFIDENTIAL**

I do not consider Ms. Janis Foreman to be a patient of mine at this time because I have been asked to consult in the capacity of an expert with the intent of communicating my diagnosis with the constraints of physician-patient privilege. I have made this special purpose of my participation in this matter clear to Ms. Foreman and she has acknowledged that she understands that she is not my patient and that I am not her physician.

Based upon these facts communicated to me, my reading of the Tachner and Foreman statements and my interview with Ms. Foreman, I have formed a preliminary medical opinion as follows:

Ms. Foreman's irrational behaviour is a result of her reaction to a temporary but continually increased work overload which became more than she could handle without any apparent way to vent the frustration, the worry and concern that's she increasingly felt as she fell behind in her work.

She correctly regards her most significant responsibility as control of cash flow by timely billing of clients and payments to vendors. In the period from early 2005 to the end of 2007, she evidently became so busy that's she lost the ability to bill clients in a timely manner and pay the firm's obligations when they were due.

She began feeling a sense of guilt for not being able to properly handle these responsibilities. She did not want to inform Mr. Tachner of these problems because she did not want to have her position diminished or lose any esteem in the eyes of her boss. She had no one else to tell of these difficulties and therefore no way to share these problems. After almost 30 years of being so capable and trustworthy, she could not bring herself to admit any inability to handle her responsibilities. She worried about her job, she worried about what Mr. Tachner would think of her, she spent more time concerned with her problems than with solving her problems.

This type of destabilizing behaviour resulted in a spiralling down in her ability to think and act rationally. She began to do and say unreasonable and unrealistic things. She lost any sense of reality. She lost her sense of proportionality. Her goal became one of maintaining a sense of continuity and stability for Mr. Tachner even by misleading him and making false statements to him and to others. Ms. Foreman was suffering from an acute psychotic breakdown brought on by rising pressures at her most important environment, her workplace where she had succeeded for decades.

**CONFIDENTIAL**

If Ms. Foreman were my patient I would propose that she undergo a program of therapy designed to give her a better sense of balance to handle such occasions of high levels of work pressure in a more motive and stable manner. I would prescribe an anti-depressant medication to address her symptoms of depression. Such medications include Prozac, Paxil, Zoloft, Lexapro, Wellbutrin and others. I would prescribe an anti-anxiety medication to address her symptoms of anxiety. Such medications include Librium, Ativan, Klonopin, Tranxene and others.

I would suggest to her that she should help her employer adjust her office responsibilities to reduce her work load if possible. I believe that Ms. Foreman's illness is amenable to treatment.

I declare under penalty of perjury that the foregoing is true and correct.  
Executed this 13 day of December 2010 at Fountain Valley, California.

By: Samuel H Albert MD  
Samuel H. Albert, M.D.

**CONFIDENTIAL**

The following information is appended so as to provide medical basis and reasoning for my conclusion:

**Assigned Duties and Work Load of Ms. Foreman:**

Ms. Janis Foreman is a Caucasian female age 61, born 4-26-1949. She has been an employee since June 19, 1978 of Leonard Tachner, Esq. Ms. Foreman is the office manager.

Ms. Foreman states that she is a Legal Secretary and is the Manager of the office where she works. She describes her assigned duties as numerous, detailed and often overwhelming.

She states, "I have a giant case load. I do many jobs." Among the long list of tasks for which she is responsible, she mentioned the following:

**TASKS RELATED TO THE LEGAL WORK OF THE OFFICE:**

1. Managing the foreign filing of patent information,
2. Managing the United States filing of patent information,
3. File patent application in the United States,
4. File world-wide trademarks, a cumbersome process,
5. File United States trademark applications,
6. Obtain required documents from the client and the United States Patent Office,
7. Obtains a United States copy of certified documents,
8. Prepares and files Assignment documents in the United States and Worldwide,
9. She does docketing of all the documents that enter the office,
10. She sends out form letters,
11. Prepares and obtains Power of Attorneys from companies,
12. She types all amendments and applications,
13. She files copyrights,
14. She does filing, pulling and replacing files,
15. She does drawing corrections and declarations. "I'll get the draftsman to come in and do new drawings".
16. Oversee preparation of photocopying (me or Jodie),
17. She does work related to the International Patent Cooperation Treaty (PCT). She does work related to the PCT, an international treaty involving nations that have signed the PCT agreement with the U.S.A.,
18. Letters take a great deal of time and each letter has to be placed in the file appropriate to the letter,
19. From the parent case there are often several other cases that come from the parent case, each having its own number,
20. Oversight of the office docketing system,

**CONFIDENTIAL**

21. Typing of drafts of patent applications and prosecution documents.

TIME PRESSURES often become extreme due to the following factors

1. Everything received by the office has a deadline of 30, 60 or 90 days,
2. Often the inventor works for a company and then leaves the company.

OVERWORK of Ms. Foreman can be ascertained by examining these factors:

The quantity of documents is massive.

Locate a misplaced document might take several hours or days.

Ms. Foreman often works 2 or 3 nights extra each week to 7-10 PM depending on what is going on in the office.

#### ASSIGNED OFFICE TASKS NOT RELATED TO THE LEGAL WORK

1. Ms. Foreman does the billing of clients for the office, and the bill paying. The attorney in the office signs the checks.
2. Pays bills.
3. Bills clients.
4. Bill clients for costs.
5. "I am responsible to obtain supplies for the office; I order or buy supplies at Sam's Warehouse or Costco stores or stationary stores including soft drinks and bulk paper".
6. She cleans the office on the weekends.

HELP AND ASSISTANCE ARE PROVIDED BY ADDITIONAL EMPLOYEES IN THE OFFICE, TO A LIMITED DEGREE.

The Secretary (Jodie) does help a bit.

# CONFIDENTIAL

**Current psychiatric mental status evaluation:**

Caucasian Female appearing her stated age. Judgement intact for basic activities of daily life, but is revealed to be quite weak during the time of the events starting in early 2005. She did think in a way that can only be described as psychotic at the time. She made extremely poor decisions, thought in unusual manners, believed events to be true that were in fact false, and acted upon these convictions rather than logic or the usual standing orders of her employer.

Her mood is one of anxiety with an undercurrent of depression. Her daily life is usually non-eventful. She spends most of our evaluation session talking about the events which occurred while she was employed by the law firm of Leonard Tachner. She has many recollections of the events. Speech is grammatical most of the time. No stutter, stammer or lisp. Dress is casual, with cotton-wash pants and a nondescript shirt. No jewelry other than an inexpensive wristwatch. No symptoms to indicate disorientation, hallucinations, illusions, delusions, true phobias, obsessive thinking, compulsive or stereotypic movement inappropriate affect. Affect is congruent to speech and thought and is appropriate mood. Psychological understanding and insight is absent.

**Diagnosis:** Major Depression, severe, with psychotic episodes.  
Generalized Anxiety Disorder

Very truly yours,



Samuel H. Albert, M.D.

09/08/1998

PTO UTILITY GRANT

Paper Number 7

**The Commissioner of Patents  
and Trademarks**

*Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.*

*Therefore, this*

**United States Patent**

*Grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America for the term set forth below, subject to the payment of maintenance fees as provided by law.*

*If this application was filed prior to June 8, 1995, the term of this patent is the longer of seventeen years from the date of grant of this patent or twenty years from the earliest effective U.S. filing date of the application; subject to any statutory extension.*

*If this application was filed on or after June 8, 1995, the term of this patent is twenty years from the U.S. filing date; subject to an statutory extension. If the application contains a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121 or 365(c); the term of the patent is twenty years from the date on which the earliest application was filed, subject to any statutory extension.*

The  
United  
States  
of  
America



*Bence Lehman*  
Commissioner of Patents and Trademarks



*Pamela J. Morth*  
Assistant

# Petitioner's Exhibit X

Post-Issuance History in  
Pat. No. 6,463,640  
“Atomic-10”

Exhibit X

**UNITED STATES PATENT & TRADEMARK OFFICE**  
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND					09/983145
1 Date of Request: 09/28/11		2 Serial/Patent # 6,463,640			
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED	6 AMOUNT	
<input type="checkbox"/>	Filing			\$	
<input type="checkbox"/>	Amendment			\$	
<input type="checkbox"/>	Extension of Time			\$	
<input type="checkbox"/>	Notice of Appeal/Appeal			\$	
<input type="checkbox"/>	Petition			\$	
<input type="checkbox"/>	Issue			\$	
<input type="checkbox"/>	Cert of Correction/Terminal Disc.			\$	
<input type="checkbox"/>	Maintenance			\$	
<input type="checkbox"/>	Assignment			\$	
<input checked="" type="checkbox"/>	Other	IFW	04/11/11	\$ 1,640.00	
			7 TOTAL AMOUNT OF REFUND		\$ 1,640.00
			8 TO BE REFUNDED BY:		
10 REASON:		Treasury Check			
<input type="checkbox"/>	Overpayment				
<input type="checkbox"/>	Duplicate Payment	<input checked="" type="checkbox"/>	Credit Deposit A/C #:		
<input checked="" type="checkbox"/>	No Fee Due (Explanation):	9 0 6 -- 0 9 3 0			
They told us to charge total of \$1,240 and \$400 to Deposit Account. We charged it \$2,880 and \$400.					
Sum of \$1,640 (\$2,880 - \$1,240) is therefore refundable.					
11 REFUND REQUESTED BY:					
TYPED/PRINTED NAME: Charles Steven Brantley		TITLE: Senior Petitions Attorney			
SIGNATURE: 		PHONE: 571-272-3203			
OFFICE: Office of Petitions					
***** THIS SPACE RESERVED FOR FINANCE USE ONLY: *****					
APPROVED: 		DATE: 10/06/11			

*Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:*

**Office of Finance  
Refund Branch  
Crystal Park One, Room 802B**



RECEIVED  
CENTRAL FAX CENTER

Attorney Docket No.: ATOMIC-10

APR 11 2011

## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

Patentee: Douglas J. Toth )  
 Patent No.: 6,463,640 )  
 Issued: October 15, 2002 )  
 For: STRAP CONNECTING BUCKLE )

2011 APR 12 PM 4:25

USPTO  
RECEIPTS ACCOUNTING  
DIVISIONTRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENTMAIL STOP: PETITIONS

Attn: Christina Tartera Donnell  
 Senior Petitions Attorney  
 Commissioner for Patents  
 U.S. Patent & Trademark Office  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

10/06/2011 GARIAS 88888881 868938 6463648

01 FC:1599 1248.88 DA

Dear Sir:

Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justifies reconsideration and granting of the pending petition and such is respectfully solicited.

04/14/2011 DALLIN 88888886 868938 6463648

01 FC:1599 2888.88 DA  
02 FC:1462 488.88 DA



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Leonard Tachner  
Suite 38-E  
17961 Sky Park Circle  
Irvine, CA 92614

**MAILED**

**OCT 06 2011**

In re Patent of Toth	:	<b>OFFICE OF PETITIONS</b>
Patent No. 6,463,640	:	
Issue Date: October 15, 2002	:	Request for Information
Application No. 09/483,145	:	
Filing Date: January 13, 2000	:	
Attorney Docket No. Atomic-10	:	

**Request for Information**

This communication responds to the renewed petition under 37 C.F.R. § 1.378(b) filed April 11, 2011, and responds to a letter filed April 22, 2011.

By Petitioner's own admission, the Tachner firm, or persons employed by that firm, have not been truthful with the USPTO. Furthermore, there is a specter of bias in the declaration of Dr. Albert since, at the time of his diagnosis, he was not Janis Foreman's doctor and he was paid to provide his opinion by Mr. Tachner. The record fails to include any evidence corroborating Dr. Albert's diagnosis. Given the circumstances of this case, corroborating evidence for Dr. Albert's diagnosis is required.

It is extremely odd that the people that were closest to Ms. Foreman did not notice that, as stated by Dr. Albert, she exhibited "destabilizing behavior" or that "she lost her sense of reality" or "lost her sense of proportionality." Further, as stated in Mr. Tachner's declaration, it appears that for about two years, Ms. Foreman was failing to bill clients or pay firm obligations even though the performance of these tasks appears to have been her primary duty. Therefore, it is not clear from the record how Mr. Tachner could have failed to recognize Ms. Foreman was failing to properly bill clients and pay firm obligations.

In response to the instant request for information, Petitioner is required to provide a rebuttal to all the assertions set forth in the petition filed July 21, 2010 in U.S. Patent No. 6,205,885.<sup>1</sup> Furthermore, Petitioner must explain why the current explanation provided in this case is any more believable than other explanations previously provided. Petitioner is required to provide

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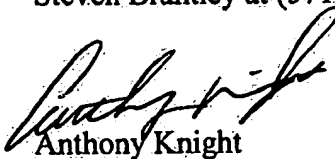
<sup>1</sup> A copy of the petition can be accessed using the Office's Public Patent Application Information Retrieval system located at <http://portal.uspto.gov/external/portal/pair>.

corroborating evidence of Ms. Foreman's condition from a source that is independent of Dr. Albert. Additionally, Petitioner must fully discuss how the actions of Ms. Foreman, with regard to the docket, went undetected from early 2005 until January 2011. Further, Petitioner must explain how Ms. Foreman's failure to bill clients and pay firm obligations went undetected from early 2005 until the end of 2007.

Petitioner must submit the requested information within TWO MONTHS of the mailing date of this letter. Extensions of time may not be obtained. No additional fee is due for a response to the instant request for information. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

Petitioner filed a letter on April 22, 2011, in this case and in Patent No. 5,803,073. The letter states, "We have noticed that [an] extra \$1,240 in fees was charged for 6,463,640 on April 14, 2011." The letter requests the Office "correct the overcharge." The April 11, 2011 petition filed in this case instructed the Office to charge the deposit account \$1,240 for the 7.5 year maintenance fee and \$400 for the request for reconsideration. The Office charged the deposit account \$2,880 and \$400. Therefore, a refund of \$1,640 (\$2,880 - \$1,240) is warranted and the sum of \$1,640 has been credited back to the deposit account.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight  
Director  
Office of Petitions

## Deposit Account Statement

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Page 1 of 1

APR 22 2011

United States  
Patent and  
Trademark OfficeDeposit Account Statement

Requested Statement Month: April 2011  
 Deposit Account Number: 060930  
 Name: LEONARD TACHNER-A PROFESSIONAL LAW CORPORATION  
 Attention: REGISTERED PATENT ATTORNEY  
 Street Address 1: 17981 SKY PARK CIRCLE  
 Street Address 2: SUITE 38-E  
 City: IRVINE  
 State: CA  
 Zip: 92614-4364  
 Country: UNITED STATES

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
<del>04/10</del>	<del>45524</del>	<del>12022254</del>	<del>DONALD</del>	<del>9203</del>	<del>\$40.00</del>	<del>\$2,817.00</del>
<del>04/10</del>	<del>2935</del>	<del>29373060</del>	<del>DONALD</del>	<del>9203</del>	<del>\$40.00</del>	<del>\$2,817.00</del>
<del>04/10</del>	<del>13023</del>	<del>05013051</del>	<del>DONALD</del>	<del>9203</del>	<del>\$40.00</del>	<del>\$2,817.00</del>
04/14	8	6463640		1599	\$2,880.00	\$3,197.00
04/14	9	6463640		1462	\$400.00	\$2,797.00
04/14	10	6098924		1462	\$400.00	\$2,397.00
04/14	11	6347766		1462	\$400.00	\$1,997.00
04/18	8785	E-REPLENISHMENT		9203	-\$3,000.00	\$4,997.00
04/18	7	6761163		1462	\$400.00	\$4,597.00
<del>04/19</del>	<del>3940</del>	<del>85200000</del>	<del>DONALD</del>	<del>9203</del>	<del>\$40.00</del>	<del>\$4,597.00</del>
04/19	11	5803073		1599	\$1,940.00	\$2,382.00
04/19	12	5803073		1462	\$400.00	\$1,982.00

← OVERCHARGE  
OF \$1,240.00

START BALANCE	SUM OF CHARGES	SUM OF REPLENISH	END BALANCE
\$6,257.00	\$7,275.00	\$3,000.00	\$1,982.00

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CENTRAL FAX CENTER****APR 22 2011**Attorney Docket No.: **ATOMIC-10****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 6,463,640 )  
Issued: October 15, 2002 )  
For: STRAP CONNECTING BUCKLE )

**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENT****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

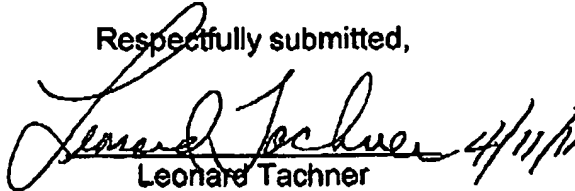
Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justifies reconsideration and granting of the pending petition and such is respectfully solicited.

6,463,640

A fee of \$1,640.00 (for the second annuity \$1,240.00 and \$400.00 for the requested reconsideration) should be deducted from Deposit Account No. 06-0930.

Respectfully submitted,

  
Leonard Tachner

**Attachments:**

1. Additional Declaration of Leonard Tachner (3 pages)
2. Declaration of Samuel H. Albert, M.D. (2 pages)
3. Additional Declaration of Janis Foreman (3 pages)

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APR 22 2011

LEONARD TACHNER  
A PROFESSIONAL LAW CORPORATION  
REGISTERED PATENT ATTORNEY  
17961 SKY PARK CIRCLE  
SUITE 38-E  
IRVINE, CALIFORNIA 92614-6364

PATENTS  
TRADEMARKS  
COPYRIGHTS

TEL: (949) 752-8525  
FAX: (949) 955-2415

USPTO  
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DIVISION  
2011 APR 25 PM 4:42

**PLEASE DELIVER THE FOLLOWING MATERIAL AS SOON AS POSSIBLE**

TO: Christina Tartera Donnell, Senior Petitions Attorney

FROM: Leonard Tachner

NUMBER OF PAGES: 6 (INCLUDING THIS COVER PAGE)

DATE SENT: 4-22-11 TIME SENT: 11 AM

RE: 5,803,073 and 6,463,640 (CLIENT AND/OR DOCKET NO.)

PLEASE NOTIFY OPERATOR IMMEDIATELY IF THE ABOVE IS \*NOT\* RECEIVED PROPERLY AT (949) 752-8525

UNLESS OTHERWISE INDICATED OR OBVIOUS FROM THE NATURE OF THE TRANSMITTAL, THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS ATTORNEY/CLIENT PRIVILEGED AND CONFIDENTIAL INFORMATION INTENDED FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR EMPLOYEE, OR AGENT RESPONSIBLE TO DELIVER IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR OR ARE NOT SURE WHETHER IT IS PRIVILEGED, PLEASE IMMEDIATELY NOTIFY US BY COLLECT TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA THE U.S. POSTAL SERVICE AT OUR EXPENSE. THANK YOU.

Dear Ms. Donnell: We recently filed Requests For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patents by delayed acceptance of previously unpaid maintenance fees. (see copy of transmittal letter for each case attached). The transmittal letters requested the fees be deducted from our Deposit Account 06-0930. We have noticed that an extra \$1,240.00 in fees was charged for 6,463,640 on April 14. That overcharge resulted in a deficiency on April 19 when the fees needed for 5,803,073 were deducted from our Deposit Account. Please can you correct the overcharge for Patent 6,463,640 of \$1,240.00 and deduct the remaining fees for Patent No. 5,803,073 of \$2,055.00 from our Deposit Account. We are enclosing a copy of our Deposit Account statement for April 2011. Thank you for your assistance.

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Attorney Docket No.: ATOMIC-10

APR 11 2011

## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

Patentee: Douglas J. Toth )  
Patent No.: 6,463,640 )  
Issued: October 15, 2002 )  
For: STRAP CONNECTING BUCKLE )

USPTO  
ACCOUNTING  
DIVISION  
2011 APR 12 PM 4:26ADDITIONAL DECLARATION OF LEONARD TACHNERMAIL STOP: PETITIONS

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Leonard Tachner, do hereby declare as follows:

1. I submit this declaration as an addition to my prior declaration submitted with the subject petition. This statement is part of the evidence I am filing in support of a request for reconsideration.
2. When Ms. Foreman told me in 2008 in regard to U.S. Patent No. 6, 205,885 that the client told her that they would pay their own maintenance fees, at first it didn't seem suspicious because the client usually wrote most or all of the specification of their patent applications in order to reduce their fees. They left the claims to me to write. Only when the client disputed Ms. Foreman's statement did I begin to wonder whether Ms. Foreman was mistaken. However, I still accepted her assertion that she believed the client had made that statement because up to then (by 2008 she had worked for me for 30 years) I had no



reason to doubt her reliability. Only in late 2010 when she asserted that other clients (ATOMIC and CSUF) had also taken on the responsibility to pay their own maintenance fees, did I realize that I could no longer trust her because there was evidently something seriously wrong with Ms. Foreman. That is when I decided that I needed to have her see Dr. Albert.

3. Over the 33 years that I have been in my own practice, I have filed applications that issued into roughly 600 U.S. patents for my clients. In a small number of these applications and patents, it has been necessary to file a petition to revive due to a delayed response to an Office Action, a late issue fee payment and occasionally a late maintenance fee. Some of these petitions were necessary because of failures of clients to communicate in a timely manner. Up to the recent events; a few such petitions were made necessary by innocent clerical errors of my staff. However, to the best of my recollection, every one of those petitions to revive an application or to accept a late maintenance fee filed by my firm, had ultimately been granted. It would be impossible for us to know the precise numbers of such petitions, because once resolved, we do not retain any data summarizing such events. Moreover, many of such files have since been transferred to other firms or otherwise disposed of.


4. I now better understand the specific behavior that was Ms. Foreman's issue with meeting office deadlines primarily for paying maintenance fees to the U.S. Patent & Trademark Office. She would entirely overlook a payment deadline. Then rather than inform me in a timely manner so that I could remedy the delay, she would "cover up" her omission by alleging that the corresponding client had told her in a phone call or face to face discussion that they would pay such fees themselves. By way of example, here enclosed is a copy of the face of the file showing the entry, apparently made by Ms. Foreman for this particular patent, showing that the client would pay their own maintenance fee. Only when I began to see this type of entry more than once did I begin to understand that I had a serious problem.

5. I believe that the heavy workload I had assigned to Ms. Foreman over the past years has contributed to her aberrant behavior. However, I believe that her actions went beyond merely normal stress and anxiety. Based on my discussions with Dr. Albert, I now recognize that Ms. Foreman had for several years since as early as 2005 and as recently as four months ago, been ill and unable to cope with her responsibilities. I also believe that her illness was a direct cause of the firm's failure to act in a timely manner in behalf of the client in this matter.

6. I regard Ms. Foreman as more than just my employee. After more than three decades of a close working relationship, Ms. Foreman is more like a member of my family. I believe that is the reason that I did not recognize her problems earlier. She will continue to see Dr. Albert at my expense. In the meantime I will transfer time-based responsibilities from Ms. Foreman to another employee.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4/11/11

  
Leonard Tachner  
Attorney for the Petitioner  
Registration No. 26,344



**Samuel H. Albert, M.D., Inc.**  
**Diplomate**  
**American Board of Psychiatry & Neurology**

I, Dr. Samuel Albert, do hereby declare as follows:

1. This declaration supplements my prior statement submitted previously in regard to this matter.
2. Based upon my interviews with Ms. Janice P. Foreman, and Mr. Leonard Tachner, it is evident that her problems at her employment stemmed from a significant increase in her workload and responsibilities that occurred at about the beginning of 2002 when another law firm went out of business and several hundred files were transferred to the Tachner firm. Evidently, she was able to handle the sudden workload increase for a period of two to three years. However, beginning in late 2004, early 2005 she started falling behind and could no longer keep current.
3. In retrospect she now realizes that within a few months thereafter she started a pattern of behavior which she now recognizes as irrational. Such behavior for example included making up false excuses for failing to take required actions such as contacting clients and responding to Mr. Tachner's questions with answers that may have had no factual basis, but which she believed would satisfy his inquiry. In my opinion, it was during this period beginning in mid-2005 when Ms. Foreman went through a transition from being merely over-worked and highly stressed to being clinically ill.
4. It appears that the extent of her illness varied depending upon her level of stress and anxiety, but that it didn't fully abate until the early months of 2011. The principal symptom of this illness was her inability to separate real events from imagined ones. From time to time during this period, she would let her behavior and her actions be dictated by what she perceived to have previously occurred as opposed to events that had actually taken place.
5. In my opinion therefore, between mid-2005 and late 2010, and based upon her prior reliable behavior in regard to her duties at the Tachner firm, Ms. Foreman's failure to take proper actions were due to a psychosis that

manifested in her inability to distinguish real events from imagined ones. This condition was of such a degree, that she could not function normally and if she were to be questioned or challenged in regard to her behavior, that would raise her stress level and exacerbate her condition. I have advised Mr. Tachner and Ms. Foreman that it would be my recommendation that Ms. Foreman enter treatment on a regular basis so that I can monitor her progress and be sure that there is no regression.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: April 11 2011Samuel Albert MD  
Dr. Samuel Albert

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APR 11 2011

Attorney Docket No.: ATOMIC-10

## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

Patentee: Douglas J. Toth )  
Patent No.: 6,463,640 )  
Issued: October 15, 2002 )  
For: STRAP CONNECTING BUCKLE )

2011 APR 12 PM 4:27

USPTO  
RECEIPTS ACCOUNTING  
DIVISIONADDITIONAL DECLARATION OF JANIS FOREMANMAIL STOP: PETITIONS

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Janis Foreman, do hereby declare as follows:

1. This declaration is a supplement to my prior declaration submitted in regard to a petition to accept an unavoidably delayed payment of the maintenance fee for the above-identified patent.

2. Over the past few months I have, as a result of discussions with and medical treatment from Dr. Samuel Albert, begun to understand that over the last five or six years I have been ill and unable to function normally and rationally in my employment as Office Manager at the Tachner Law Firm. My mindset was more attuned to survival than to properly carrying out my duties.

3. In regard to the subject patent in particular, my duty was to communicate in a timely manner with the client who is the patentee of the subject patent, to ascertain whether that client wished to have our firm pay the maintenance fee that was required in order to retain the patent. Normally, I would have sent a letter or an email to the client about 45 days before the due date for payment of the maintenance fee. Then, if I receive a positive response, I would have prepared and mailed or emailed a statement to the client so that payment from the client would be received in time to forward the payment to the U.S. Patent & Trademark Office before the due date.

4. It is my current recollection that what I did instead was to recognize that a maintenance fee was coming due for this patent, but continually put it off as something that I could attend to in due course, since I had more urgent things to do before I could get to that matter. Then I would rationalize that I could rely on a six-month surcharge period if needed and continue to put off communicating with the client. Eventually, I ran out of time, but it would occur to me that this client had wanted to pay its own maintenance fees and I would simply make such an entry in the corresponding docket sheet.

5. There was no logic or rational explanation for my behavior. I simply felt hopelessly overwhelmed and this was a way for me to handle it. I had no animosity toward the client or toward the law firm. It was just my way of coping with what I perceived to be an impossible situation without admitting to Mr. Tachner that I could no longer handle all of my usual responsibilities.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or

both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4-9-11

Janis Foreman  
Janis Foreman



RECEIVED  
CENTRAL FAX CENTERAttorney Docket No.: **ATOMIC-10**

APR 11 2011

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 6,463,640 )  
Issued: October 15, 2002 )  
For: STRAP CONNECTING BUCKLE )

2011 APR 12 PM 4:25

USPTO  
RECEIPTS ACCOUNTING  
DIVISION**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENT****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

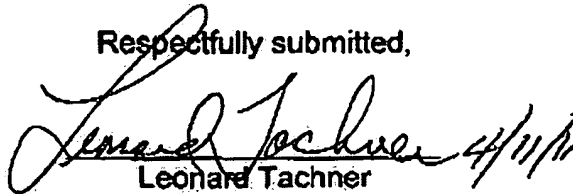
Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justifies reconsideration and granting of the pending petition and such is respectfully solicited.

04/14/2011 DALLEN 00000006 060930 6463640

01 FC:1599 2000.00 DA  
02 FC:1462 400.00 DA

A fee of \$1,640.00 (for the second annuity \$1,240.00 and \$400.00 for the requested reconsideration) should be deducted from Deposit Account No. 06-0930.

Respectfully submitted,

  
Leonard Tachner

Attachments:

1. Additional Declaration of Leonard Tachner (3 pages)
2. Declaration of Samuel H. Albert, M.D. (2 pages)
3. Additional Declaration of Janis Foreman (3 pages)



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

**MAILED**

**FEB 10 2011**

**OFFICE OF PETITIONS**

In re Patent No. 6,463,640	:	
Issue Date: October 15, 2002	:	DECISION ON PETITION
Application No. 09/483,145	:	
Filed: January 13, 2000	:	
Attorney Docket No. ATOMIC-10	:	

This is a decision in response to the petition under 37 CFR 1.378(b), filed January 3, 2011, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is **dismissed** without prejudice to reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued on October 15, 2002. The first maintenance fee could have been paid during the period from Monday, October 17, 2005 through Monday, April 17, 2006, or with a surcharge during the period from Tuesday, April 18, 2006 through Monday, October 16, 2006. Accordingly, this patent expired on October 16, 2006, for failure to timely remit the first maintenance fee.

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);

(2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks requirement (3).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).

That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of

establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987).

In the present petition, petitioner asserted that over a protracted period beginning in 2005, counsel's office manager, Ms. Foreman, experienced a medical condition that caused her to fail in her office duties which included notifying the patentee of the need to pay the maintenance fees, obtaining the client's authorization to pay the maintenance fee, and proceeding to send the payment to the USPTO. In support of the petition, petitioners provided a statement from patent practitioner Leonard Tachner, office manager Ms. Foreman, and Dr. Samuel A. Albert.

To establish a showing of "unavoidable" delay based upon medical incapacitation, petitioner must demonstrate that the incapacitation was of such a nature and degree as to render the person unable to conduct business (*e.g.*, correspond with the USPTO) during the period when the maintenance fee was due. Such a showing must be supported by a statement(s) from the person's treating physician(s), and such statement(s) must provide the nature and degree of the person's medical condition during the period from when the maintenance was due (*i.e.*, October 16, 2006) until the filing of a grantable petition. Namely, petitioner should provide the USPTO with a statement from a treating physician, asserting that from the time the maintenance fee was due (*i.e.*, October 16, 2006) until the filing of a grantable petition, the person's medical condition was of such a degree of severity that it prevented her from timely paying the maintenance fee. Additionally, the treating physician must describe person's medical condition, the degree of incapacitation, and the duration of the medical illness.

In this instance, petitioner has not provided sufficient evidence at this time to show that "but for" Ms. Foreman's medical condition, the maintenance fee would have been timely paid. The Office is particularly interested in the duration of Ms. Foreman's medical condition - the date of when Ms. Foreman's medical condition began until the date she sought treatment. Petitioner may wish to

provide a statement from her treating physician. Additionally, petitioner should submit a statement from Ms. Foreman explaining in detail the exact actions or inactions she took with regard to the docketing and timely paying of the maintenance fees for this patent. The present statements submitted on petition provide the Office with generalities as to the actions/inactions of Ms. Foreman that ultimately resulted in the delayed payment of the maintenance fees.

In summary, petitioner must show that Ms. Foreman's medical condition was the cause of the error in failing to timely pay the maintenance fee; her condition was of such a degree of severity that it prevented her from performing specific duties with regard to the docketing and paying of the maintenance fee for this patent; and that her condition spanned the entire period from the due date for the maintenance fee until the date of the filing of a grantable petition. Without any further explanation or documentary evidence, the Office is left to speculate as to the circumstances that transpired.

The Office cautions petitioner to remove or mark through any personal information in any document submitted to the USPTO that could contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioner should consider deleting such personal information from the documents before submitting them to the USPTO. Petitioner is advised that the patent file is available to the public after the issuance of a patent. However, checks and credit card authorization forms (PTO-2038) submitted for payment purposes are not retained in the application file, and therefore, are not publicly available.

For the reasons stated, the petition is **dismissed**.

Petitioner should note that if this petition under 37 CFR 1.378(b)/(e) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the maintenance fee and post-expiration surcharge. The \$400.00 petition fee for seeking further reconsideration is not refundable.

Any request for refund should be in writing to the following address:

Mail Stop 16  
Director of the US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

The Office charged the deposit account for the \$490.00 maintenance fee due at 3.5 years, the \$1,240.00 maintenance fee due at 7.5 years, and the \$700.00 surcharge after expiration as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                Mail Stop Petition  
                          Commissioner for Patents  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX:                (571) 273-8300  
                          Attn: Office of Petitions

By hand:               Customer Services Window  
                          Randolph Building  
                          401 Dulany Street  
                          Alexandria, VA 22314

Correspondence may also be submitted electronically via EFS-Web.

The patent file is being returned to Files Repository.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

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JAN 12 2011

JAN 03 2011

18 pages

## OFFICE OF PETITIONS

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Approved for use through 03/31/2012. OMB 0851-0016  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCEPETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF  
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))Docket Number (Optional)  
ATOMIC-10Mail to: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450  
Fax: (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact the Patent and Trademark Office at (571) 272-3282.

01 FC:1599

1190.00 DA

Patent Number: 6,463,640

Application Number: 09/483,145

Issue Date: October 15, 2002

Filing Date: January 13, 2000

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

- ☐ is a reissue of original Patent No. \_\_\_\_\_ original issue date \_\_\_\_\_  
original application number \_\_\_\_\_  
original filing date \_\_\_\_\_
- ☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application  
\_\_\_\_\_ filed on \_\_\_\_\_

## CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

12/31/10  
Date

Signature

LEONARD TACHNER

Typed or printed name of person signing Certificate

02/10/2011 CKHLOK 00000014 060930 6463640

(Page 1 of 4)

01 FC:2551 490.00 DA

02 FC:1557 700.00 DA

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the public which is to his (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Adjustment date: 02/10/2011 CKHLOK

01/11/2011 DALLEN 00000058 060930 6463640

01 FC:1599 1190.00 CR



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JAN 03 2011

PTO/SB/85 (03-09)

Approved for use through 03/31/2012. OMB 0651-0018  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 1. SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

## 2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

## 3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input checked="" type="checkbox"/> \$ _____	3 ½ yr fee	(1551)	<input checked="" type="checkbox"/> \$ 490	3 ½ yr fee	(2551)
<input type="checkbox"/> \$ _____	7 ½ yr fee	(1552)	<input checked="" type="checkbox"/> \$ 1240	7 ½ yr fee	(2552)
<input type="checkbox"/> \$ _____	11 ½ yr fee	(1553)	<input type="checkbox"/> \$ _____	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ 1730

## 4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ 700

## 5. MANNER OF PAYMENT

- ☐ Enclosed is a check for the sum of \$ \_\_\_\_\_
- ☒ Please charge Deposit Account No. 06-0930 the sum of \$ 2430
- ☐ Payment by credit card. Form PTO-2038 is attached.

## 6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

- ☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 06-0930

(Page 2 of 4)

PTO/SB/85 (03-09)

Approved for use through 03/31/2012. OMB 0651-0016

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

7. OVERPAYMENT

As to any overpayment made, please

☒ Credit to Deposit Account No. 06-0930

OR

☐ Send refund check

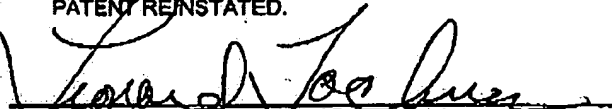
WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

  
Signature(s) of Petitioner(s)

12/31/10  
Date

LEONARD TACHNER

Typed or printed name(s)

17961 SKY PARK CIRCLE, SUITE 38-E

Address

IRVINE, CALIFORNIA 92614

Address

28,344

Registration Number, if applicable

949-752-8525

Telephone Number

ENCLOSURES:

- ☒ Maintenance Fee Payment
- ☒ Statement why maintenance fee was not paid timely
- ☒ Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)
- ☐ Other:

01/11/2011 DALLIN 88888825 858930 6463640  
Sale Ref: 88888858 DAH: 858930 6463640  
01 FC:1599 1198.00 DA

PTO/SB/65 (03-08)

Approved for use through 03/31/2012. OMB 0851-0018

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."



Signature

LEONARD TACHNER

Type or printed name



Date

26,344

Registration Number, if applicable

STATEMENT

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

This petition is supported by declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and a physician, Dr. Samuel A. Albert who is a board certified psychiatrist.

The declaration evidence shows that over a protracted period beginning in 2005 Ms. Foreman experienced a psychological breakdown or psychotic episode as described by Dr. Albert who has interviewed her for purposes of making his enclosed Statement/Declaration. The breakdown of Ms. Foreman caused her to fail in her office duties which included notifying the patentee of the need to pay maintenance fees, obtaining the client's authorization to make such payments and then proceeding to send such payments to the U.S. Patent & Trademark Office in a timely manner. Only in the past few weeks has her strange and unexpected behavior come to light.

Ms. Foreman has been a loyal and reliable employee of Tachner's office for more than thirty-two years. She did not exhibit any form of overt personality characteristics or behavior which would have led Mr. Tachner to anticipate that she would not have fulfilled her normal office duties as she had done for more than three decades. Based upon Dr. Albert's interview and diagnosis of Ms. Foreman, it is only now understood that she was overworked and stressed beyond her limit (see Dr. Albert's Statement/Declaration) but that she was "programmed" to hide her predicament for fear of losing her position. Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justify a granting of this petition and such is respectfully solicited.

(Please attach additional sheets if additional space is needed)

(Page 4 of 4)

I, Leonard Tachner, do hereby declare as follows:

A. INTRODUCTION

1. I am a member of the State Bar of California (1973) and admitted to practice before the U.S. Patent and Trademark Office (1971). I make this declaration in support of petition under Rule 1.378(b). This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

B. BACKGROUND AND PROFESSIONAL EXPERIENCE

2. I earned a Bachelor of Science degree in Electrical Engineering from City College of the State University of New York in 1965 and a Master of Science degree in Electrical Engineering from California State University at Long Beach in 1969. I received a Juris Doctor degree cum laude from Western State University in 1973.

3. I was admitted to practice before the United States Patent and Trademark Office as a patent agent since about December 1971 and I was assigned registration number 26,344. I was admitted to the State Bar of California in 1973. Over my entire career no disciplinary action has been taken against me by the United States Patent and Trademark Office, the State Bar of California or any other agency or administrative body.

4. I am admitted to practice before the U.S. Supreme Court, the Court of Appeals for the Federal Circuit, the Ninth Circuit Court of Appeals, all the U.S. District Courts of California and the Supreme Court of California.

5. I began my legal career in 1973 and have more than 35 years of private practice experience in intellectual property matters including patent, trademark, copyright and unfair competition. I began my own private practice as a patent attorney in March 1978, initially as a partner in a small firm and later as a sole practitioner in 1984.

6. I have prepared and prosecuted over 800 U.S. patent applications. In addition, I have been lead trial counsel in numerous U.S. District Court trials involving patent validity and infringement and served as a testifying patent law expert in federal district court litigation and arbitration proceedings.

7. I have an "AV" Martindale-Hubbell Peer Review rating.

C. LAW PRACTICE MANAGEMENT

8. I have two employees working full time as office staff. Janis Foreman is my office manager. Ms. Foreman was hired in June 1978 and has been continually employed by me since that time. In 1988 I hired Jodie Pyle as a typist. Jodie, now Mrs. Jodie Miller, has been continually employed by me since that time.

9. For at least the past twenty years, Ms. Foreman, as office manager, has been responsible for entering information into my patent and trademark docket and handling routine communications with clients and associates, all under my direction and supervision. In addition, Ms. Foreman does the bookkeeping for my office including billing and tracking our accounts receivable and accounts payable. She also prepares the final version of documents to be filed in the U.S. Patent and Trademark Office.

10. I have personally devoted uncountable hours to training and teaching Ms. Foreman over the past three decades. Over the last thirty two years of employment, she has become well-trained in every aspect of the administration of my practice. However, despite her acumen, we have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney. Her work is done under my supervision. She is not authorized to make any decision that could affect, diminish or be inimical in any way to a client's rights. Her actions in dealing with clients, the U.S. Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communications are to be reviewed by me.

11. I maintain a docketing system whereby Ms. Foreman receives all incoming correspondence and docketed relevant dates in our electronic docket. As each due date in the docket is responded to Ms. Foreman has the responsibility for noting when the due date was met.

12. I maintain supervisory authority of the docket. I routinely check the docket to keep aware of upcoming deadlines. I also regularly confer with Janis regarding matters coming up on the docket. Ms. Foreman also reviews the docket for upcoming due dates. Where appropriate, Ms. Foreman consults with me regarding matters entered into the docketing system.

13. When Ms. Foreman is either sick or on vacation or otherwise unavailable, Jodie fills in. Jodie's responsibilities include, typing drafts of patent applications and prosecution documents and preparing form letters to clients.

14. Over the years of her employment in my office, Ms. Foreman has been a loyal and devoted employee. Janis has normally handled her responsibilities in a professional and competent manner.

D. CHRONOLOGY OF EVENTS IN THIS MATTER

15. On or about Monday November 22, 2010 Ms. Foreman showed me a table of patent-related matters of Atomic Aquatics that she had prepared at the request of Mr. Dean Garraffa, one of that company's principals. Atomic Aquatics has been an important client of mine for about the past fifteen years and I have known its principals, Dean Garraffa and Doug Toth for more than twenty years.

16. I noticed that the table had a number of entries for Atomic Aquatics issued U.S. Patents which indicated that they had become abandoned for failure to pay maintenance fees between 2005 and 2008. She informed me that she believed that these abandonments were known to the client's principals and were the result of their lack of adequate funds or because the corresponding products had become obsolete. To the best of my knowledge, Ms. Foreman sent this table to Mr. Garraffa that day on Wednesday morning, November 24. On that same day I left Southern California for the four-day Thanksgiving weekend, arriving at my destination that evening. I checked my email and opened an email from Ms. Foreman stating that Mr. Garraffa had received the table and had called the office that day and expressed a desire to see me as soon as I returned from the Thanksgiving weekend.

17. When I returned to the office on Monday November 29, 2010, Mr. Garraffa was already waiting for me in the lobby talking to Ms. Foreman. He indicated a need to meet with me to speak to me about the contents of the table Ms. Foreman had sent to him. Mr. Garraffa then proceeded to explain that he and Mr. Toth were shocked to learn that several of their issued U.S. patents had apparently expired without their knowledge and that they needed to find out how it had happened and what could be done to remedy the situation. I told him that I would investigate the various files involved and report to him as soon as possible.

18. Over the ensuing two days I had discussions with Ms. Foreman and I examined a number of the Atomic Aquatics patent files. I also spoke to Mr. Garraffa about a provisional application that was supposed to be followed by a corresponding non-provisional but hadn't been. In examining the file, I found various instructions I had prepared for Ms. Foreman including a set of claims for the non-provisional, but no evidence that Ms. Foreman had carried out my instructions or that a non-provisional had been prepared and filed. It became evident to me that Ms. Foreman had failed to do her work in regard to a number of Atomic Aquatics files including the file No. ATOMIC-10 (Patent No. 6,463,640) for which this petition is being filed.


19. When I confronted her, she eventually admitted to me that she had lost control of her tasks, particularly over a several year period between 2005 and 2008 when she just couldn't keep up with the demands of the job and perform all of her duties in a timely manner. She revealed that she was too afraid and embarrassed to tell me about this behavior. I then reported to Mr. Garraffa and advised him that I would immediately begin preparation of petitions to revive the Atomic Aquatics patents that had been lost as a result of Ms. Foreman's shocking and totally unexpected behavior.

20. I arranged for Ms. Foreman to consult with a psychiatrist acquaintance so I could learn whether her problems were treatable and whether I could trust her work in the future. A Declaration Report of Dr. Samuel Albert is enclosed herewith.

21. Based upon Dr. Albert's Report and my own observations, I believe that Ms. Foreman, as a result of overwork and stress beyond her limit, experienced a lengthy period of irrational behavior. During this period she simply didn't carry out all of her usual responsibilities including communicating with clients and paying patent issue and maintenance fees including the following: file No. ATOMIC-10 for Patent No. 6,463,640 maintenance fees. Furthermore, Ms. Foreman was afraid to admit her inadequacies and endanger her position which had become such a predominant aspect of her life. Consequently, she did all she could to hide the problems until just recently.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Respectfully submitted,

  
Leonard Tachner 12/31/10



I, Janis Foreman, do hereby declare as follows:

**A. INTRODUCTION**

1. This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

**B. BACKGROUND AND PROFESSIONAL EXPERIENCE**

2. I am the office manager for attorney Leonard Tachner. I was hired in June 1978 and have been continually employed by Mr. Tachner since that time.

3. Over the past thirty two years, I have received an extensive amount of training and instruction from Mr. Tachner in all aspects of his practice. For the last approximately twenty years, I have been responsible for entering information into Mr. Tachner's patent and trademark docket. I handle routine communications with clients and associates, all under Mr. Tachner's direction and supervision. I also manage the bookkeeping, billing, and tracking of Mr. Tachner's accounts receivable and accounts payable. I prepare the final version of documents to be filed in the U.S. Patent and Trademark Office.

4. Our office procedures are clearly defined by Mr. Tachner. I receive all incoming correspondence and docket relevant dates in our electronic docket. As each due date in the docket is responded to, I am responsible for noting in the electronic docket when the due date was met.

5. Mr. Tachner maintains supervisory authority of the docket and routinely checks it for accuracy and upcoming deadlines. Mr. Tachner regularly confers with me regarding matters coming up on the docket. I review the docket daily for upcoming due dates and Mr. Tachner periodically reviews the docket for the same purpose. Where appropriate, I consult with Mr. Tachner regarding matters entered into the docketing system.

6. In connection with preparing this declaration, I have reviewed correspondence, emails and other documents relating to this matter. Though I cannot explain or justify many of my actions described below, I have set forth in this declaration my true recollection of the events.

C. CHRONOLOGY OF EVENTS IN THIS MATTER

7. On or about November 17, 2010, I received a phone call from Mr. Dean Garraffa of Atomic Aquatics. He asked me to prepare a tabular report showing the current status of all of their patent-related files in our office.

8. In response to Mr. Garraffa's request, I spent the following two days carefully examining all of the patent-related files of Atomic Aquatics. I found that there were a number of issued patents that had expired for non-payment of maintenance fees that had been due to be paid since as early as 2005. I also found a pending design patent application that had become abandoned for failure to pay an issue fee and a provisional application that had been allowed to lapse without filing a corresponding non-provisional.

9. I actually filled out the tabular report to reflect the true status of all of the Atomic Aquatic files, but I could not fully understand why there appeared to be numerous problems associated with these files, particularly in regard to the past several years. My initial reaction was that the client had communicated authorization to withhold such payments and filings because of their financial problems or product obsolescence, but I could not find any documents or other evidence supporting these "feelings". In retrospect, I now realize that these were unsupported rationalizations that cover a period of several years during which I was functioning at less than my normal capabilities.

10. I don't know precisely what may have affected my mental performance during this period, but I do recall that I was under a great deal of pressure and stress due to my work load and that I was feeling continuously overwhelmed and unable to keep up. However, I was reluctant to tell Mr. Tachner of my concerns because I did not want to disappoint him after so many years.

11. Upon discussing this matter with Mr. Tachner and Dr. Samuel Albert, I now realize that it was a mistake to keep Mr. Tachner in the dark in regard to my sense of being overwhelmed and that I should have informed Mr. Tachner of my need for help. I also now realize the harm my actions have caused the client and Mr. Tachner. I am truly sorry.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dec 22, 2010

  
Janis Foreman

**CONFIDENTIAL**Statement of Samuel H. Albert, M.D.

I, Samuel H. Albert, M.D., am a practising Psychiatrist having an office in Fountain Valley, California. I have been a licensed physician in the State of California beginning July 1, 1969. I have been in practice as a Psychiatrist since October 1, 1972 and a board certified Psychiatrist since November 1978.

In late November 2010 I was asked to render professional consultation as a psychiatric expert for the purpose of diagnosing a Ms. Janis Foreman, who is a legal secretary and office manager for Attorney Leonard Tachner in Irvine, California.

I was presented with certain facts relating to Ms. Foreman's job role and apparent irrational behaviour over the past few years or so in regard to her performance of her duties at Mr. Tachner's office. As I understand these facts, Ms. Foreman has had for over thirty years working in the Tachner law firm, the responsibility for billing clients for professional services carried out by the Tachner firm, as well as communicating with vendors of outside services for the firm and its clients, and generally running the day to day activities of the firm according to established rules and instructions of Mr. Tachner.

Besides Ms. Foreman and Mr. Tachner, I am informed that there is another full time secretary who takes instruction directly from Ms. Foreman and that from time to time there are one or two additional part time employees who may be brought in to carry out certain maintenance-type activities such as library upkeep, filing, copying, mail preparation and the like.

As I understand their relationship, Mr. Tachner spends his time mostly doing legal work for the firm's clients and he depends heavily on Ms. Foreman to run the business aspects of the firm including billing, docketing, payroll and communicating with outside service providers. She also handles Mr. Tachner's document preparation and maintaining his files which are quite numerous. Clearly from what I've learned, the Tachner law firm is a very busy firm and Ms. Foreman has a heavy workload with many varied and important responsibilities.

I have had the opportunity to read Mr. Tachner's statement regarding Ms. Foreman's behaviour in relation to the client Atomic Aquatics. I have also read Ms. Foreman's statement pertaining to those matters. In addition, I have had a two hour interview with Ms. Foreman in which she participated voluntarily at the request of Mr. Tachner.

**CONFIDENTIAL**

I do not consider Ms. Janis Foreman to be a patient of mine at this time because I have been asked to consult in the capacity of an expert with the intent of communicating my diagnosis with the constraints of physician-patient privilege. I have made this special purpose of my participation in this matter clear to Ms. Foreman and she has acknowledged that she understands that she is not my patient and that I am not her physician.

Based upon these facts communicated to me, my reading of the Tachner and Foreman statements and my interview with Ms. Foreman, I have formed a preliminary medical opinion as follows:

Ms. Foreman's irrational behaviour is a result of her reaction to a temporary but continually increased work overload which became more than she could handle without any apparent way to vent the frustration, the worry and concern that's she increasingly felt as she fell behind in her work.

She correctly regards her most significant responsibility as control of cash flow by timely billing of clients and payments to vendors. In the period from early 2005 to the end of 2007, she evidently became so busy that's she lost the ability to bill clients in a timely manner and pay the firm's obligations when they were due.

She began feeling a sense of guilt for not being able to properly handle these responsibilities. She did not want to inform Mr. Tachner of these problems because she did not want to have her position diminished or lose any esteem in the eyes of her boss. She had no one else to tell of these difficulties and therefore no way to share these problems. After almost 30 years of being so capable and trustworthy, she could not bring herself to admit any inability to handle her responsibilities. She worried about her job, she worried about what Mr. Tachner would think of her, she spent more time concerned with her problems then with solving her problems.

This type of destabilizing behaviour resulted in a spiralling down in her ability to think and act rationally. She began to do and say unreasonable and unrealistic things. She lost any sense of reality. She lost her sense of proportionality. Her goal became one of maintaining a sense of continuity and stability for Mr. Tachner even by misleading him and making false statements to him and to others. Ms. Foreman was suffering from an acute psychotic breakdown brought on by rising pressures at her most important environment, her workplace where she had succeeded for decades.

**CONFIDENTIAL**

If Ms. Foreman were my patient I would propose that she undergo a program of therapy designed to give her a better sense of balance to handle such occasions of high levels of work pressure in a more motive and stable manner. I would prescribe an anti-depressant medication to address her symptoms of depression. Such medications include Prozac, Paxil, Zoloft, Lexapro, Wellbutrin and others. I would prescribe an anti-anxiety medication to address her symptoms of anxiety. Such medications include Librium, Ativan, Klonopin, Tranxene and others.

I would suggest to her that she should help her employer adjust her office responsibilities to reduce her work load if possible. I believe that Ms. Foreman's illness is amenable to treatment.

I declare under penalty of perjury that the foregoing is true and correct.  
Executed this 13 day of December 2010 at Fountain Valley, California.

By: Samuel H Albert MD  
Samuel H. Albert, M.D.

# CONFIDENTIAL

The following information is appended so as to provide medical basis and reasoning for my conclusion:

## Assigned Duties and Work Load of Ms. Foreman:

Ms. Janis Foreman is a Caucasian female age 61, born 4-26-1949. She has been an employee since June 19, 1978 of Leonard Tachner, Esq. Ms. Foreman is the office manager.

Ms. Foreman states that she is a Legal Secretary and is the Manager of the office where she works. She describes her assigned duties as numerous, detailed and often overwhelming.

She states, "I have a giant case load. I do many jobs." Among the long list of tasks for which she is responsible, she mentioned the following:

## TASKS RELATED TO THE LEGAL WORK OF THE OFFICE:

1. Managing the foreign filing of patent information,
2. Managing the United States filing of patent information,
3. File patent application in the United States,
4. File world-wide trademarks, a cumbersome process,
5. File United States trademark applications,
6. Obtain required documents from the client and the United States Patent Office,
7. Obtains a United States copy of certified documents,
8. Prepares and files Assignment documents in the United States and Worldwide,
9. She does docketing of all the documents that enter the office,
10. She sends out form letters,
11. Prepares and obtains Power of Attorneys from companies,
12. She types all amendments and applications,
13. She files copyrights,
14. She does filing, pulling and replacing files,
15. She does drawing corrections and declarations. "I'll get the draftsman to come in and do new drawings".
16. Oversee preparation of photocopying (me or Jodie),
17. She does work related to the international Patent Cooperation Treaty (PCT). She does work related to the PCT, an International treaty involving nations that have signed the PCT agreement with the U.S.A.,
18. Letters take a great deal of time and each letter has to be placed in the file appropriate to the letter,
19. From the parent case there are often several other cases that come from the parent case, each having its own number,
20. Oversight of the office docketing system,

**CONFIDENTIAL**

21. Typing of drafts of patent applications and prosecution documents.

TIME PRESSURES often become extreme due to the following factors

1. Everything received by the office has a deadline of 30, 60 or 90 days,
2. Often the inventor works for a company and then leaves the company.

OVERWORK of Ms. Foreman can be ascertained by examining these factors:

The quantity of documents is massive.

Locate a misplaced document might take several hours or days.

Ms. Foreman often works 2 or 3 nights extra each week to 7-10 PM depending on what is going on in the office.

#### ASSIGNED OFFICE TASKS NOT RELATED TO THE LEGAL WORK

1. Ms. Foreman does the billing of clients for the office, and the bill paying. The attorney in the office signs the checks.
2. Pays bills.
3. Bills clients.
4. Bill clients for costs.
5. "I am responsible to obtain supplies for the office; I order or buy supplies at Sam's Warehouse or Costco stores or stationary stores including soft drinks and bulk paper".
6. She cleans the office on the weekends.

HELP AND ASSISTANCE ARE PROVIDED BY ADDITIONAL EMPLOYEES IN THE OFFICE, TO A LIMITED DEGREE.

The Secretary (Jodie) does help a bit.



# CONFIDENTIAL


## Current psychiatric mental status evaluation:

Caucasian Female appearing her stated age. Judgement intact for basic activities of daily life, but is revealed to be quite weak during the time of the events starting in early 2005. She did think in a way that can only be described as psychotic at the time. She made extremely poor decisions, thought in unusual manners, believed events to be true that were in fact false, and acted upon these convictions rather than logic or the usual standing orders of her employer.

Her mood is one of anxiety with an undercurrent of depression. Her daily life is usually non-eventful. She spends most of our evaluation session talking about the events which occurred while she was employed by the law firm of Leonard Tachner. She has many recollections of the events. Speech is grammatical most of the time. No stutter, stammer or lisp. Dress is casual, with cotton-wash pants and a nondescript shirt. No jewelry other than an inexpensive wristwatch. No symptoms to indicate disorientation, hallucinations, illusions, delusions, true phobias, obsessive thinking, compulsive or stereotypic movement inappropriate affect. Affect is congruent to speech and thought and is appropriate mood. Psychological understanding and insight is absent.

**Diagnosis:** Major Depression, severe, with psychotic episodes.  
Generalized Anxiety Disorder

Very truly yours,



Samuel H. Albert, M.D.



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Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

P75M  
LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

DATE PRINTED

11/15/06

**NOTICE OF PATENT EXPIRATION**

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, you may call the USPTO Contact Center at 800-786-9199 or 571-272-1000.

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
463640	09483145	10/15/02	01/13/00	10/16/06	

# Petitioner's Exhibit Y

Post-Issuance History in  
Pat. No. 6,761,163  
“Atomic-14”

Exhibit Y



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

LEONARD TACHNER, A PROFESSIONAL LAW CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

**MAILED**

OCT 06 2011

In re Patent No. 6,761,163  
Issue Date: July 13, 2004  
Application No. 10/347,608  
Filed: January 21, 2003  
Attorney Docket No: ATOMIC-14

OFFICE OF PETITIONS

ON PETITION

**REQUEST FOR INFORMATION**

A petition was filed on April 12, 2011 under 37 CFR 1.378(e), requesting reconsideration of a decision mailed February 10, 2011, which refused to accept the delayed payment of the maintenance fee for the above-identified patent.

By Petitioner's own admission, the Tachner firm, or persons employed by that firm, have not been truthful with the USPTO. Furthermore, there is a specter of bias in the declaration of Dr. Albert since, at the time of his diagnosis, he was not Janis Foreman's doctor and he was paid to provide his opinion by Mr. Tachner. The record fails to include any evidence corroborating Dr. Albert's diagnosis. Given the circumstances of this case, corroborating evidence for Dr. Albert's diagnosis is required.

It is extremely odd that the people that were closest to Ms. Foreman did not notice that, as stated by Dr. Albert, she exhibited "destabilizing behavior" or that "she lost her sense of reality" or "lost her sense of proportionality." Further, as stated in Mr. Tachner's declaration, it appears that for about two years, Ms. Foreman was failing to bill clients or pay firm obligations even though the performance of these tasks appears to have been her primary duty. Therefore, it is not clear from the record how Mr. Tachner could have failed to recognize Ms. Foreman was failing to properly bill clients and pay firm obligations.

In response to the instant request for information, Petitioner is required to provide a rebuttal to all the assertions set forth in the petition filed July 21, 2010 in U.S. Patent No. 6,205,885.<sup>1</sup> Furthermore, Petitioner must explain why the current explanation provided in this case is any more believable than other explanations previously provided. Petitioner is required to provide corroborating evidence of Ms. Foreman's condition from a source that is independent of Dr. Albert. Additionally, Petitioner must fully discuss how the actions of Ms. Foreman, with regard to the docket, went undetected from early 2005 until January 2011. Further, Petitioner must

---

<sup>1</sup> A copy of the petition can be accessed using the Office's Public Patent Application Information Retrieval system located at <http://portal.uspto.gov/external/portal/pair>.

explain how Ms. Foreman's failure to bill clients and pay firm obligations went undetected from early 2005 until the end of 2007.

Petitioner must submit the requested information within TWO MONTHS of the mailing date of this letter. Extensions of time may not be obtained. No additional fee is due for a response to the instant request for information. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

The response to this Request for Information should include a cover letter entitled "Response to Request for Information."

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

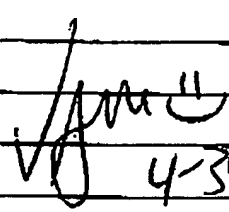
By FAX: (571) 273-8300  
Attn: Office of Petitions

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Anthony Knight  
Director,  
Office of Petitions

Issued

INVENTOR <u>DOUGLAS J. TOTH</u>	
SERIAL NO. <u>10/347,608</u>	FILED <u>1-21-03</u>
TITLE <u>INFLATOR REGULATOR WITH MULTIPLE ADAPTERS FOR CONNECTION TO DIFFERENT SIZE BC HOSES</u>	
ASSIGNEE _____	
ASSIGNMENT RECORDED _____ REEL _____ FRAME _____	
OFFICE ACTIONS	AMENDMENTS
1-21-04 PCT & Taiwan Due ✓	
5-25-04 Issue Fees ✓	5-25-04 ✓
1-13-08 First Annuity ✓	client will pay fees
1-13-12 Second Annuity ✓	
1-13-16 Third Annuity ✓	
 4-30-08	
ALLOWED _____ FINAL FEE PAID _____	
PATENT NO. <u>US 6,761,163 B1</u>	DATE <u>July 13, 2004</u>

Kruysman

10-00 Hudson Avenue Long Island City, NY 11101 (718) 431-3071 (fax) 771-1014

**Samuel H. Albert, M.D., Inc.**  
**Diplomate**  
**American Board of Psychiatry & Neurology**

I, Dr. Samuel Albert, do hereby declare as follows:

1. This declaration supplements my prior statement submitted previously in regard to this matter.
2. Based upon my interviews with Ms. Janice P. Foreman, and Mr. Leonard Tachner, it is evident that her problems at her employment stemmed from a significant increase in her workload and responsibilities that occurred at about the beginning of 2002 when another law firm went out of business and several hundred files were transferred to the Tachner firm. Evidently, she was able to handle the sudden workload increase for a period of two to three years. However, beginning in late 2004, early 2005 she started falling behind and could no longer keep current.
3. In retrospect she now realizes that within a few months thereafter she started a pattern of behavior which she now recognizes as irrational. Such behavior for example included making up false excuses for failing to take required actions such as contacting clients and responding to Mr. Tachner's questions with answers that may have had no factual basis, but which she believed would satisfy his inquiry. In my opinion, it was during this period beginning in mid-2005 when Ms. Foreman went through a transition from being merely over-worked and highly stressed to being clinically ill.
4. It appears that the extent of her illness varied depending upon her level of stress and anxiety, but that it didn't fully abate until the early months of 2011. The principal symptom of this illness was her inability to separate real events from imagined ones. From time to time during this period, she would let her behavior and her actions be dictated by what she perceived to have previously occurred as opposed to events that had actually taken place.
5. In my opinion therefore, between mid-2005 and late 2010, and based upon her prior reliable behavior in regard to her duties at the Tachner firm, Ms. Foreman's failure to take proper actions were due to a psychosis that

manifested in her inability to distinguish real events from imagined ones. This condition was of such a degree, that she could not function normally and if she were to be questioned or challenged in regard to her behavior, that would raise her stress level and exacerbate her condition. I have advised Mr. Tachner and Ms. Foreman that it would be my recommendation that Ms. Foreman enter treatment on a regular basis so that I can monitor her progress and be sure that there is no regression.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: April 11 2011Samuel Albert MD

Dr. Samuel Albert



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APR 11 2011

Attorney Docket No.: **ATOMIC-14****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 6,761,163 )  
Issued: July 13, 2004 )  
For: INFLATOR REGULATOR WITH )  
MULTIPLE ADAPTERS FOR )  
CONNECTION TO DIFFERENT SIZE )  
BC HOSES )

USPTO  
RECEIPTS ACCOUNTING  
DIVISION  
2011 APR 12 PM 4:29**ADDITIONAL DECLARATION OF JANIS FOREMAN****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Janis Foreman, do hereby declare as follows:

1. This declaration is a supplement to my prior declaration submitted in regard to a petition to accept an unavoidably delayed payment of the maintenance fee for the above-identified patent.

2. Over the past few months I have, as a result of discussions with and medical treatment from Dr. Samuel Albert, begun to understand that over the last five or six years I have been ill and unable to function normally and rationally in my employment as Office Manager at the Tachner Law Firm. My mindset was more attuned to survival than to properly carrying out my duties.

3. In regard to the subject patent in particular, my duty was to communicate in a timely manner with the client who is the patentee of the subject patent, to ascertain whether that client wished to have our firm pay the maintenance fee that was required in order to retain the patent. Normally, I would have sent a letter or an email to the client about 45 days before the due date for payment of the maintenance fee. Then, if I receive a positive response, I would have prepared and mailed or emailed a statement to the client so that payment from the client would be received in time to forward the payment to the U.S. Patent & Trademark Office before the due date.

4. It is my current recollection that what I did instead was to recognize that a maintenance fee was coming due for this patent, but continually put it off as something that I could attend to in due course, since I had more urgent things to do before I could get to that matter. Then I would rationalize that I could rely on a six-month surcharge period if needed and continue to put off communicating with the client. Eventually, I ran out of time, but it would occur to me that this client had wanted to pay its own maintenance fees and I would simply make such an entry in the corresponding docket sheet.

5. There was no logic or rational explanation for my behavior. I simply felt hopelessly overwhelmed and this was a way for me to handle it. I had no animosity toward the client or toward the law firm. It was just my way of coping with what I perceived to be an impossible situation without admitting to Mr. Tachner that I could no longer handle all of my usual responsibilities.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge

that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4-9-11

*Janis Foreman*  
Janis Foreman

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APR 11 2011

Attorney Docket No.: ATOMIC-14

## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

Patentee: Douglas J. Toth )  
Patent No.: 6,761,163 )  
Issued: July 13, 2004 )  
For: INFLATOR REGULATOR WITH )  
MULTIPLE ADAPTERS FOR )  
CONNECTION TO DIFFERENT SIZE )  
BC HOSES )

2011 APR 12 PM 4:29

ACCOUNTING  
DIVISION**TRANSMITTAL OF REQUEST FOR RECONSIDERATION OF A  
PETITION TO REVIVE A PATENT****MAIL STOP: PETITIONS**

Attn: Christina Tartera-Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

04/18/2011 DALLEN 00000004 060930 6761163  
01 FC:1462 400.00 DA

Dear Sir:

Enclosed herein is this Request For Reconsideration of a Petition under Rule 1.378(b) to revive the above-captioned patent by delayed acceptance of previously unpaid maintenance fees. The Request is supported by supplemental declarations of the undersigned, Leonard Tachner, counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and physician, Dr. Samuel Albert who is a board certified psychiatrist.

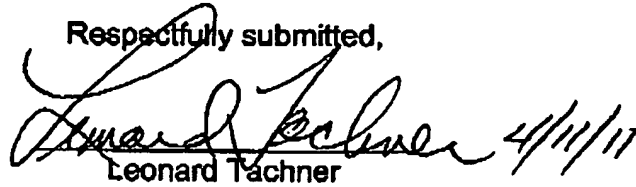
Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justifies

APR 11 2011

reconsideration and granting of the pending petition and such is respectfully solicited.

A fee of \$ \$400.00 for the requested reconsideration should be deducted from Deposit Account No. 06-0930.

Respectfully submitted,

 4/11/11  
Leonard Tachner

Attachments:

1. Additional Declaration of Leonard Tachner (3 pages)
2. Declaration of Samuel H. Albert, M.D. (2 pages)
3. Additional Declaration of Janis Foreman (3 pages)

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APR 11 2011

Attorney Docket No.: **ATOMIC-14****IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Patentee: Douglas J. Toth )  
Patent No.: 6,761,163 )  
Issued: July 13, 2004 )  
For: INFLATOR REGULATOR WITH )  
MULTIPLE ADAPTERS FOR )  
CONNECTION TO DIFFERENT SIZE )  
BC HOSES )

**ADDITIONAL DECLARATION OF LEONARD TACHNER****MAIL STOP: PETITIONS**

Attn: Christina Tartera Donnell  
Senior Petitions Attorney  
Commissioner for Patents  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

I, Leonard Tachner, do hereby declare as follows:

1. I submit this declaration as an addition to my prior declaration submitted with the subject petition. This statement is part of the evidence I am filing in support of a request for reconsideration.
2. When Ms. Foreman told me in 2008 in regard to U.S. Patent No. 6, 205,885 that the client told her that they would pay their own maintenance fees, at first it didn't seem suspicious because the client usually wrote most or all of the specification of their patent applications in order to reduce their fees. They left the claims to me to write. Only when the client disputed Ms. Foreman's statement did I begin to wonder whether Ms. Foreman was mistaken. However, I

still accepted her assertion that she believed the client had made that statement because up to then (by 2008 she had worked for me for 30 years) I had no reason to doubt her reliability. Only in late 2010 when she asserted that other clients (ATOMIC and CSUF) had also taken on the responsibility to pay their own maintenance fees, did I realize that I could no longer trust her because there was evidently something seriously wrong with Ms. Foreman. That is when I decided that I needed to have her see Dr. Albert.

3. Over the 33 years that I have been in my own practice, I have filed applications that issued into roughly 600 U.S. patents for my clients. In a small number of these applications and patents, it has been necessary to file a petition to revive due to a delayed response to an Office Action, a late issue fee payment and occasionally a late maintenance fee. Some of these petitions were necessary because of failures of clients to communicate in a timely manner. Up to the recent events; a few such petitions were made necessary by innocent clerical errors of my staff. However, to the best of my recollection, every one of those petitions to revive an application or to accept a late maintenance fee filed by my firm, had ultimately been granted. It would be impossible for us to know the precise numbers of such petitions, because once resolved, we do not retain any data summarizing such events. Moreover, many of such files have since been transferred to other firms or otherwise disposed of.

4. I now better understand the specific behavior that was Ms. Foreman's issue with meeting office deadlines primarily for paying maintenance fees to the U.S. Patent & Trademark Office. She would entirely overlook a payment deadline. Then rather than inform me in a timely manner so that I could remedy the delay, she would "cover up" her omission by alleging that the corresponding client had told her in a phone call or face to face discussion that they would pay such fees themselves. By way of example, here enclosed is a copy of the face of the file showing the entry, apparently made by Ms. Foreman for this particular patent, showing that the client would pay their own

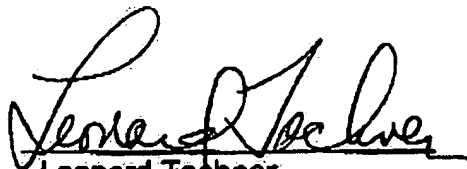
maintenance fee. Only when I began to see this type of entry more than once did I begin to understand that I had a serious problem.

5. I believe that the heavy workload I had assigned to Ms. Foreman over the past years has contributed to her aberrant behavior. However, I believe that her actions went beyond merely normal stress and anxiety. Based on my discussions with Dr. Albert, I now recognize that Ms. Foreman had for several years since as early as 2005 and as recently as four months ago, been ill and unable to cope with her responsibilities. I also believe that her illness was a direct cause of the firm's failure to act in a timely manner in behalf of the client in this matter.

6. I regard Ms. Foreman as more than just my employee. After more than three decades of a close working relationship, Ms. Foreman is more like a member of my family. I believe that is the reason that I did not recognize her problems earlier. She will continue to see Dr. Albert at my expense. In the meantime I will transfer time-based responsibilities from Ms. Foreman to another employee.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dated: 4/11/11

  
Leonard Tachner  
Attorney for the Petitioner  
Registration No. 26,344





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United States Patent and Trademark Office  
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LEONARD TACHNER, A PROFESSIONAL LAW  
CORPORATION  
17961 SKY PARK CIRCLE, SUITE 38-E  
IRVINE CA 92614

**MAILED**

**FEB 10 2011**

**OFFICE OF PETITIONS**

In re Patent No. 6,761,163  
Issue Date: July 13, 2004  
Application No. 10/347,608  
Filed: January 21, 2003  
Attorney Docket No. ATOMIC-14

**DECISION ON PETITION**

This is a decision in response to the petition under 37 CFR 1.378(b), filed January 3, 2011, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is dismissed without prejudice to reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued on July 13, 2004. The first maintenance fee could have been paid during the period from July 13, 2007 through Monday, January 14, 2008, or with a surcharge during the period from Tuesday, January 15, 2008 through Monday, July 14, 2008. Accordingly, this patent expired on July 14, 2008, for failure to timely remit the first maintenance fee.

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);

(2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks requirement (3).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).

That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of

establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987).

In the present petition, petitioner asserted that over a protracted period beginning in 2005, counsel's office manager, Ms. Foreman, experienced a medical condition that caused her to fail in her office duties which included notifying the patentee of the need to pay the maintenance fees, obtaining the client's authorization to pay the maintenance fee, and proceeding to send the payment to the USPTO. In support of the petition, petitioners provided a statement from patent practitioner Leonard Tachner, office manager Ms. Foreman, and Dr. Samuel A. Albert.

To establish a showing of "unavoidable" delay based upon medical incapacitation, petitioner must demonstrate that the incapacitation was of such a nature and degree as to render the person unable to conduct business (e.g., correspond with the USPTO) during the period when the maintenance fee was due. Such a showing must be supported by a statement(s) from the person's treating physician(s), and such statement(s) must provide the nature and degree of the person's medical condition during the period from when the maintenance was due (i.e., July 14, 2008) until the filing of a grantable petition. Namely, petitioner should provide the USPTO with a statement from a treating physician, asserting that from the time the maintenance fee was due (i.e., July 14, 2008) until the filing of a grantable petition, the person's medical condition was of such a degree of severity that it prevented her from timely paying the maintenance fee. Additionally, the treating physician must describe person's medical condition, the degree of incapacitation, and the duration of the medical illness.

In this instance, petitioner has not provided sufficient evidence at this time to show that "but for" Ms. Foreman's medical condition, the maintenance fee would have been timely paid. The Office is particularly interested in the duration of Ms. Foreman's medical condition - the date of when Ms. Foreman's medical condition began until the date she sought treatment. Petitioner may wish to

provide a statement from her treating physician. Additionally, petitioner should submit a statement from Ms. Foreman explaining in detail the exact actions or inactions she took with regard to the docketing and timely paying of the maintenance fees for this patent. The present statements submitted on petition provide the Office with generalities as to the actions/inactions of Ms. Foreman that ultimately resulted in the delayed payment of the maintenance fees.

In summary, petitioner must show that Ms. Foreman's medical condition was the cause of the error in failing to timely pay the maintenance fee; her condition was of such a degree of severity that it prevented her from performing specific duties with regard to the docketing and paying of the maintenance fee for this patent; and that her condition spanned the entire period from the due date for the maintenance fee until the date of the filing of a grantable petition. Without any further explanation or documentary evidence, the Office is left to speculate as to the circumstances that transpired.

The Office cautions petitioner to remove or mark through any personal information in any document submitted to the USPTO that could contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioner should consider deleting such personal information from the documents before submitting them to the USPTO. Petitioner is advised that the patent file is available to the public after the issuance of a patent. However, checks and credit card authorization forms (PTO-2038) submitted for payment purposes are not retained in the application file, and therefore, are not publicly available.

For the reasons stated, the petition is **dismissed**.

Petitioner should note that if this petition under 37 CFR 1.378(b)/(e) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the maintenance fee and post-expiration surcharge. The \$400.00 petition fee for seeking further reconsideration is not refundable.

Any request for refund should be in writing to the following address:

Mail Stop 16  
Director of the US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

The Office charged the deposit account for the \$490.00 maintenance fee due at 3.5 years, the \$1,240.00 maintenance fee due at 7.5 years, and the \$700.00 surcharge after expiration as authorized.

Patent No. 6,761,163  
Application No. 10/347,608

Page 5

Further correspondence with respect to this matter should be addressed as follows:

By mail:                   Mail Stop Petition  
                              Commissioner for Patents  
                              P.O. Box 1450  
                              Alexandria, VA 22313-1450

By FAX:                   (571) 273-8300  
                              Attn: Office of Petitions

By hand:                  Customer Services Window  
                              Randolph Building  
                              401 Dulany Street  
                              Alexandria, VA 22314

Correspondence may also be submitted electronically via EFS-Web.

The patent file is being returned to Files Repository.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.

*C. T. Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

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JAN 12 2011

OFFICE OF PETITIONS

18 pages

JAN 03 2011

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0651-0016  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF  
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))**Docket Number (Optional)  
ATOMIC-14Mail to: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450  
Fax: (571) 273-830001/11/2011 DALLEN 00000057 060930 6761163  
01 FC:1599 1190.00 DANOTE: If information or assistance is needed in completing this form, please contact Petitions Information at  
(571) 272-3282.

Patent Number: 6,761,163

Application Number: 10/347,608

Issue Date: July 13, 2004

Filing Date: January 21, 2003

**CAUTION:** Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

☐ Is a reissue of original Patent No. \_\_\_\_\_ original issue date \_\_\_\_\_  
original application number \_\_\_\_\_  
original filing date \_\_\_\_\_☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application  
\_\_\_\_\_ filed on \_\_\_\_\_**CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

12/31/10  
Date  
Signature

LEONARD TACHNER

Typed or printed name of person signing Certificate

02/10/2011 CKHL0K 00000013 060930 6761163

(Page 1 of 4)

01 FC:2551 490.00 DA  
02 FC:1557 700.00 DA

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-919

Adjustment dates: 02/10/2011 CKHL0K  
01/17/2011 DALLEN 00000057 060930 6761163  
01 FC:1599 1190.00 CR

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JAN 03 2011

PTO/SB/85 (03-09)

Approved for use through 03/31/2012. OMB 0851-0016  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 1. SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

## 2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

## 3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$ _____	3 ½ yr fee	(1551)	<input checked="" type="checkbox"/> \$ 490	3 ½ yr fee	(2551)
<input type="checkbox"/> \$ _____	7 ½ yr fee	(1552)	<input type="checkbox"/> \$ 1240	7 ½ yr fee	(2552)
<input type="checkbox"/> \$ _____	11 ½ yr fee	(1553)	<input type="checkbox"/> \$ _____	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ 490

## 4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of \$ 700 (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ 700

## 5. MANNER OF PAYMENT

☐ Enclosed is a check for the sum of \$ \_\_\_\_\_☒ Please charge Deposit Account No. 06-0930 the sum of \$ 1190☐ Payment by credit card. Form PTO-2038 is attached.

## 6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

☒ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. 06-0930

[Page 2 of 4]

PTO/SB/65 (03-09)

Approved for use through 03/31/2012. OMB 0651-0016  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## 7. OVERPAYMENT

As to any overpayment made, please



Credit to Deposit Account No. 06-0930

OR



Send refund check

## WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

## 8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

## 9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

  
Signature(s) of Petitioner(s)12/31/10  
Date

LEONARD TACHNER

Typed or printed name(s)

26,344

Registration Number, if applicable

17961 SKY PARK CIRCLE, SUITE 38-E

Address

949-752-8525

Telephone Number

IRVINE, CALIFORNIA 92614

Address

## ENCLOSURES:



Maintenance Fee Payment



Statement why maintenance fee was not paid timely



Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)



Other:



PTO/SB/05 (03-08)

Approved for use through 03/31/2012. OMB 0651-0016  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."



Signature

12/31/10

Date

LEONARD TACHNER

Type or printed name

26,344

Registration Number, if applicable

**STATEMENT**

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

This petition is supported by declarations of the undersigned, Leonard Tachner counsel for the patentee, the office manager of counsel's office, Ms. Janis Foreman and a physician, Dr. Samuel A. Albert who is a board certified psychiatrist.

The declaration evidence shows that over a protracted period beginning in 2005 Ms. Foreman experienced a psychological breakdown or psychotic episode as described by Dr. Albert who has interviewed her for purposes of making his enclosed Statement/Declaration. The breakdown of Ms. Foreman caused her to fail in her office duties which included notifying the patentee of the need to pay maintenance fees, obtaining the client's authorization to make such payments and then proceeding to send such payments to the U.S. Patent & Trademark Office in a timely manner. Only in the past few weeks has her strange and unexpected behavior come to light.

Ms. Foreman has been a loyal and reliable employee of Tachner's office for more than thirty-two years. She did not exhibit any form of overt personality characteristics or behavior which would have led Mr. Tachner to anticipate that she would not have fulfilled her normal office duties as she had done for more than three decades. Based upon Dr. Albert's interview and diagnosis of Ms. Foreman, it is only now understood that she was overworked and stressed beyond her limit (see Dr. Albert's Statement/Declaration) but that she was "programmed" to hide her predicament for fear of losing her position. Based upon the foregoing as more thoroughly detailed in the enclosed declarations, it is earnestly believed that the revival of the subject patent based upon entirely unforeseen circumstances that were truly "unavoidable", justify a granting of this petition and such is respectfully solicited.

(Please attach additional sheets if additional space is needed)

[Page 4 of 4]

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JAN 12 2011

I, Leonard Tachner, do hereby declare as follows: OFFICE OF PETITIONS

A. INTRODUCTION

1. I am a member of the State Bar of California (1973) and admitted to practice before the U.S. Patent and Trademark Office (1971). I make this declaration in support of petition under Rule 1.378(b). This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

B. BACKGROUND AND PROFESSIONAL EXPERIENCE

2. I earned a Bachelor of Science degree in Electrical Engineering from City College of the State University of New York in 1965 and a Master of Science degree in Electrical Engineering from California State University at Long Beach in 1969. I received a Juris Doctor degree cum laude from Western State University in 1973.

3. I was admitted to practice before the United States Patent and Trademark Office as a patent agent since about December 1971 and I was assigned registration number 26,344. I was admitted to the State Bar of California in 1973. Over my entire career no disciplinary action has been taken against me by the United States Patent and Trademark Office, the State Bar of California or any other agency or administrative body.

4. I am admitted to practice before the U.S. Supreme Court, the Court of Appeals for the Federal Circuit, the Ninth Circuit Court of Appeals, all the U.S. District Courts of California and the Supreme Court of California.

5. I began my legal career in 1973 and have more than 35 years of private practice experience in intellectual property matters including patent, trademark, copyright and unfair competition. I began my own private practice as a patent attorney in March 1978, initially as a partner in a small firm and later as a sole practitioner in 1984.

6. I have prepared and prosecuted over 800 U.S. patent applications. In addition, I have been lead trial counsel in numerous U.S. District Court trials involving patent validity and infringement and served as a testifying patent law expert in federal district court litigation and arbitration proceedings.

7. I have an "AV" Martindale-Hubbell Peer Review rating.

C. LAW PRACTICE MANAGEMENT

8. I have two employees working full time as office staff. Janis Foreman is my office manager. Ms. Foreman was hired in June 1978 and has been continually employed by me since that time. In 1988 I hired Jodie Pyle as a typist. Jodie, now Mrs. Jodie Miller, has been continually employed by me since that time.

9. For at least the past twenty years, Ms. Foreman, as office manager, has been responsible for entering information into my patent and trademark docket and handling routine communications with clients and associates, all under my direction and supervision. In addition, Ms. Foreman does the bookkeeping for my office including billing and tracking our accounts receivable and accounts payable. She also prepares the final version of documents to be filed in the U.S. Patent and Trademark Office.

10. I have personally devoted uncountable hours to training and teaching Ms. Foreman over the past three decades. Over the last thirty two years of employment, she has become well-trained in every aspect of the administration of my practice. However, despite her acumen, we have always maintained clear lines between her responsibilities as an employee and mine as a patent attorney. Her work is done under my supervision. She is not authorized to make any decision that could affect, diminish or be inimical in any way to a client's rights. Her actions in dealing with clients, the U.S. Patent and Trademark Office and with our foreign associates, must be based on my instructions that she receives by conferring with me. She is not to carry out such actions until and unless she first confers with me. Our office procedure is clear – all substantive incoming communications are to be reviewed by me.

11. I maintain a docketing system whereby Ms. Foreman receives all incoming correspondence and docketed relevant dates in our electronic docket. As each due date in the docket is responded to Ms. Foreman has the responsibility for noting when the due date was met.

12. I maintain supervisory authority of the docket. I routinely check the docket to keep aware of upcoming deadlines. I also regularly confer with Janis regarding matters coming up on the docket. Ms. Foreman also reviews the docket for upcoming due dates. Where appropriate, Ms. Foreman consults with me regarding matters entered into the docketing system.

13. When Ms. Foreman is either sick or on vacation or otherwise unavailable, Jodie fills in. Jodie's responsibilities include, typing drafts of patent applications and prosecution documents and preparing form letters to clients.

14. Over the years of her employment in my office, Ms. Foreman has been a loyal and devoted employee. Janis has normally handled her responsibilities in a professional and competent manner.

**D. CHRONOLOGY OF EVENTS IN THIS MATTER**

15. On or about Monday November 22, 2010 Ms. Foreman showed me a table of patent-related matters of Atomic Aquatics that she had prepared at the request of Mr. Dean Garraffa, one of that company's principals. Atomic Aquatics has been an important client of mine for about the past fifteen years and I have known its principals, Dean Garraffa and Doug Toth for more than twenty years.

16. I noticed that the table had a number of entries for Atomic Aquatics issued U.S. Patents which indicated that they had become abandoned for failure to pay maintenance fees between 2005 and 2008. She informed me that she believed that these abandonments were known to the client's principals and were the result of their lack of adequate funds or because the corresponding products had become obsolete. To the best of my knowledge, Ms. Foreman sent this table to Mr. Garraffa that day on Wednesday morning, November 24. On that same day I left Southern California for the four-day Thanksgiving weekend, arriving at my destination that evening. I checked my email and opened an email from Ms. Foreman stating that Mr. Garraffa had received the table and had called the office that day and expressed a desire to see me as soon as I returned from the Thanksgiving weekend.

17. When I returned to the office on Monday November 29, 2010, Mr. Garraffa was already waiting for me in the lobby talking to Ms. Foreman. He indicated a need to meet with me to speak to me about the contents of the table Ms. Foreman had sent to him. Mr. Garraffa then proceeded to explain that he and Mr. Toth were shocked to learn that several of their issued U.S. patents had apparently expired without their knowledge and that they needed to find out how it had happened and what could be done to remedy the situation. I told him that I would investigate the various files involved and report to him as soon as possible.

18. Over the ensuing two days I had discussions with Ms. Foreman and I examined a number of the Atomic Aquatics patent files. I also spoke to Mr. Garraffa about a provisional application that was supposed to be followed by a corresponding non-provisional but hadn't been. In examining the file, I found various instructions I had prepared for Ms. Foreman including a set of claims for the non-provisional, but no evidence that Ms. Foreman had carried out my instructions or that a non-provisional had been prepared and filed. It became evident to me that Ms. Foreman had failed to do her work in regard to a number of Atomic Aquatics files including the file No. ATOMIC-14 (Patent No. 6,761,163) for which this petition is being filed.


19. When I confronted her, she eventually admitted to me that she had lost control of her tasks, particularly over a several year period between 2005 and 2008 when she just couldn't keep up with the demands of the job and perform all of her duties in a timely manner. She revealed that she was too afraid and embarrassed to tell me about this behavior. I then reported to Mr. Garraffa and advised him that I would immediately begin preparation of petitions to revive the Atomic Aquatics patents that had been lost as a result of Ms. Foreman's shocking and totally unexpected behavior.

20. I arranged for Ms. Foreman to consult with a psychiatrist acquaintance so I could learn whether her problems were treatable and whether I could trust her work in the future. A Declaration Report of Dr. Samuel Albert is enclosed herewith.

21. Based upon Dr. Albert's Report and my own observations, I believe that Ms. Foreman, as a result of overwork and stress beyond her limit, experienced a lengthy period of irrational behavior. During this period she simply didn't carry out all of her usual responsibilities including communicating with clients and paying patent issue and maintenance fees including the following: file No. ATOMIC-14 for Patent No. 6,761,163 maintenance fees. Furthermore, Ms. Foreman was afraid to admit her inadequacies and endanger her position which had become such a predominant aspect of her life. Consequently, she did all she could to hide the problems until just recently.

Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Respectfully submitted,

 12/31/10  
Leonard Tachner

I, Janis Foreman, do hereby declare as follows:

A. INTRODUCTION

1. This declaration is based on my personal knowledge and if called as a witness, I could and would testify competently to the facts set forth herein under oath.

B. BACKGROUND AND PROFESSIONAL EXPERIENCE

2. I am the office manager for attorney Leonard Tachner. I was hired in June 1978 and have been continually employed by Mr. Tachner since that time.

3. Over the past thirty two years, I have received an extensive amount of training and instruction from Mr. Tachner in all aspects of his practice. For the last approximately twenty years, I have been responsible for entering information into Mr. Tachner's patent and trademark docket. I handle routine communications with clients and associates, all under Mr. Tachner's direction and supervision. I also manage the bookkeeping, billing, and tracking of Mr. Tachner's accounts receivable and accounts payable. I prepare the final version of documents to be filed in the U.S. Patent and Trademark Office.

4. Our office procedures are clearly defined by Mr. Tachner. I receive all incoming correspondence and docket relevant dates in our electronic docket. As each due date in the docket is responded to, I am responsible for noting in the electronic docket when the due date was met.

5. Mr. Tachner maintains supervisory authority of the docket and routinely checks it for accuracy and upcoming deadlines. Mr. Tachner regularly confers with me regarding matters coming up on the docket. I review the docket daily for upcoming due dates and Mr. Tachner periodically reviews the docket for the same purpose. Where appropriate, I consult with Mr. Tachner regarding matters entered into the docketing system.

6. In connection with preparing this declaration, I have reviewed correspondence, emails and other documents relating to this matter. Though I cannot explain or justify many of my actions described below, I have set forth in this declaration my true recollection of the events.

C. CHRONOLOGY OF EVENTS IN THIS MATTER

7. On or about November 17, 2010, I received a phone call from Mr. Dean Garraffa of Atomic Aquatics. He asked me to prepare a tabular report showing the current status of all of their patent-related files in our office.

8. In response to Mr. Garraffa's request, I spent the following two days carefully examining all of the patent-related files of Atomic Aquatics. I found that there were a number of issued patents that had expired for non-payment of maintenance fees that had been due to be paid since as early as 2005. I also found a pending design patent application that had become abandoned for failure to pay an issue fee and a provisional application that had been allowed to lapse without filing a corresponding non-provisional.

9. I actually filled out the tabular report to reflect the true status of all of the Atomic Aquatic files, but I could not fully understand why there appeared to be numerous problems associated with these files, particularly in regard to the past several years. My initial reaction was that the client had communicated authorization to withhold such payments and filings because of their financial problems or product obsolescence, but I could not find any documents or other evidence supporting these "feelings". In retrospect, I now realize that these were unsupported rationalizations that cover a period of several years during which I was functioning at less than my normal capabilities.

10. I don't know precisely what may have affected my mental performance during this period, but I do recall that I was under a great deal of pressure and stress due to my work load and that I was feeling continuously overwhelmed and unable to keep up. However, I was reluctant to tell Mr. Tachner of my concerns because I did not want to disappoint him after so many years.

11. Upon discussing this matter with Mr. Tachner and Dr. Samuel Albert, I now realize that it was a mistake to keep Mr. Tachner in the dark in regard to my sense of being overwhelmed and that I should have informed Mr. Tachner of my need for help. I also now realize the harm my actions have caused the client and Mr. Tachner. I am truly sorry.



Pursuant to the terms of 28 U.S.C. §1746, I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. The declaration made herein are made with the knowledge that willful false statements and the like are punishable by fine, imprisonment, or both under 18 U.S.C. §1001 and may jeopardize the validity of the above-captioned patent.

Dec 22, 2010

  
Janis Foreman

**CONFIDENTIAL**Statement of Samuel H. Albert, M.D.

I, Samuel H. Albert, M.D., am a practising Psychiatrist having an office in Fountain Valley, California. I have been a licensed physician in the State of California beginning July 1, 1969. I have been in practice as a Psychiatrist since October 1, 1972 and a board certified Psychiatrist since November 1978.

In late November 2010 I was asked to render professional consultation as a psychiatric expert for the purpose of diagnosing a Ms. Janis Foreman, who is a legal secretary and office manager for Attorney Leonard Tachner in Irvine, California.

I was presented with certain facts relating to Ms. Foreman's job role and apparent irrational behaviour over the past few years or so in regard to her performance of her duties at Mr. Tachner's office. As I understand these facts, Ms. Foreman has had for over thirty years working in the Tachner law firm, the responsibility for billing clients for professional services carried out by the Tachner firm, as well as communicating with vendors of outside services for the firm and its clients, and generally running the day to day activities of the firm according to established rules and instructions of Mr. Tachner.

Besides Ms. Foreman and Mr. Tachner, I am informed that there is another full time secretary who takes instruction directly from Ms. Foreman and that from time to time there are one or two additional part time employees who may be brought in to carry out certain maintenance-type activities such as library upkeep, filing, copying, mail preparation and the like.

As I understand their relationship, Mr. Tachner spends his time mostly doing legal work for the firm's clients and he depends heavily on Ms. Foreman to run the business aspects of the firm including billing, docketing, payroll and communicating with outside service providers. She also handles Mr. Tachner's document preparation and maintaining his files which are quite numerous. Clearly from what I've learned, the Tachner law firm is a very busy firm and Ms. Foreman has a heavy workload with many varied and important responsibilities.

I have had the opportunity to read Mr. Tachner's statement regarding Ms. Foreman's behaviour in relation to the client Atomic Aquatics. I have also read Ms. Foreman's statement pertaining to those matters. In addition, I have had a two hour interview with Ms. Foreman in which she participated voluntarily at the request of Mr. Tachner.

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I do not consider Ms. Janis Foreman to be a patient of mine at this time because I have been asked to consult in the capacity of an expert with the intent of communicating my diagnosis with the constraints of physician-patient privilege. I have made this special purpose of my participation in this matter clear to Ms. Foreman and she has acknowledged that she understands that she is not my patient and that I am not her physician.

Based upon these facts communicated to me, my reading of the Tachner and Foreman statements and my interview with Ms. Foreman, I have formed a preliminary medical opinion as follows:

Ms. Foreman's irrational behaviour is a result of her reaction to a temporary but continually increased work overload which became more than she could handle without any apparent way to vent the frustration, the worry and concern that's she increasingly felt as she fell behind in her work.

She correctly regards her most significant responsibility as control of cash flow by timely billing of clients and payments to vendors. In the period from early 2005 to the end of 2007, she evidently became so busy that's she lost the ability to bill clients in a timely manner and pay the firm's obligations when they were due.

She began feeling a sense of guilt for not being able to properly handle these responsibilities. She did not want to inform Mr. Tachner of these problems because she did not want to have her position diminished or lose any esteem in the eyes of her boss. She had no one else to tell of these difficulties and therefore no way to share these problems. After almost 30 years of being so capable and trustworthy, she could not bring herself to admit any inability to handle her responsibilities. She worried about her job, she worried about what Mr. Tachner would think of her, she spent more time concerned with her problems then with solving her problems.

This type of destabilizing behaviour resulted in a spiralling down in her ability to think and act rationally. She began to do and say unreasonable and unrealistic things. She lost any sense of reality. She lost her sense of proportionality. Her goal became one of maintaining a sense of continuity and stability for Mr. Tachner even by misleading him and making false statements to him and to others. Ms. Foreman was suffering from an acute psychotic breakdown brought on by rising pressures at her most important environment, her workplace where she had succeeded for decades.

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If Ms. Foreman were my patient I would propose that she undergo a program of therapy designed to give her a better sense of balance to handle such occasions of high levels of work pressure in a more motive and stable manner. I would prescribe an anti-depressant medication to address her symptoms of depression. Such medications include Prozac, Paxil, Zoloft, Lexapro, Wellbutrin and others. I would prescribe an anti-anxiety medication to address her symptoms of anxiety. Such medications include Librium, Ativan, Klonopin, Tranxene and others.

I would suggest to her that she should help her employer adjust her office responsibilities to reduce her work load if possible. I believe that Ms. Foreman's illness is amenable to treatment.

I declare under penalty of perjury that the foregoing is true and correct.  
Executed this 13 day of December 2010 at Fountain Valley, California.

By: Samuel H. Albert M.D.  
Samuel H. Albert, M.D.

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The following information is appended so as to provide medical basis and reasoning for my conclusion:

## Assigned Duties and Work Load of Ms. Foreman:

Ms. Janis Foreman is a Caucasian female age 61, born 4-26-1949. She has been an employee since June 19, 1978 of Leonard Tachner, Esq. Ms. Foreman is the office manager.

Ms. Foreman states that she is a Legal Secretary and is the Manager of the office where she works. She describes her assigned duties as numerous, detailed and often overwhelming.

She states, "I have a giant case load. I do many jobs." Among the long list of tasks for which she is responsible, she mentioned the following:

## TASKS RELATED TO THE LEGAL WORK OF THE OFFICE:

1. Managing the foreign filing of patent information,
2. Managing the United States filing of patent information,
3. File patent application in the United States,
4. File world-wide trademarks, a cumbersome process,
5. File United States trademark applications,
6. Obtain required documents from the client and the United States Patent Office,
7. Obtains a United States copy of certified documents,
8. Prepares and files Assignment documents in the United States and Worldwide,
9. She does docketing of all the documents that enter the office,
10. She sends out form letters,
11. Prepares and obtains Power of Attorneys from companies,
12. She types all amendments and applications,
13. She files copyrights,
14. She does filing, pulling and replacing files,
15. She does drawing corrections and declarations. "I'll get the draftsman to come in and do new drawings".
16. Oversee preparation of photocopying (me or Jodie),
17. She does work related to the international Patent Cooperation Treaty (PCT). She does work related to the PCT, an international treaty involving nations that have signed the PCT agreement with the U.S.A.,
18. Letters take a great deal of time and each letter has to be placed in the file appropriate to the letter,
19. From the parent case there are often several other cases that come from the parent case, each having its own number,
20. Oversight of the office docketing system,

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21. Typing of drafts of patent applications and prosecution documents.

TIME PRESSURES often become extreme due to the following factors

1. Everything received by the office has a deadline of 30, 60 or 90 days,
2. Often the inventor works for a company and then leaves the company.

OVERWORK of Ms. Foreman can be ascertained by examining these factors:

The quantity of documents is massive.

Locate a misplaced document might take several hours or days.

Ms. Foreman often works 2 or 3 nights extra each week to 7-10 PM depending on what is going on in the office.

#### ASSIGNED OFFICE TASKS NOT RELATED TO THE LEGAL WORK

1. Ms. Foreman does the billing of clients for the office, and the bill paying. The attorney in the office signs the checks.
2. Pays bills.
3. Bills clients.
4. Bill clients for costs.
5. "I am responsible to obtain supplies for the office; I order or buy supplies at Sam's Warehouse or Costco stores or stationary stores including soft drinks and bulk paper".
6. She cleans the office on the weekends.

HELP AND ASSISTANCE ARE PROVIDED BY ADDITIONAL EMPLOYEES IN THE OFFICE, TO A LIMITED DEGREE.

The Secretary (Jodie) does help a bit.

12/31/2010 12:50 FAX 9499552415

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## Current psychiatric mental status evaluation:

Caucasian Female appearing her stated age. Judgement intact for basic activities of daily life, but is revealed to be quite weak during the time of the events starting in early 2005. She did think in a way that can only be described as psychotic at the time. She made extremely poor decisions, thought in unusual manners, believed events to be true that were in fact false, and acted upon these convictions rather than logic or the usual standing orders of her employer.

Her mood is one of anxiety with an undercurrent of depression. Her daily life is usually non-eventful. She spends most of our evaluation session talking about the events which occurred while she was employed by the law firm of Leonard Tachner. She has many recollections of the events. Speech is grammatical most of the time. No stutter, stammer or lisp. Dress is casual, with cotton-wash pants and a nondescript shirt. No jewelry other than an inexpensive wristwatch. No symptoms to indicate disorientation, hallucinations, illusions, delusions, true phobias, obsessive thinking, compulsive or stereotypic movement inappropriate affect. Affect is congruent to speech and thought and is appropriate mood. Psychological understanding and insight is absent.

**Diagnosis:** Major Depression, severe, with psychotic episodes.  
Generalized Anxiety Disorder

Very truly yours,



Samuel H. Albert, M.D.



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According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). **THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD.** 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, customers should call the Office of Petitions Help Desk at 571-272-3282 or refer to the USPTO Web site at [www.uspto.gov/web/offices/pac/dapp/petitionspractice.html](http://www.uspto.gov/web/offices/pac/dapp/petitionspractice.html). The USPTO also permits reinstatement under 37 CFR 1.378(c) by electronic petition (e-petition) using EFS-Web; e-petitions may be automatically granted if all the eligibility requirements are met. For further information on filing an e-petition, please call the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100 or refer to the EBC's e-petition guide at [www.uspto.gov/ebs/portal/efs/petition\\_quickstart.pdf](http://www.uspto.gov/ebs/portal/efs/petition_quickstart.pdf).

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PATENT NUMBER	APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
6761163	10347608	07/13/04	01/21/03	07/13/08	ATOMIC-14

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